

Trademark Trial and Appeal Board Update – NYIPLA Hot Topics

TTAB Judge Jonathan Hudis
August 4, 2020

UNITED STATES
PATENT AND TRADEMARK OFFICE



Cumulative increases FY17-FY19

- Ex Parte Appeals Up 6.8%
- Extensions to Oppose Up 7.6%
- Oppositions Up 18.3%
- Petitions to Cancel Up 31.3%

FY 2020 TTAB incoming filings

FY 2020 TTAB incoming filings	FY 2019 EOY results	FY 2020 actual, target or projected	FY 2020 Through June 2020	Rate of Change
TYPE OF FILING				
Notices of Appeal	3,333		2,495	N.A.
Extensions of Time to Oppose	20,502		14,399	-6.4%
Notices of Opposition	6,955		5,045	-3.3%
Petitions to Cancel	2,426		1,865	+2.5%

Trends in new filings - Quarterly

Type of filing	FY18 (% +/- FY17)	FY19 (% +/- FY17)	By Quarters in FY19	By Quarters in FY20	FY20 Thru Q3 (rate of change +/- FY19)
Appeals	3,223 (+1.2%)	3,333 (+3.4%)	866; 747; 871; 849	863; 803; 829	2,495 (no change)
Extensions of time to oppose	19,208 (+3.9%)	20,502 (+6.7%)	4,672; 4,673; 5,564; 5,593	5,025; 4,669; 4,705	14,399 (-6.4%)
Oppositions	6,496 (+5.5%)	6,955 (+7.1%)	1,599; 1,632; 1,780; 1,944	1,841; 1,639; 1,565	5,045 (-3.3%)
Cancellations	2,253 (+7.2%)	2,426 (+7.7%)	565; 599; 609; 653	632; 654; 579	1,865 (+2.5%)

Trends – cases ready for decision, Quarterly

Final decisions on merits appeals and trial cases	FY18 (% +/- FY17) (% trials)	FY19 (% +/- FY18) (% trials)	By Quarters in FY19	By Quarters in FY20	FY20 Thru Q3 (rate of change +/- FY19)
Maturing to RFD (ready for decision) (appeals/trials) (percent trials)	650 (-4.3 %) (473/177) (27.2%)	744 (+14.5%) (514/230) (29.9%)	191; 185; 201; 167 (33%); (32%); (34.3%); (23.4%)	145; 176; 176 (23.4%); (27.8%); (16.5%)	497 (-10.9%) (385/112) (22.5%)
Awaiting decision at end of period (appeals/trials) (percent trials)	130 (+39.8%) (74/56) (43.1%)	206 (+58.5%) (123/83) (40.3%)	197; 213; 267; 206 (33.5%); (39.4%); (40.8%); (40.3%)	235; 211; 194 (34.9%); (32.2%); (22.7%)	194 (-5.8%) (150/44) (22.7%)

FY 2020 performance: contested motions

FY 2020 TTAB performance: Contested Motions	FY 2019 EOY results	FY 2020 Actual, Target or Projected	FY 2020 Through June 2020	Variance
<p>PENDENCY – Contested motions</p> <p>(1) Measured from ready-for decision until mailing; average of orders on contested motions, excluding precedents, issued during reporting period</p>	11.5 weeks	8-12 weeks (target)	11.8 weeks	Within target range
<p>INVENTORY – Contested motions ready for decision</p> <p>The number of cases with contested motions in which briefing was completed, becoming ready for decision, as of the end of the reporting period</p>	242		199	17.8% decrease

Trends – motions ready for decision

Contested Motions	FY17 (% +/- FY16)	FY18 (% +/- FY17)	FY19 (% +/- FY18)	By Quarters in FY19	FY20 thru Q3 (rate of change +/- FY19)
Maturing to RFD (ready for decision)	1212 (+4.4%)	1287 (+6.2 %)	1284 (-0.2%)	341; 301; 304; 338	1065 (10.6% change compared to 75% of FY19 total)
No. of Motions Resolved by Issued Decisions (No. of Decisions Issued)	1,238 (-9.4%) (991) (-3%)	1,318 (+6.5%) (1,082) (+9.2%)	1,231 (-9.4%) (1,002) (-7.4%)	248; 376; 270; 337 (208; 304; 216; 274)	977 (+5.8%)* (781) (+3.9%)* *each compared to 75% of FY19 total
No. of Cases with Motions Awaiting Decision at end of period	147 (+25.6%)	165 (+12.2%)	242 (+46.7%)	197; 213; 267; 242	199 (-17.8%)

FY 2020 performance: final decisions

FY 2020 TTAB performance: <i>Final Decisions</i>	FY 2019 EOY results	FY 2020 actual, target or projected	FY 2020 Through June 2020	Variance
<p>PENDENCY – Final decisions in ex parte appeals Average time to issuance, measured from ready for decision date until mailing for final decisions, excluding precedents, in appeal cases decided during reporting period</p>	12.7 weeks	10-12 weeks (target)	13 weeks	above target range
<p>PENDENCY – Final decisions in trial cases Average time to issuance, measured from ready for decision date until mailing for final decisions, excluding precedents, in trial cases decided during reporting period</p>	15.3 weeks	12-15 weeks (target)	18 weeks	above target range

FY performance: end-to-end processing times

FY 2020 TTAB performance: End-to-End Processing Times	FY 2019 EOY results	FY 2020 actual, target or projected	FY 2020 Through June 2020	Variance
<p>TOTAL PENDENCY Average total pendency, commencement to completion, excluding precedents</p> <p>Appeals (448 in FY19; 338 decided FY20)</p> <p>Trial cases (203 in FY19; 149 decided FY20)</p> <p>ACR trial cases (27 decided in FY19; 13 decided FY20) (2/3 of time of full trial)</p>	<p>40.5 weeks</p> <p>160.6 weeks</p> <p>126.2 weeks</p>		<p>48.6 weeks</p> <p>149.7 weeks</p> <p>93.5 weeks</p>	<p>+20%</p> <p>-2.3%</p> <p>-25.9%</p>

FY 2020 TTAB staffing

FY 2020 TTAB staffing	As of October 1, 2019	As of June 2020	Projected
JUDGES and ATTORNEYS			
Administrative Trademark Judges	23	24	ATJs may be added
Interlocutory Attorneys	14/1	17/1	

Recent retirement of ATJ. Possible vacancy announcement

TTAB IT updates (U.S. Counsel Rule)

- July Enhancement Package: ESTTA 3.1/TTABIS 4.1
- Entering non-U.S. domicile address for filing party forces filer to Attorney Correspondence screen automatically (entry of such an address automatically checks “represented by attorney” box)
- Checking attorney box activates “Bar membership info” box; U.S. counsel fields viewable to filer and in TTABIS (internal), but not in TTABVUE (external)
- Registrant’s “owner email” masked while petitioner completes Petition to Cancel filing process and on final coversheet; appears in TTABVUE correspondence address field only *after* institution

TTAB IT updates (ESTTA emails)

- Separate email field for required Primary email address (limit of one); Up to 10 optional secondary email addresses
- Matches structure in Trademark systems
- Improved synchronization between Trademarks and TTAB databases on correspondence fields and application or registration records
- Two emails issue concurrently to primary and secondary addresses; identical except for the “from” email address (ESTTA@uspto.gov and ESTTANoReply@uspto.gov)
- New optional Docket Number field for external attorneys

TTAB IT updates (reading room)

- TTAB Reading Room will replace e-FOIA webpage August 1
- Search final decisions and precedential decisions/orders
- Search by date, issue involved, or other criteria, or by text
- URL: <https://e-foia.uspto.gov/Foia/TTABReadingRoom.jsp>
- Provide feedback via TTABFeedback@uspto.gov (suggestions will be considered for future releases)

TTAB Reading Room



TTAB Reading Room

Decisions

Search

Legend : RE = Request for reconsideration; EXA = Ex parte appeal; OPP = Opposition; CAN = Cancellation; CNU = Concurrent use

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14,478 results found

Refine by

Proceeding or Application No.

Date range

Names

TTAB decision

Mark and goods/services

Proceeding type

Citable as precedent of TTAB

Decision type

Grounds for refusal, opposition, or cancellation; defenses

Evidentiary and procedural

<input type="button" value="ⓘ"/>	Date issued <input type="button" value="▼"/>	Case type	Proceeding / App. No.	Party / Parties	Issue	TTAB decision	Mark and goods cited by Examining Attorney	Opposer's or Petitioner's mark and goods/services	Applicant's or Respondent's mark and goods/services	Citable
<input type="button" value="ⓘ"/>	06/05/2020	EXA	88005423	Product Miniature Co. Inc.	2(d)	Refusal Affirmed	FLEXWALL [rental of interlocking partitions for use in face to face marketing events in Class 35]	—	FLEXWALL [retail shelving system comprised primarily of adjustable shelves featuring a back wall unit and components thereof in Class 20]	No
<input type="button" value="ⓘ"/>	06/04/2020	EXA	88033521	International Franchise Inc.	2(d)	Refusal Affirmed	REAR SCHMEAR (REAR disclaimed) [non-medicated diaper rash ointments and lotions in Class 3]	—	SCHMEAR [body oils, essential oils and scented oils, not for use for the treatment or prevention of diaper rash in Class 3]	No
<input type="button" value="ⓘ"/>	06/04/2020	EXA	87780575	Highway Transport Logistics, Inc.	1, 2, 3 & 45 (generic); 2(e) (1) and 2(f)	Refusal Affirmed on genericness	—	—	HIGHWAY TRANSPORT (TRANSPORT disclaimed) [freight transportation by trucks; supply chain logistics and reverse logistics services, namely, storage, t ...more	No
<input type="button" value="ⓘ"/>	06/04/2020	OPP	91241488	Perfectly Posh, LLC v. Jacqueline Abner-Pongratz	2(d), No Bona Fide Intent to Use, Fraud	Opposition Dismissed	—	PERFECTLY POSH (and two with designs as shown below) [all for wide range of personal care products, including, perfume, nutritional oils for co ...more	POSH GOTH and [both for bath soaps; cosmetic preparations for body care; cosmetics; perfumes in Class 3]	No
<input type="button" value="ⓘ"/>	06/04/2020	EXA	88030290	Shelby A. Tarleton	2(d), Rule 2.32(a) (6), unacceptable	Both Refusals Affirmed	LASHBOSS [mascara in Class 3]	—	LASH BOSS (LASH disclaimed as to Class 3 goods) [artificial eyelashes; eyelash extension application accessories sold	No



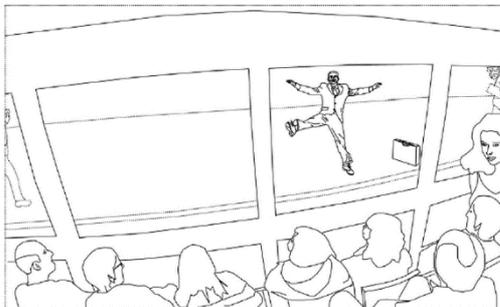
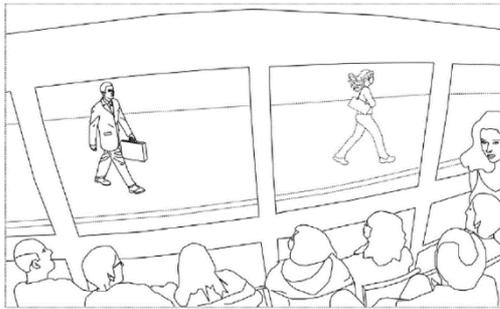
“Generic.Com” Domain Names as marks

United States Patent and Trademark Office v. Booking.com B. V., 140 S. Ct. 2298 (2020)

- No *per se* rule that a “generic.com” domain name is incapable of serving as a trademark or service mark.
- Did not hold that a “generic.com” mark must be capable.
- Did not hold that a “generic.com” mark must be incapable.
- The USPTO must assess such marks one-at-a-time, based on evidence of consumer perception made of record.
- Consumer perception evidence: dictionaries and other references, surveys, owner’s use, media use, consumer use, competitor use.

Failure to Function

- Trademark Act § § 1, 2, 3, 45.
- *In re The Ride, LLC*, 2020 USPQ2d 39644 (TTAB 2020)



“[T]he ... specimens, all fail to display the proposed mark or associate the proposed mark with the recited services [sightseeing travel services by bus], thus making it unlikely that the relevant consumers will perceive the proposed mark as indicating source.”

Failure to Function

- *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686 (TTAB 2019)



“Applicant presents the proposed marks in a manner that just conveys information about the identified crabmeat; a number of third parties in the industry use wording that is the same as, or similar to, each of the proposed marks to convey information about their products; third parties use similar pictorial representations to provide information about their crabmeat and seafood products; and the inclusion of stylization, insignificant background carriers, and a realistic image of a crab, does not alter our conclusion regarding consumer perceptions of the proposed marks as a whole.”

Failure to Function

- *In re Wal-Mart Stores, Inc.*, 129 USPQ2d 1148 (TTAB 2019)
INVESTING IN AMERICAN JOBS for “promoting public awareness for goods made or assembled by American workers.”

“[C]onsumers would perceive [the proposed mark] as merely an informational statement that Applicant is selling certain goods that are made or assembled in America in areas of the store where the signage appears. It would not be perceived as a service mark for ... [the] services recited in the application, but instead would be perceived as informing consumers that the goods are made or assembled by U.S. workers and expressing enthusiasm for the creation of jobs in the United States.”

Failure to Function

- *In re DePorter*, 129 USPQ2d 1298 (TTAB 2019)
#MAGICNUMBER108 for clothing products

“[D]ue to the widespread use of [the proposed mark] to express affiliation for the Chicago Cubs baseball team and their pursuit of a 2016 World Series win 108 years after their last one, Applicant's proposed mark would not be perceived as identifying a particular source of goods. That Applicant may have been the first to use the phrase and/or hashtag does not change the fact that the evidence shows widespread use of #MAGICNUMBER108 to informationally convey reference to the Chicago Cubs' World Series appearance.”

Tips for Inter Partes proceedings

- Consider Accelerated Case Resolution (“ACR”) and other stipulated efficiencies.
- Refrain from “over-papering” the record.
- Tight declarations, affidavits, depositions.
- Clearly identify notice of reliance materials.
- In final briefs, focus on claims, defenses and evidence necessary to prosecute or defend case.
- Avoid evidentiary objections focusing on minutiae.

