

**UNITED STATES  
PATENT AND TRADEMARK OFFICE**



# **Trademark Trial and Appeal Board (TTAB) update NYIPLA – July 13, 2022**

TTAB Judge Jonathan Hudis

UNITED STATES  
PATENT AND TRADEMARK OFFICE



**Final Pretrial Conference pilot**

# Pretrial conference pilot

- TTAB interlocutory attorneys (IAs) and administrative trademark judges (ATJs) all contributed on goals, processes
- Board has begun soliciting customer input
- Will focus on cases with indications they are likely to create large and redundant, unfocused or unwieldy records

# Benefits

- Goals are to save time and resources of parties and the TTAB, and foster effective presentation of case
- Parties will be strongly encouraged to enter into stipulations on exhibits, agreed-upon facts, presentation of evidence; subject to Board approval
- Winnow down the case with stipulations, and dispense with extraneous claims/defenses/objections

# Recommendations

- Focus on cases wherein (A) the number of claims/defenses unwarranted; (B) parties or counsel unfamiliar with TTAB practice; (C) proceedings too contentious, too many motions
- Large majorities of TTAB IAs and ATJs said all three somewhat or very important signs, with (C) the most important

# Recommendations

- Parties to submit a proposed Final Pretrial Conference Order (FPCO) (complete with a trial plan and pretrial disclosures); Board will provide template for parties' use
- Parties come to the Final Pretrial Conference (FPC) with possible amendments to their claims and defenses in their draft FPCO
- Once the claims and defenses are reflected in the FPCO approved by the Board, that limits what parties will pursue at trial

# Recommendations

- Known objections to evidence should be raised and discussed during conference, particularly for documentary evidence (to encourage stipulations)
- Encourage parties to focus objections on issues they are likely to win and that are outcome determinative
- Discourage parties from asserting a whole litany of objections



# Recommendations

- Proceed with pilot, experiment, adjust over time
- An ATJ and IA should oversee each FPC
- The FPC should be preceded by an introductory conference with an ATJ, to describe the process
- The FPC should be held sometime after close of discovery but before pre-trial disclosures are due


# Input needed

- Provide feedback via [TTABFeedback@uspto.gov](mailto:TTABFeedback@uspto.gov)

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## Trademark Trial and Appeal Board

The Trademark Trial and Appeal Board (TTAB) handles appeals involving applications to register marks, appeals from expungement or reexamination proceedings involving registrations, and trial cases of various types involving applications or registrations.




### Filing assistance

- > New to TTAB?
- > Filing with TTAB
- > Pre-filing and technical requirements
- > Forms
- > Fees
- > Systems status
- > Contact us



### Practice and procedure

- > Trademark Trial and Appeal Board Manual of Procedure (TBMP)
- > Final rules and pilots
- > Policy and guidance resources
- > Automatic Standard Protective Order (SPO)
- > Acknowledgement form for SPO
- > Alternative Dispute Resolution



### Proceedings

- > Preparing for hearings
- > TTAB by the numbers
- > Search final and precedential decisions
- > Frequently asked questions

# Input needed

- Provide feedback via [TTABFeedback@uspto.gov](mailto:TTABFeedback@uspto.gov)

## Pilots

- [Final Pretrial Conference Pilot](#)
  - [Model Format for Final Pretrial Conference Order](#)
- [Expedited cancellation program concluded](#)
  - [Comments](#)

# Input needed

- Provide feedback via [TTABFeedback@uspto.gov](mailto:TTABFeedback@uspto.gov)

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## Final Pretrial Conference Pilot

The United States Patent and Trademark Office (USPTO), Trademark Trial and Appeal Board (TTAB) is implementing a pilot program of holding Final Pretrial Conferences in certain *inter partes* (trial) cases to better manage opposition and cancellation proceedings that proceed to trial.

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- > Background
- > How the Pilot Will Work
- > Pilot Goals and Duration
- > Final Pretrial Conference Order (Template)
- > Request for Input

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# **Submissions to the TTAB – problem cases**

# Problems with following Board rules or in submitting evidence

- *Made in Nature, LLC v. Pharmavite LLC*, 2022 USPQ2d 557 (TTAB 2022) (asserting a defense that was not pleaded, over-designating as confidential large portions of record as confidential, filing duplicative evidence, finding violations of rule governing counter-designation of discovery deposition testimony, submitting irrelevant evidence, parties using their own evidence page numbering systems)
- *Int'l Dairy Foods Ass'n v. Interprofession du Gruyère and Syndicat Interprofessionnel du Gruyère*, 2020 USPQ2d 10892 (TTAB 2020) (notwithstanding entry of evidentiary stipulation, parties asserted numerous evidentiary objections as well as objections that certain materials were submitted in contravention of Board's rules and practices), *aff'd*, \_\_\_ F. Supp. 3d \_\_\_, 2021 WL 6286234 (E.D. Va. Dec. 15, 2021), *appeal docketed*, No. 22-1041 (4th Cir. Jan. 11, 2022)

# Problems with following Board rules or in submitting evidence

- *Societe Des Produits Nestle S.A. v. Taboada*, 2020 USPQ2d 10893 (TTAB 2020) (given parties' ACR stipulation, opposer's refiling of numerous portions of its summary judgment evidence was duplicative and unnecessary)
- *Chavakula v. Praise Broadcasting aka Praise FM*, 2020 USPQ2d 10855 (TTAB 2020) (Board found "troubling" petitioner's actions deliberately misleading respondent with "promised future service of its discovery responses while in fact it was preparing to file a summary judgment motion...")

# Problems with following Board rules or in submitting evidence

- *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1803 (TTAB 2018) ("Simply put, the parties introduced into the record thousands of pages of testimony and other evidence without regard to what they needed to prove, apparently in the hope that in wading through it, we might find something probative. This is not productive."), *aff'd*, 377 F. Supp. 3d 588 (E.D. Va. 2019), *aff'd*, 986 F.3d 361, 2021 USPQ2d 81 (4th Cir. 2021)
- *SFM, LLC v. Corcamore, LLC*, 129 USPQ2d 1072, 1078 (TTAB 2018) (defendant refused to cooperate in the discovery process for over sixteen months), *aff'd*, 978 F.3d 1298, 2020 USPQ2d 11277 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021)
- *Benedict v. Superbakery Inc.*, 665 F.3d 1263, 101 USPQ2d 1089 (Fed. Cir. 2011) (affirming Board's entry of judgment as a discovery sanction for repeated failures to comply with Board's reasonable orders), *aff'g* 96 USPQ2d 1134 (TTAB 2010)



**Best practices before the TTAB**

# Briefing entitlement to a cause of action (f/k/a “standing”)

- Our decisions have previously analyzed the requirements of Trademark Act Sections 13 and 14, 15 U.S.C. §§ 1063-64, under the rubric of “standing.”
- We now refer to this inquiry as entitlement to a statutory cause of action.
- Despite the change in nomenclature, our prior decisions and those of the Federal Circuit interpreting Trademark Act Sections 13 and 14 remain applicable. *Chutter, Inc. v. Great Mgmt. Grp., LLC*, 2021 USPQ2d 1001, at \*10 n.39 (TTAB 2021) (citing *Spanishtown Enters., Inc. v. Transcend Res., Inc.*, 2020 USPQ2d 11388, at \*2 (TTAB 2020)).

# Briefing entitlement to a cause of action (f/k/a “standing”)

- Latest relevant Federal Circuit decisions:
  - *Corcamore, LLC v. SFM, LLC*, 978 F.3d 1298, 2020 USPQ2d 11277, at \*4 (Fed. Cir. 2020), *cert. denied*, 141 S. Ct. 2671 (2021), (citing *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 572 U.S. 118, 109 USPQ2d 2061, 2067-70 (2014))
  - *Australian Therapeutic Supplies Pty. Ltd. v. Naked TM, LLC*, 965 F.3d 1370, 2020 USPQ2d 10837, at \*3 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 82 (2021)

# “Standing” means now means something else to the Federal Circuit

- The Federal Circuit has now introduced a new wrinkle as to a requisite showing of Article III standing on appeals from TTAB adverse 2(d) decisions. See *Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 17 F.4th 129, 139, 2021 U.S.P.Q.2d 1069, at \*5 (Fed. Cir. 2021)
- Under *Brooklyn Brewery*, the losing plaintiff before the Board must show that it will suffer harm by continued registration of the defendant’s mark as to an area in which the plaintiff competes or has concrete plans to enter.

# Pet peeves and best practices of the TTAB judges (“Help us help you”)

- Original filing of one’s trademark application: Define technical or complex goods and services so a layman can understand them
- Pleadings
  - Double-check the legal test for your claim and ensure that the necessary allegations are included
  - Set a reminder to circle back to the pleadings after discovery and move to amend if necessary; do not risk relying on trial by implied consent
  - Refrain from asserting claims or theories more appropriate for infringement or unfair competition court litigation – remember the TTAB’s limited jurisdiction



# Pet peeves and best practices

- Submission of evidence
  - Attach pleaded registrations to complaint, but nothing else, to ensure they are in the record; if you did not, make sure you submit the registrations by another appropriate evidentiary vehicle: testimony declaration/affidavit/deposition, notice of reliance; your goal is to support the current active status and ownership title in your client
  - Make sure all of the evidence you submit is readable
  - Do not submit mounds of evidence, then barely refer to it; if filing a big document, tell us where in the document to find the nugget you wish for us to rely on, without making us hunt for it

# Pet peeves and best practices

- Common mistakes
  - Relying on Notice of Reliance materials for the truth of the matter asserted
  - Using third-party registrations incorrectly
  - Expecting argument rather than evidence to work for you
- Do not submit evidence twice; such as by Notice of Reliance and again in your client's testimony declaration/affidavit/deposition
- Do not submit deposition transcripts in condensed format
- Internet evidence: URL + date of capture; remember, without additional testimony Internet evidence is only good for what is shown on its face, not for the truth of what is shown
- Do not over-designate confidential material. When you redact confidential parts of a document, make sure the confidential version (accessible by the Board, not the public) highlights or shades the parts that were redacted in the public version. Otherwise, we have to spend a great deal of time comparing the two versions to make sure we do not inadvertently disclose confidential information. And then you wonder why it takes so long to get a decision.

# Pet peeves and best practices

- Procedural, substantive and evidentiary objections
  - Familiarize yourself as to when (timeliness) and how to assert these different types of objections; the TBMP is a good place to help you with this
  - Limit objections given that ATJs (not a jury) will assess the evidence - the Board can weigh the evidence and accord it the proper probative value, which sometimes may be zero
    - If granted, the objection is outcome-determinative and/or
    - the evidence of your adversary is egregiously inadmissible
  - If admissible, just argue its low probative value, or lack of any probative value
  - Refrain from objecting unless the objection is important/dispositive. Board proceedings are akin to bench trials. We know what weight to give the evidence.



# Pet peeves and best practices

- Briefs on final hearing
  - Cite precedential cases from the Federal Circuit and TTAB. If you must cite a non-precedential decision, or a decision from outside the CAFC/TTAB, do so judiciously and only if there is nothing else within our jurisdiction on point
  - Do not attach evidence to your brief; if it was timely placed in the record then it is duplicative; if it was not timely made of record, then it is too late
  - Cite to the evidentiary record appropriately for supporting your position – using TTABVUE docket entry number and TTABVUE page (not your own citation method)

# Pet peeves and best practices

- Briefs on final hearing
  - If advancing a novel theory, or a position that runs contrary to our established decisional law or practice, acknowledge it and be prepared to explain why we should create an exception for you and your client; citing to an outlier decision and simply asserting that it applies by vague analogy is not sufficient
  - Painting the adverse party or its attorney as a bad actor never works
  - Trying to pull one over on the Board also never works – such as misrepresenting or exaggerating the value of the evidence, statutes, case law, or applicable rule



# Pet peeves and best practices

- Oral argument
  - Assume the ATJs know basic trademark law principles – e.g., no need to go over likelihood of confusion test
  - Assume the ATJs have reviewed the briefs
  - Treat ATJ questions as an opportunity to address the concerns of the decision-makers, and respond directly and helpfully
  - Do not try to use visual aids unless they depict something directly from the record and have been submitted and approved well in advance



# Appeals from adverse TTAB decisions

- A party that has received a final decision from the Board, and is dissatisfied with that decision, whether an applicant in an ex parte proceeding, or the losing party in an opposition, cancellation or concurrent use proceeding, may have remedy by way of an appeal
  - to the United States Court of Appeals for the Federal Circuit, Trademark Act Section 21(a), 15 U.S.C. § 1071(a), or
  - by way of a civil action for review of the decision of the Board, Trademark Act Section 21(b), 15 U.S.C. § 1071(b)
- A registrant dissatisfied with the final decision in an ex parte expungement or reexamination proceeding only has recourse to seek review by way of appeal to the Federal Circuit – Trademark Act Sections 21(a)(b), 15 U.S.C. §§ 1071(a)(b)

# Appeals from adverse TTAB decisions

- Appeals to the Federal Circuit are limited to the record before the TTAB
- Review by way of a civil action to a District Court may include the introduction of new evidence that was not before the TTAB; new evidence is considered *de novo*, and evidence previously before the TTAB is considered based on substantial evidence

**Thank you – time permitting, we can now entertain questions**

TTAB Judge Jonathan Hudis

UNITED STATES  
PATENT AND TRADEMARK OFFICE





# **Advanced Practice Tips from the Trademark Trial and Appeal Board**

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## **I. GENERAL INFORMATION**

This section provides general information regarding practice before the Trademark Trial and Appeal Board (TTAB or Board).

### **A. Employees and responsibilities**

Generally, every pending inter partes case is assigned to a paralegal and interlocutory attorney. The names of the attorney and paralegal assigned to the case are on the proceeding record in TTABVUE, the Board's docket database. Ex parte appeals are assigned to a paralegal, whose name also is in the appeal record in TTABVUE.

The Board's paralegal staff handles routine uncontested motions and scheduling orders. Interlocutory attorneys handle all contested pretrial matters, certain uncontested motions, and participate in discovery conferences on request of a party or when necessary to manage a case. The Board's Administrative Trademark Judges generally work in panels of three to decide ex parte and inter partes cases.

The Board's information specialists provide general information and answer status inquiries. They may be reached at the Board's main phone number: 571-272-8500. Parties should not contact any Board personnel ex parte to discuss the merits of a case or a particular substantive issue. Patent and Trademark Rule 11.305(b); TBMP § 105 (2021).

### **B. Electronic information and filings**

#### **(i) TTAB homepage**

The TTAB homepage is accessed from the U.S. Patent and Trademark Office website at [www.uspto.gov](http://www.uspto.gov) under the "Find It Fast" feature and under the dropdown menu for "Trademarks." The TTAB homepage provides links to online systems and various standard documents, policies and procedures, including:

- TTABVUE, the Board's online docket system, and ESTTA, the Board's online filing system;
- The TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP);
- The Trademark Rules, from Title 37 of the Code of Federal Regulations, and the Trademark Act, from Title 15 of the U.S. Code. These documents are not the official versions of the statutes and rules, but a resource provided by the Office;
- Information and documents specific to inter partes proceedings, including information about Accelerated Case Resolution (ACR) and the Board's STANDARD PROTECTIVE ORDER;

- The TTAB Reading Room providing a searchable database of final decisions and precedential orders;
- The TTAB Dashboard and other information reflecting case pendency measures, new filings, and inventory;
- Fee and payment information; and
- Information concerning oral hearings, which are available by request in both ex parte appeals and inter partes proceedings.

**(ii) Electronic filing and proceeding files**

Unless ESTTA is unavailable due to technical problems or extraordinary circumstances are present, **all Board filings must be made electronically via ESTTA** (with the appropriate fee, where applicable).

Current USPTO systems status and availability, including planned events, is posted at <https://www.uspto.gov/blog/ebiz/>. Detailed information on procedures for filing TTAB documents during an ESTTA outage is found at <https://www.uspto.gov/trademarks-application-process/appealing-trademark-decisions/filing-ttab-documents-during-outage>. Carefully review and follow relevant rules and procedures to preserve your client's rights.

**TIPS**

- Plan ahead, docket filing deadlines, and allow plenty of time to resolve issues that may arise due to unexpected problems using ESTTA. *DFC Expo LLC v. Coyle*, 121 USPQ2d 1903, 1906 (TTAB 2017).
- On successful transmission, a filing will be assigned an ESTTA tracking number. If the submitting party encounters a problem, such as the filing not appearing in the TTABVUE docket history, notify the Board and provide the ESTTA tracking number. The information will be forwarded to a Board IT specialist, who will attempt to remedy the problem quickly.
- Any questions regarding the technical aspects of ESTTA should be directed to the Board. If the information specialist, interlocutory attorney or paralegal cannot answer the question due to its highly technical nature, the question will be forwarded to a Board IT specialist. You may also submit the technical question by email to [ESTTA@uspto.gov](mailto:ESTTA@uspto.gov). Note: This email address is used for technical inquiries only, not for filing with the Board.
- Because communication between parties and from the Board is done through email, parties should make sure their authorized email correspondence addresses are up to date and USPTO email communication will not be blocked by spam filters.

- For immediate help, call 571-272-8500 during business hours.

### **C. Use of authority**

The following sources are appropriate for reference and citation in Board proceedings:

- Precedential decisions of the Board, the U.S. Court of Appeals for the Federal Circuit, and the Federal Circuit’s predecessor, the U.S. Court of Customs and Patent Appeals (CCPA). Case citations should be to the U.S. Patent Quarterly (USPQ).
- The U.S. Trademark Act (Lanham Act), 15 U.S.C. § 1051 et seq.
- Rules of Practice in Trademark Cases, 37 C.F.R. Part 2.
- The TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP), cited as “TBMP § XXX (2021)”, and the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP), cited as “TMEP § XXX (Ju. 2021)”.

### **TIP**

- Board decisions that are not designated precedential are not binding on the Board, but may be cited for whatever persuasive weight they may carry. Because each case must be decided on its own record, over-reliance on nonprecedential decisions should be avoided. *See In re Cordua Rests., Inc.*, 823 F.3d 954, 118 USPQ2d 1632, 1635 (Fed. Cir. 2016); *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001); *In re Loggerhead Tools, LLC*, 119 USPQ2d 1429, 1440 (TTAB 2016).

### **D. Representation by U.S.-licensed attorney**

Foreign-domiciled applicants, registrants, and parties to a Board proceeding are required to be represented by an attorney who is licensed to practice in the United States. Trademark Rule 2.11(a). All attorneys must provide the name of a state in which he or she is an active member in good standing, the date of admission to the bar of the named state, and the bar license number, if issued. Trademark Rule 2.17(b)(3). A reciprocally recognized attorney or agent may only appear as an additionally appointed practitioner. *Cloudworks Consulting Servs., Inc. v. Ongoing Operations, LLC*, 2020 USPQ2d 10019 (TTAB 2020).

## **II. TIPS FOR EX PARTE APPEALS**

Chapter 1200 of the TBMP is devoted to ex parte appeals and contains significant information regarding appeals from denials of registration. The following tips are intended to help appellants avoid some common errors.

## **A. Procedural issues**

Failure to comply with a procedural requirement (e.g. a requirement for information, to amend an identification of goods or services, to submit a signed and verified application) is an independent ground for refusing registration, separate and apart from any substantive ground for refusal. *In re SICPA Holding SA*, 2021 USPQ2d 613, at \*10 (TTAB 2021); *In re Carlton Cellars*, 2020 USPQ2d 10150, at \*5 (TTAB 2020); *In re Brack*, 114 USPQ2d 1338, 1343 (TTAB 2015). In addition, res judicata may bar re-litigation of an issue in an ex parte appeal. *In re SolarWindow Techs., Inc.*, 2021 USPQ2d 257 (TTAB 2021).

## **B. Refusal on the ground of likelihood of confusion**

Many denials of registration that are appealed to the Board are made on the ground of a likelihood of confusion with a cited registration pursuant to Section 2(d) of the Trademark Act. The issues specific to these refusals discussed below arise with particular frequency.

### **(i) Suspension**

When an application is refused registration on the ground of a likelihood of confusion with an existing registration, an applicant should always check the status of the cited registration. The Board will grant a request for suspension of an appeal after the fifth anniversary of the issue date of the cited registration if a Section 8 or 71 affidavit is due. When renewal is due, requests for suspension will be granted after the ninth anniversary of the issue date of the cited registration. *See* TBMP § 1213 (2021).

### **(ii) Scope of identification of goods and services**

The Board's analysis of a likelihood of confusion is based on the scope of the identifications in the cited registration and the subject application. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 USPQ2d 1157, 1162-63 (Fed. Cir. 2014); *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1354 (TTAB 2015). Thus, it is unavailing to argue or submit evidence that either the applicant or the owner of the cited registration uses a mark for fewer than all goods or services encompassed by the identification, or that the nature or prices of the goods or services are different.

## **TIPS**

- Where the identified goods or services are unrestricted, they are presumed to travel through all channels of trade and to all consumers normal for goods or services of the identified type. *See In re i.am.symbolic, llc*, 866 F.3d 1315, 123 USPQ2d 1744, 1750 (Fed. Cir. 2017); *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1788 (Fed. Cir. 1990); *In re Anderson*, 101 USPQ2d 1912, 1920 (TTAB 2012).
- Where an applicant's identified goods or services are identical to those identified in the cited registration, the Board must presume that the channels of trade and classes of customers are the same. *See In re Viterra Inc.*, 671 F.3d

1358, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012); *In re Smith & Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994).

- Likelihood of confusion must be found as to the entire class if confusion is likely with respect to any item within the identification of goods or services in that class. *Tuxedo Monopoly, Inc. v. General Mills Fun Grp.*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Double Coin Holdings Ltd. v. Tru Dev.*, 2019 USPQ2d 377409, at \*6 (TTAB 2019).

### C. Evidence

Do not submit multiple copies of evidence because it causes confusion in reviewing the record and may delay issuance of a final decision. *In re Virtual Indep. Paralegals, LLC*, 2019 USPQ2d 111512, at \*1 (TTAB 2019).

#### (i) Listings of third-party registrations

The Board does not take judicial notice of records that exist within USPTO databases, including registrations. *In re Jonathan Drew Inc.*, 97 USPQ2d 1640, 1644 n.11 (TTAB 2011); *Beech Aircraft Corp. v. Lightning Aircraft Co.*, 1 USPQ2d 1290, 1293 (TTAB 1986). This includes the file of a cited registration, which is not automatically of record. *In re Sela Prods., LLC*, 107 USPQ2d 1580, 1583 (TTAB 2013).

To make registrations of record, copies of the registrations or the electronic equivalent – e.g., printouts from the USPTO Trademark Electronic Search System (TESS) or Trademark Status and Document Retrieval (TSDR) databases – must be submitted during examination. *In re Jump Designs LLC*, 80 USPQ2d 1370, 1372 (TTAB 2006). Submission of a list, chart, or other summary of third-party registrations, including a commercial search report, is insufficient to make the underlying registrations of record. *In re Hoefflin*, 97 USPQ2d 1174, 1177 (TTAB 2010); *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Dos Padres Inc.*, 49 USPQ2d 1860, 1861 n.2 (TTAB 1998).

If an applicant improperly submits evidence of third-party registrations when the problem can be cured, the examining attorney must object to the evidence or the Board may deem the objection waived. *In re City of Houston*, 101 USPQ2d 1534, 1536 (TTAB 2012), *aff'd*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re 1st USA Realty Prof'ls Inc.*, 84 USPQ2d 1581, 1583 (TTAB 2007); *see also* TBMP §§ 1207.03, 1208.02 (2021).

### TIPS

- The evidentiary value of third-party registrations typically is minimal in the likelihood of confusion context. They are not evidence of use and cannot justify registration of a similar mark. *See Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992); *In re Embiid*, 2021 USPQ2d 577, at \*38 (TTAB 2021); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1934 (TTAB 2011).

- However, evidence of third-party registrations and use can be relevant to show that a mark or portion of a mark (in association with the particular goods or services) is descriptive, suggestive, or so commonly used that consumers will look to other elements to distinguish source. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1135-36 (Fed. Cir. 2015); *Juice Generation, Inc. v. GS Enters. LLC*, 794 F.3d 1334, 115 USPQ2d 1671, 1674-75 (Fed. Cir. 2015).
- In contrast to registrations, third-party applications have no probative value other than as evidence that they were filed. *In re Embiid*, 2021 USPQ2d 577, at \*36; *In re Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266, 1270 n.8 (TTAB 2009). Expired and cancelled registrations generally are evidence only that the registrations issued. *In re Brown-Forman Corp.*, 81 USPQ2d 1284, 1286 n.3 (TTAB 2006).

#### (ii) Internet evidence

Material obtained through the internet generally is acceptable as evidence if both the URL (web address) and access date are provided. *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018); *In re Mueller Sports Med., Inc.*, 126 USPQ2d 1584, 1587 (TTAB 2018).

If an applicant's internet evidence does not include the required URL and/or date, the examining attorney must object and advise the applicant as to the proper way to make the internet evidence of record. Otherwise, the Board may consider the objection waived. *In re Mueller Sports Med., Inc.*, 126 USPQ2d at 1587.

#### TIPS

- Listing a web address or providing a link to a website is insufficient to make information from that site of record. *See e.g., Int'l Dairy Foods Assoc. v. Interprofession du Gruyère and Syndicat Interprofessionnel de Gruyère, et al.*, 2020 USPQ2d 10892, at \*3-4 (TTAB 2020). *Norris v. PAVE: Promoting Awareness, Victim Empowerment*, 2019 USPQ2d 370880, at \*2 (TTAB 2019); *see also* TBMP § 1208.03 (2021).
- Internet search results that do not show the context in which a term or mark is used are generally of little probative value. *In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at \*21 n.28 (TTAB 2021).

#### D. Briefs

Briefs should include reference to compliance with requirements not the subject of the appeal. Trademark Rule 2.142(c). Ex parte appeal briefs are limited to 25 pages, reply briefs to 10 pages. Trademark Rule 2.142(b)(2).

Citations to evidence should reference the electronic application record by date, the name of the paper, and the page number in the electronic record. For example: "December 14,



2016 Office Action, TSDR p. 6” or, for any evidence appearing in TTABVUE after appeal, “4 TTABVUE 2.” Trademark Rule 2.142(b)(3).

Good cause must be shown to obtain an extension of time to file a brief. The Board considers reasons for an extension in context of the number of requests, so good cause for a first extension may not suffice for a subsequent extension. TBMP § 1203.02(d) (2021). A second or subsequent extension of time to file a brief must be accompanied by the requisite fee. Trademark Rule 2.6(a)(18)(iv)-(v).

### **TIPS**

- Late filing of a brief cannot be cured by a petition to revive. TBMP § 1203.02(a) (2021).
- Evidence should not be attached to an appeal brief. The record in the application should be complete before an appeal is filed, and evidence submitted for the first time with a brief is untimely. Trademark Rule 2.142(d); *In re Fallon*, 2020 USPQ2d 11249, at \*2 (TTAB 2020); TBMP § 1203.02(e) (2021). Evidence of record should be cited in the electronic record in the body of the brief. Trademark Rule 2.142(b)(3); TBMP § 1203.01 (2021).
- Responses to requests for information submitted for the first time in an appeal brief are untimely. *In re SICPA Holding SA*, 2021 USPQ2d 613, at \*9-10 (TTAB 2021).

### **E. Requests for reconsideration and remand**

Appellate briefs sometimes include offers to restrict an identification of goods or services, amend an application from the Principal Register to the Supplemental Register, and the like, if the Board is not otherwise persuaded the mark is registrable. This is improper. After decision by the Board, absent order of the Director, an application can be reopened only to enter a disclaimer. Trademark Rule 2.142(g); *In re Information Builders Inc.*, 2021 USPQ2d 228, at \*3-4 (TTAB 2021). If an applicant wishes to have the Board consider an amendment in the alternative, it should request remand before the Board decides the appeal so the examining attorney can evaluate the amendment.

If an applicant files a notice of appeal and a request for reconsideration, and a subsequent final Office action issues, an applicant does not have a right to file a second request for reconsideration. Rather, the applicant must request remand. *See* TBMP §§ 1204, 1207 and 1209.04 (2021).

### **TIP**

- A second refusal repeating all refusals and requirements may be considered a final refusal for purpose of appeal. Trademark Rule 2.141(a).

- It is the responsibility of an applicant to ensure that its filings and evidence are complete. *See In re tapio GmbH*, 2020 USPQ2d, at \*3 (TTAB 2020). To enter evidence into the record after a notice of appeal is filed, an applicant or examining attorney should request remand. Trademark Rule 2.142(d).

### **III. TIPS FOR INTER PARTES PROCEEDINGS**

#### **A. Jurisdiction over applications and registrations**

The Board has jurisdiction over an application or registration subject to an inter partes proceeding. Accordingly, any amendment, change of address, change of counsel, etc., must be filed with the Board. However, maintenance documents related to a registration involved in a cancellation proceeding (e.g., an affidavit of continuing use or a renewal application) must be filed with the Post Registration division of the Office. In addition, when a mark has been assigned or the owner's name has changed, the assignment or name change document should be recorded with the Assignment Branch of the USPTO and proof of the assignment or name change should be filed with the Board. TBMP §§ 512.01 and 512.02 (2021). It is always helpful to alert the Board to any filing made in another part of the USPTO concerning a registration or application involved in a Board proceeding.

#### **TIP**

- Filings for opposed applications often are submitted via the Trademark Electronic Application System (TEAS) or to the examining attorney who approved the mark for publication, rather than via ESTTA. Do not do this! It can cause serious delays and may result in the filing not being considered.

#### **B. Service of submissions and papers**

The Board effects service of complaints on defendants by issuing a notice of institution that includes a web link to the electronic proceeding record. Trademark Rules 2.101(a) and (b), 2.105(a), 2.111(a) and (b), and 2.113(a); TBMP § 309.02(c) (2021). Petitioners are required to provide the Board with the current email address(es) for the registration sought to be cancelled, to the best of the petitioner's knowledge. Trademark Rule 2.112(a).

All other submissions and papers in inter partes cases must be served via email unless the parties stipulate otherwise. There is an exception if the serving party encounters technical difficulties or other extraordinary circumstances, but the serving party must show by written explanation that service by email was attempted but could not be made. Trademark Rule 2.119(a) and (b).

#### **TIPS**

- The automatic filing notice that ESTTA generates when a submission is filed does not constitute service or relieve a party from complying with the service requirement. *Coffee Studio LLC v. Reign LLC d/b/a Coffee Studio*, 129 USPQ2d 1480, 1482 (TTAB 2019).

- Institution orders for cancellation proceedings are sent directly to the respondent itself, or to the respondent’s domestic representative, if one has been appointed. This is so even if there is an attorney of record because the Office treats the legal representation during prosecution of an application as terminated once a registration issues. Trademark Rule 2.113(c); TBMP § 310.01 (2021).

### **C. Pleadings and related motions**

#### **(i) Notice of Opposition and Petition to Cancel**

A well-drafted complaint puts the parties and the Board on clear notice of the pleaded claim(s) and may avoid needless and costly motion practice. To avoid ambiguity, consider using the statutory language to plead a claim, and set forth separate claims under separate headings. *Freki Corp. N.V. v. Pinnacle Entm’t, Inc.*, 126 USPQ2d 1697, 1702 (TTAB 2018). Note, however, that “citation of the wrong statute in a complaint is not generally considered a fatal misstep.” *Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at \*4-5 (TTAB 2020). In addition, keep in mind that the Board’s jurisdiction is limited to determining whether a mark is entitled to federal registration. Allegations of trademark infringement and unfair competition fall outside the Board’s jurisdiction and should not be included in a notice of opposition or petition to cancel.

Exhibits to a party’s pleading are not part of the trial record unless they are identified and introduced during the party’s testimony period. Trademark Rule 2.122(c). The one exception is that a federal trademark registration pleaded by the plaintiff is evidence of record if the complaint is accompanied by a copy of the registration prepared and issued by the USPTO showing the current status and title of the registration, or a printout of information from USPTO electronic database records showing the current status and title of the registration. Trademark Rule 2.122(d).

#### **TIPS**

- The Board recommends that a plaintiff make its pleaded registration(s) of record when it files the complaint. This helps focus discovery on matters in dispute and avoids the unfortunate situation in which a plaintiff has not properly made the pleaded registration(s) of record during its testimony period and, as a result, cannot establish entitlement to a statutory cause of action.
- Make sure to plead all elements of each claim. Consult Section 309.03(c)(1) of the TBMP for a list of frequently asserted grounds for opposition and cancellation.
- Grounds for cancellation of a registration five years or older are limited to those listed in Trademark Act Section 14(3) through (5). Do not use a claim of false suggestion of a connection under Trademark Act Section 2(a) to attempt to circumvent the five-year limitation. It is specifically different from a claim of likelihood of confusion under Section 2(d). *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 217 USPQ 505, 508 (Fed. Cir. 1983).

## (ii) Answer

In an answer, a defendant must admit, deny, or state that it is without sufficient knowledge to admit or deny each allegation set forth in the complaint. FED. R. CIV. P. 8(b). Do not include a boilerplate affirmative defense that the complaint fails to state a claim on which relief can be granted. If a pleading is insufficient, file a motion to dismiss pursuant to FED. R. CIV. P. 12(b)(6). Also, do not include in an answer pro forma defenses of laches or acquiescence. These defenses are severely limited in inter partes proceedings, and may not be available at all with respect to certain claims (e.g., fraud, abandonment, functionality and genericness). *But see Brooklyn Brewery Corp. v. Brooklyn Brew Shop, LLC*, 2020 USPQ2d 10914, at \*11, 13 (TTAB 2020) (finding laches and acquiescence established as to some goods); *TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1412 (TTAB 2018) (finding registrant's laches defense meritorious and denying petition for cancellation).

If a defendant is aware of grounds for a compulsory counterclaim when the answer is filed, the counterclaim should be pleaded at that time. Trademark Rules 2.106(b)(2)(i) and 2.114(b)(2)(i); *Jive Software, Inc. v. Jive Commc'ns, Inc.*, 125 USPQ2d 1175, 1180 (TTAB 2017). If grounds for a compulsory counterclaim are learned after an answer is filed, the defendant must promptly move to file a motion for leave to amend to add the counterclaim. *Id.* A defendant that fails to timely file a compulsory counterclaim may be precluded from asserting the counterclaim. *Freki Corp. N.V. v. Pinnacle Entm't, Inc.*, 126 USPQ2d 1697, 1701 (TTAB 2018).

## TIPS

- Do not embed a motion to dismiss or other motion in an answer. Board personnel generally do not read pleadings unless necessitated by a motion, so an embedded motion usually will not come to the Board's attention timely.
- A defendant must promptly inform the Board if it (or a party in privity) has filed a compulsory counterclaim that is the subject of another proceeding. Trademark Rules 2.106(b)(3)(i) and 2.114(b)(3)(i).

## (iii) Amendments to pleadings

The Board is liberal in allowing amendments to a pleading when justice so requires, FED. R. CIV. P. 15, but certain amendments are impermissible. Oppositions filed against applications based on a request for extension of protection under Section 66(a) of the Trademark Act are limited to the goods, services, and grounds set forth on the ESTTA cover sheet. Trademark Rules 2.104(c) and 2.107(b); *Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463, 1466-67 (TTAB 2017). Also, an opposition against an application under Trademark Act Section 1, 44, or 66(a) may not be amended to add a joint opposer after the close of the time period for filing an opposition. Trademark Rule 2.107.

## TIP

- When seeking to amend a pleading, identify the specific proposed changes in the motion. It is helpful for a party to include a copy of the proposed amended pleading with changes tracked.

### (iv) Motions or stipulations relating to late/no answer

A defendant that misses the deadline to file an answer should first contact the plaintiff to see if it will stipulate to late filing of the answer. If the plaintiff stipulates, the answer should be filed with a stipulation to reset the due date for the answer. If the plaintiff does not stipulate, the defendant should file its answer with a motion to cure default or reopen. The Board is liberal in allowing a defendant to cure default, but a defendant should not file a late answer without explanation. Default cannot be cured by a phone call to the Board.

## TIPS

- Plaintiffs should consent to late-filed answers because there is little chance that the Board will refuse to accept a late answer and enter default judgment. *Paolo's Assocs. Ltd. P'ship v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).
- The Board generally issues a notice of default about 10 days after the expiration of an answer deadline. To save the client the expense of a motion for default judgment, if 15 days have passed since the answer deadline, counsel may call the Board paralegal assigned to the case regarding status of the notice of default.

### (v) Motion to dismiss in lieu of answer

A motion to dismiss under FED. R. CIV. P. 12(b)(6) challenges whether the plaintiff's claim(s) are sufficiently pleaded, not whether the claim(s) can be proven. Accordingly, the parties should not argue the merits of the case on a motion to dismiss. *See, e.g., Petróleos Mexicanos v. Intermix S.A.*, 97 USPQ2d 1403, 1406 (TTAB 2010). Additionally, the Board will not consider matters outside the pleadings on a motion to dismiss under FED. R. CIV. P. 12(b)(6).

## TIPS

- A plaintiff may respond to a motion to dismiss by filing an amended pleading under FED. R. CIV. P. 15(a)(1)(B). The amended pleading will be accepted "as a matter of course" and will moot the motion under Rule 12(b)(6).
- Even in situations where a motion to dismiss is considered on its merits and is well-taken, the Board often will allow the plaintiff leave to amend the defective pleading.

#### **D. Discovery Conference**

Parties share an obligation to arrange and participate in a discovery conference within the deadline set by the Board to discuss the subjects set forth in FED. R. CIV. P. 26(f) and the Board's institution order. Trademark Rule 2.120(a)(1) and (2)(i); *Promgirl Inc. v. JPC Co.*, 94 USPQ2d 1759, 1761-62 (TTAB 2009); TBMP § 401.01 (2021). Settlement discussions are encouraged, but are not a substitute for the discovery conference. *Promgirl*, 94 USPQ2d at 1761-62.

A party may request Board participation in the discovery conference. Trademark Rule 2.120(a)(2)(i). This may be particularly helpful when a party is appearing pro se, when it appears that the claims or defenses have not been adequately pleaded, or if the case is one that might become unnecessarily contentious. A party can request Board participation in the discovery conference by telephone or through ESTTA using the form provided. Often, the Board is able to act more quickly on a telephone request. Additionally, when a party refuses or is unresponsive to requests to participate in the discovery conference, the adverse party may contact the assigned interlocutory attorney via telephone prior to the deadline to facilitate scheduling the conference. The Board also has the discretion to participate sua sponte in the discovery conference. *Id.*

#### **E. Accelerated Case Resolution**

Accelerated Case Resolution (ACR) is an abbreviated trial on the merits approximating a summary bench trial, available by stipulation of the parties. ACR, discussed in detail in TBMP § 702.04 (2021), can take almost any form the parties agree will move the proceeding forward in an efficient and expeditious manner. The earlier in a proceeding parties elect ACR, the greater the efficiencies, but even on the eve of trial, parties may agree to efficiencies, such as shortening the trial by combining trial and briefing periods. TBMP § 528.05(a)(2) (2021).

When ACR is adopted early in a proceeding, parties generally agree to abbreviate or forgo discovery and forfeit trial in favor of submitting briefs with attached evidence. Parties must agree that the Board may resolve any genuine disputes of material fact raised by the parties' filings or the record. *See, e.g., TPI Holdings, Inc. v. TrailerTrader.com, LLC*, 126 USPQ2d 1409, 1411-12 (TTAB 2018); *Chanel Inc. v. Makarczyk*, 106 USPQ2d 1774, 1776 (TTAB 2013); TBMP § 702.04(b) (2021). Parties may further stipulate to some or all facts and also may reach procedural agreements, such as stipulating to a page limit for briefs or to the admissibility of evidence and the types of evidentiary objections that may be raised. *University of Kentucky v. 40-0, LLC*, 2021 USQP2d 253, at \*6-7 (TTAB 2021); *TPI Holdings*, 126 USPQ2d at 1411-12; *Chanel*, 106 USPQ2d at 1775-76.

In addition, parties may stipulate to ACR when a motion for summary judgment or cross-motions for summary judgment have been filed and briefed. In this scenario, parties stipulate that the Board may make findings of fact on the summary judgment record, in lieu of adhering to the summary judgment standard that would require a finding that no genuine disputes of material fact exist for judgment to be granted to a party. *See, e.g.,*

*Weatherford/Lamb Inc. v. C&J Energy Servs. Inc.*, 96 USPQ2d 1834, 1836 (TTAB 2010); TBMP §§ 528.05(a)(2) and 702.04(c) (2021).

### **TIPS**

- Parties interested in ACR should request a telephone conference with the assigned interlocutory attorney, who can assist the parties in negotiating a suitable ACR stipulation.
- Parties not willing to stipulate to ACR still may agree to simplify proceedings by entering into a wide variety of factual and procedural stipulations. *See* Trademark Rule 2.120(a)(2)(iv); *see also Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1678 (TTAB 2007); TBMP § 702.04(e) (2021).

#### **F. Suspension for a civil action**

The Board generally orders suspension of a case when one or both parties are involved in a collateral civil action. All that need be shown is that the civil action **may** have a bearing on the Board proceeding. Trademark Rule 2.117(a).

The party that prevails in the civil action should file with the Board a motion to resume proceedings after time has elapsed for any appeal in the civil action. The motion should include the particular disposition of the Board case that the party believes is warranted and a copy of the court's final decision.

### **TIP**

- A party moving to suspend for a civil action should attach to its motion copies of the operative complaint and answer in the civil action. Failure to do so may delay consideration of the motion. TBMP § 510.02(a) (2021).

#### **G. Settlement and suspension for settlement**

Most Board cases settle. The simplest way to settle a Board case is to file a single stipulation, signed by each party, specifying whether the involved application or registration is to be amended, abandoned, or surrendered, and whether the Board case is to be dismissed with or without prejudice.

The mere existence of settlement negotiations does not discharge a party's obligation to comply with deadlines. Accordingly, it is prudent for parties involved in settlement discussions to stipulate to suspend proceedings. Such stipulations are subject to the right of either party to request resumption of the proceeding.

### **TIPS**

- The Board prefers that parties stipulate to suspend for settlement rather than stipulate to extend deadlines. If parties file multiple extensions for settlement

discussions, the Board may sua sponte suspend proceedings. Trademark Rule 2.117(c).

- The Board is liberal in granting suspension to accommodate settlement discussions, but parties seeking numerous suspensions for settlement will be required to provide evidence of their progress towards settlement in order to show good cause for continued suspension. The Board retains discretion to condition approval of a consented or stipulated motion to suspend on the parties providing updates on the status of settlement talks, discovery activities, or trial activities, as may be appropriate. *Id.*
- Do not move to suspend or extend deadlines for settlement after an answer is filed, but before the required discovery conference is completed. The Board is unlikely to find good cause to suspend because settlement is a subject to be discussed during the discovery conference. The Board will consider a motion to suspend or extend filed after the pleadings close but before the discovery conference is completed for a reason other than settlement.

## **H. Disclosures and Discovery**

### **(i) Initial Disclosures**

Initial disclosures must be made no later than 30 days after the opening of the discovery period. A party may not pursue discovery until it has made initial disclosures. Trademark Rule 2.120(a)(3); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010). Parties have a duty to timely supplement initial disclosures unless the supplemental information or documents have been disclosed during discovery. FED. R. CIV. P. 26(e)(1); *Sheetz of Del., Inc. v. Doctor's Assocs. Inc.*, 108 USPQ2d 1341, 1345 n.7 (TTAB 2013). A party that fails to timely supplement initial disclosures may be precluded from introducing the withheld information at trial. *Spier Wines (PTY) Ltd. v. Shepher*, 105 USPQ2d 1239, 1246 (TTAB 2012); *Great Seats Inc. v. Great Seats Ltd.*, 100 USPQ2d 1323, 1326, 1328 (TTAB 2011).

### **(ii) Standard Protective Order**

The Board's STANDARD PROTECTIVE ORDER automatically applies to every inter partes case, unless the parties stipulate to modify it or to substitute an alternative agreement and the Board approves the stipulation. Trademark Rule 2.116(g).

The Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a party's designation, or order parties to resubmit excessively redacted evidence and briefs. Trademark Rule 2.116(g); *see also McGowen Precision Barrels, LLC v. Proof Research*, 2021 USPQ2d 559, at \*3-4 (TTAB 2021); *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 n.9 (TTAB 2018); *Azalea Health Innovations, Inc. v. Rural Health Care, Inc.*, 125 USPQ2d 1236, 1238 (TTAB 2017).



### (iii) Written discovery

A party may seek discovery of any non-privileged matter that is relevant to the party's claims or defenses and proportional to the needs of the case. Trademark Rule 2.120(a)(1); *Emilio Pucci Int'l BV v. Sachdev*, 118 USPQ2d 1383, 1386 (TTAB 2016); *Domond v. 37.37, Inc.*, 113 USPQ2d 1264, 1268 (TTAB 2015). Because Board proceedings concern only the right to registration, discovery in a Board proceeding generally is more limited than discovery in a trademark infringement action.

Discovery requests must be served with at least 31 days remaining in the discovery period, counting the service date, so that responses are due before the close of discovery as required under Trademark Rule 2.120(a)(3). *Estudi Moline Dissey, S.L. v. BioUrn Inc.*, 123 USPQ2d 1268, 1270-71 (TTAB 2017). However, the duty to supplement or correct discovery responses continues after the close of discovery. FED. R. CIV. P. 26(e).

Interrogatories, document requests, and requests for admission are limited to 75 each, including subparts. Trademark Rule 2.120(d), (e) and (i); *One Jeanswear Grp. Inc. v. YogaGlo, Inc.*, 127 USPQ2d 1793, 1796-97 (TTAB 2018). One additional comprehensive request for admission independent of the 75 limit may be propounded to authenticate specific documents produced by an adverse party. Trademark Rule 2.120(i).

The period to respond to written discovery is 30 days. Trademark Rule 2.120(a)(3). Failure to respond timely to discovery requests may waive the right to assert merit-based objections (e.g., objections that a request is overly broad, vague, ambiguous, burdensome, oppressive, or not calculated to lead to the discovery of admissible evidence). *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1554 (TTAB 2000). Requests for admission are admitted as a matter of law when a party does not timely respond. FED. R. CIV. P. 36(a)(3); *Fram Trak Indus. Inc. v. Wiretracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006).

Objections to discovery requests must be stated with particularity. *Hewlett Packard Enter.*, 2019 USPQ2d 158663 at \*3-4 (TTAB 2019). A party also must indicate whether it is withholding documents based on an objection. FED. R. CIV. P. 34(b)(2)(C); *Hewlett Packard Enter.*, 2019 USPQ2d 158663 at \*4. Because the Board's STANDARD PROTECTIVE ORDER is automatically applicable, parties should not object to a discovery request on the ground that it seeks confidential information or documents, but rather should produce responsive information and documents designated under the appropriate tier of confidentiality. *Amazon Techs. Inc. v. Wax*, 93 USPQ2d 1702, 1706 n.6 (TTAB 2009). If a party asserts privilege, it must provide a privilege log. FED. R. CIV. P. 26(b)(5)(A).

### TIPS

- When drafting discovery requests, consult Section 414 of the TBMP, which sets out numerous examples of the types of information and documents that are discoverable in Board proceedings. Parties frequently come to the Board with

discovery disputes that could have been resolved easily had the parties reviewed Section 414 of the TBMP and the relevant case law.

- Under FED. R. CIV. P. 33(d), a party may produce business records in lieu of providing a written response to an interrogatory, but only when certain conditions are met. *Hewlett Packard Enter. Dev. LP v. Arroware Indus., Inc.*, 2019 USPQ2d 158663, at \*8-9 (TTAB 2019).
- Serve discovery requests early in the discovery period to ensure that time remains for follow-up discovery.
- Parties frequently agree to extend discovery response periods, however, they may not stipulate that responses are due after discovery closes. Trademark Rule 2.120(a)(3). Any agreement to extend discovery response periods should be reduced to writing to avoid misunderstandings and motions to compel. TBMP § 403.04 (2021).

#### (iv) **Discovery depositions**

The discovery deposition of a person will be taken in the Federal judicial district where the person resides or is regularly employed or anywhere the parties agree. Trademark Rule 2.120(b). The discovery deposition of a foreign party taken in a foreign country must be taken on written questions. Trademark Rules 2.120(c)(1) and 2.124. The Board will not order a person residing in a foreign country to come to the United States for his or her discovery deposition. *Jain v. Ramparts Inc.*, 49 USPQ2d 1429, 1431 (TTAB 1998).

The discovery deposition of a nonparty must be secured by subpoena unless the witness is willing to appear voluntarily. Any issues related to the discovery deposition of a nonparty by subpoena (e.g., a motion to quash the subpoena or for sanctions for defiance of the subpoena) are within the control of the district court that issued the subpoena; the Board has no jurisdiction to address such issues. *Ate My Heart, Inc. v. GA GA Jeans Ltd.*, 111 USPQ2d 1564, 1565 n.5 (TTAB 2014).

On stipulation of the parties or motion granted by the Board, a deposition may be taken by telephone or video conference. See FED. R. CIV. P. 30(b)(4); *Spliethoff's Bevrachtungskantoor B.V. v. United Yacht Transport LLC*, 2020 BL 227888, at \*10 (TTAB 2020); *Sunrider Corp. v. Raats*, 83 USPQ2d 1648, 1654 (TTAB 2007). The location of the telephonic or video deposition is the same as a regular deposition: where the witness resides or is regularly employed or where the parties agree.

If a party witness objects and refuses to answer a particular question, the propounding party may wait until the completion of the discovery deposition and then file a motion with the Board to compel the witness to answer the question.

## TIP

- Parties are limited to 10 discovery depositions under FED. R. CIV. P. 30(a)(2)(A)(i) and should plan accordingly. The Board is reluctant to grant leave to exceed 10 discovery depositions. *Spliethoff's Bevrachtingskantoor B.V. v. United Yacht Transport LLC dba United Yacht Transport*, 2020 USPQ2d 10605, at \*10 (TTAB 2020).

### (v) Disclosure of testifying experts

Experts are rarely used in Board cases because of the expense. A party that decides to use an expert witness must make an expert disclosure pursuant to FED. R. CIV. P. 26(a)(2) before the close of discovery. Trademark Rule 2.120(a)(2)(iii). When an expert is disclosed, the Board generally will suspend proceedings and issue any necessary orders to allow for expert discovery and the disclosure of rebuttal experts. Trademark Rule 2.120(a)(2)(iii).

#### I. Motions

The filing of a potentially dispositive motion automatically suspends proceedings with respect to all matters not germane to the motion. Trademark Rule 2.127(d). The Board also may suspend proceedings sua sponte. Trademark Rule 2.117(c).

The deadline to respond to a motion for summary judgment is 30 days. Trademark Rule 2.127(e). The period to respond to all other motions and to file reply briefs is 20 days. Trademark Rules 2.119 and 2.127. Reply briefs on motions are permitted but discouraged because they generally have little persuasive value. *No Fear Inc. v. Rule*, 54 USPQ2d 1551, 1553 (TTAB 2000).

Briefs in support of or in opposition to a motion may not exceed 25 pages; reply briefs are limited to 10 pages. Trademark Rule 2.127(a). These page limits cannot be waived or exceeded, even by agreement of the parties. Exhibits to a motion are not counted toward the page limit, but a table of contents, index of cases, or description of the record does count against the page limit.

The Board may grant a motion as conceded where the non-movant has failed to respond. Trademark Rule 2.127(a). Matters that are conceded or not potentially dispositive may be acted on by a single Administrative Trademark Judge, an interlocutory attorney, a Board paralegal, or order generated by ESTTA. Trademark Rule 2.127(c). An order “By the Board” has the same legal effect as an order issued by a three-judge panel. *Id.*

On the parties’ request or its own initiative, the Board may convene a telephone conference to decide a non-dispositive motion. Trademark Rule 2.120(j)(1). Telephone conferences are particularly helpful when a motion is time-sensitive (e.g., a motion to extend or a motion to quash a deposition).

The Board also may require the parties and their counsel to attend an in-person or telephone conference with an interlocutory attorney, judge, or panel of judges to resolve complex discovery or disclosure issues. Trademark Rule 2.120(j)(2); *see also, e.g., Blackhorse v. Pro Football Inc.*, 98 USPQ2d 1633, 1634 (TTAB 2011); *Gen. Mills Inc. v. Fage Dairy Processing Indus. SA*, 100 USPQ2d 1584, 1592 n.5 (TTAB 2011); TBMP § 502.06(a)-(b) (2021). The Board may also order the parties to attend a pretrial conference. Trademark Rule 2.120(j)(2); TBMP § 413.02 (2021).

### TIPS

- The time to file a reply brief will not be extended or reopened, even by stipulation of the parties. Trademark Rule 2.127(a).
- Any filing in the nature of a surreply, no matter the caption, will not be considered. Trademark Rule 2.127(a) and (e)(1); *Pioneer Kabushiki Kaisha v. Hitachi High Techs. Am. Inc.*, 74 USPQ2d 1672, 1677 (TTAB 2005). Accordingly, a movant should not file a motion to strike a surreply.

#### (i) Motions to extend or reopen

Motions to extend or reopen a deadline are governed by FED. R. CIV. P. 6. Good cause must be shown to obtain an extension of an unexpired period. FED. R. CIV. P. 6(b)(1)(A); *Trans-High Corp. v. JFC Tobacco Corp.*, 127 USPQ2d 1175, 1176 (TTAB 2018). *Am. Vitamin Prods. Inc. v. DowBrands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). Excusable neglect, which is a more onerous standard, must be shown to reopen an expired period. FED. R. CIV. P. 6(b)(1)(B); *Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380 (1993); *Pumpkin, Ltd. v. Seed Corps*, 43 USPQ2d 1582, 1585 (TTAB 1997).

If the Board denies a motion to extend or reopen, it is likely to leave schedules as set unless doing so would work some injustice (e.g., if the Board denies a motion to extend discovery, trial dates usually will be reset; if the Board denies a motion to extend a particular trial period, later periods likely will be reset). *Vital Pharms. Inc. v. Kronholm*, 99 USPQ2d 1708, 1711 (TTAB 2011).

### TIPS

- A party seeking an extension without consent should not propose specific new deadlines or dates. Instead, the movant should request an extension for a specified length of time, measured prospectively from the date of the Board's ruling on the motion. Otherwise, if the Board approves a motion to extend as uncontested, the movant may find that the requested extension period has expired.
- The mere fact that settlement negotiations are ongoing usually will not constitute excusable neglect to reopen an expired period. *Atlanta Fulton County Zoo Inc. v. DePalma*, 45 USPQ2d 1858, 1859-60 (TTAB 1998).

## (ii) Motions to compel

A motion to compel initial disclosures must be filed within 30 days after the initial disclosure deadline, while a motion to compel discovery must be filed before the day of the deadline for the plaintiff's pretrial disclosures. Trademark Rule 2.120(f)(1); *Asustek Comput. Inc. v. Chengdu Westhouse Interactive Entm't. Co.*, 128 USPQ2d 1470 (TTAB 2018). The Board will suspend proceedings pending the disposition of a motion to compel, except that the parties will remain obligated to serve initial disclosures, to respond to outstanding discovery requests, and to attend discovery depositions noticed prior to the filing of the motion to compel. If a motion to compel is filed after discovery has closed, the parties need not make pretrial disclosures until directed to do so by the Board. Trademark Rule 2.120(f)(2).

Discovery disputes almost always result from the parties' failure to cooperate, rather than from genuine differences of opinion about what is discoverable under the applicable law. The Board will consider the merits of a discovery dispute only where the movant has shown that it made a good-faith effort to resolve the dispute and that the parties were unable to resolve their differences. Trademark Rule 2.120(f)(1); *see also Hot Tamale Mama...and More, LLC v. SF Invs., Inc.*, 110 USPQ2d 1080, 1081 (TTAB 2014). A showing of a good-faith effort requires more than one telephone call, letter, or email exchange. The Board expects that the parties will engage in a meaningful effort to understand their differences and investigate ways to resolve their dispute. *Hot Tamale Mama*, 110 USPQ2d at 1081; *Sentrol, Inc. v. Sentex Sys., Inc.*, 231 USPQ 666, 667 (TTAB 1986).

To demonstrate a good-faith effort, a movant should include in its motion the dates on which the parties communicated regarding the discovery dispute and a summary of such discussions, along with copies of any relevant correspondence. *Hot Tamale Mama*, 110 USPQ2d at 1081. When no discovery responses have been provided, the showing of a good-faith effort need not be as great as when there is a dispute over the sufficiency of responses or the propriety of objections. The Board may deny a motion to compel where the parties have failed to narrow the disputed requests to a reasonable number. *Sentrol*, 231 USPQ at 667.

## TIPS

- Parties have a duty to cooperate under the Federal Rules of Civil Procedure and the Trademark Rules. The Board looks with extreme disfavor on those who do not cooperate in the discovery process. TBMP § 408.01 (2021).
- To the extent possible, group related discovery requests together in a motion to compel. This will streamline the issues for the Board.

## (iii) Motions for discovery sanctions

A party may move for discovery sanctions where its adversary fails to comply with a prior Board order relating to discovery. Trademark Rule 2.120(h)(1); *Fifth Generation Inc. v. Titomirov Vodka LLC*, 2019 USPQ2d 418666, at \*4-6 (TTAB 2019); *Baron Philippe de*

*Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1854 (TTAB 2000). A party also may seek sanctions (without first moving to compel) where an adversary fails to participate in the required discovery conference or unequivocally states that it will not make required disclosures, respond to discovery requests, or appear for a properly noticed deposition. Trademark Rule 2.120(h)(2); TBMP § 527.01(b) (2021).

The Board may impose a range of discovery sanctions, including striking all or part of a party's pleading, prohibiting a non-complying party from relying on certain evidence at trial, and entering judgment against a disobedient party. Trademark Rule 2.120(h)(1) and (2). The Board will not hold a party in contempt or award expenses, including attorneys' fees.

#### (iv) **Motions for summary judgment and Rule 56(d) discovery**

A party moving for summary judgment bears the burden of demonstrating the absence of any genuine disputes of material fact, and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986); *Sweats Fashions Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1795 (Fed. Cir. 1987). This is a difficult burden to satisfy in Board proceedings, where the claims and defenses at issue generally are fact-intensive. But where the burden is met, summary judgment may avoid a costly and time-consuming trial. *See, e.g., Kellogg Co. v. Pack'em Enters. Inc.*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861 (TTAB 2016); *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409 (TTAB 2015).

A party may seek summary judgment only on pleaded claims or defenses. FED. R. CIV. P. 56(a). The Board will not entertain a motion for summary judgment on an unpleaded claim or defense unless the non-movant does not object on this basis and the parties treat the unpleaded issue on its merits or the movant simultaneously moves to amend its complaint to add the unpleaded claim or defense. *See Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994), *aff'd mem.*, 108 F.3d 1392 (Fed. Cir. 1997); TBMP § 528.07(a) (2021).

A motion for summary judgment may not be filed until after the moving party has made initial disclosures (except for a motion asserting claim or issue preclusion or lack of Board jurisdiction). A summary judgment motion must be filed before the day of the plaintiff's deadline to serve pretrial disclosures. Trademark Rule 2.127(e)(1); *KID-Systeme GmbH v. Türk Hava Yollari Teknik-Anonim Sirketi*, 125 USPQ2d 1415, 1416 (TTAB 2018).

If a party believes that it cannot effectively respond to a motion for summary judgment without first taking discovery, it may file a motion pursuant to FED. R. CIV. P. 56(d) to take the needed discovery. Such a motion must be filed within 30 days of service of the motion for summary judgment. This deadline will not be extended or reopened. Trademark Rule 2.127(e)(1). A motion for Rule 56(d) discovery must be supported by an affidavit or declaration setting forth the specific subjects on which discovery is needed and why such evidence cannot be obtained other than from the party that filed the motion for summary judgment. *See* FED. R. CIV. P. 56(d); *Opryland USA Inc. v. Great Am. Music Show Inc.*,

970 F.2d 847, 23 USPQ2d 1471, 1474 (Fed. Cir. 1992); *Chavakula v. Praise Broadcasting aka Praise FM*, 2020 USPQ2d 10855, at \*3-4 (TTAB 2020).

Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. However, if any motion for summary judgment is denied, the parties may stipulate that the materials submitted with briefs on the motion be considered as trial evidence, which may be supplemented by additional evidence during trial.

### TIPS

- A motion for summary judgment or opposition thereto must be supported with evidence. FED. R. CIV. P. 56(c)(1). A plaintiff moving for summary judgment must remember to include proof of entitlement to a statutory cause of action. Too often, the Board sees motions for summary judgment woefully lacking in probative evidence.
- Do not file a combined response to a motion for summary judgment and a cross-motion for discovery under FED. R. CIV. P. 56(d). The response brief is likely to demonstrate that discovery is not needed to respond. *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes Inc.*, 63 USPQ2d 2009, 2012 n.8 (TTAB 2002); TBMP § 528.06 (2021).
- Parties should avoid filing motions for summary judgment on claims of fraud. The factual question of intent, an element of a fraud claim, is particularly unsuited to disposition on summary judgment. *Copelands' Enters. Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295, 1299 (Fed. Cir. 1991); *DaimlerChrysler Corp. v. Am. Motors Corp.*, 94 USPQ2d 1086, 1090 (TTAB 2010).

### J. Pretrial disclosures, trial and briefing

The submission of notices of reliance, declarations, and affidavits, as well as the taking of depositions during assigned testimony periods correspond to the trial in court proceedings. Trademark Rule 2.116(e).

At trial, parties often confuse what evidence is automatically of record and what must be submitted. Pledged registrations are **not** automatically of record.

The files of opposed applications and registrations subject to petition for cancellation are automatically in the trial record and should not be resubmitted. Trademark Rule 2.122(b)(1). Statements made in affidavits and declarations in application and registration files, however, are not testimony on behalf of the applicant or registrant. Trademark Rule 2.122(b)(2).

#### (i) Pretrial Disclosures

Fifteen days before the opening of each testimony period, a party must disclose witnesses from whom it will take testimony or may call if the need arises or state that it plans to

submit no witness testimony. Trademark Rule 2.121(e); TBMP § 702.01 (2021). If a testimony deposition is noticed of a witness either not identified or improperly identified in pretrial disclosures, a party may move to quash the deposition. *Id.* Similarly, a party may move to strike a testimony affidavit or declaration of a witness not identified or improperly identified in pretrial disclosures. A party, however, need not disclose each document or exhibit it plans to introduce at trial. *Kate Spade LLC v. Thatch, LLC*, 126 USPQ2d 1098, 1103 (TTAB 2018); TBMP § 702.01 (2021).

## (ii) Testimony

A party may submit testimony in the form of a testimony deposition or an affidavit or declaration, subject to the right to cross-examination by the adverse party. Trademark Rule 2.123(a)(1) and (c); *M/S R.M. Dhariwal (HUF) 100% EOU v. Zarda King Ltd. and Global Tech. & Trade Marks Ltd.*, 2019 USPQ2d 149090, \*2-3 (TTAB 2019); *USPS v. RPost Commc'n Ltd.*, 124 USPQ2d 1045, 1046 (TTAB 2017). Absent a stipulation, a testimonial affidavit or declaration must be executed during the assigned testimony period. Trademark Rule 2.121(a); *Robinson v. Hot Grabba Leaf, LLC*, 2019 USPQ2d 149089, \*3-4 (TTAB 2019). Cross-examination of a witness in the United States must be taken orally; cross-examination of a witness outside the United States must be taken on written questions. Trademark Rule 2.123(a)(1) and (a)(2); *Empresa Cubana Del Tabaco dba Cubatabaco v. Gen. Cigar Co., Inc.*, 2019 USPQ2d 227680, at \*1-2 (TTAB 2019); *Andrusiek v. Cosmic Crusaders, LLC*, 2019 USPQ2d 222984, at \*2-3 (TTAB 2019). Redirect examination is permitted of a testimony declarant the same as a testimony deponent. *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at \*5 (TTAB 2020).

The manner in which an objection is made to testimony depends on the nature of the objection. If an objection could be cured if seasonably made, it must be raised promptly or it may later be found waived. Thus, for example, an objection that a deposition was taken without adequate notice must be promptly raised by a motion to strike. Trademark Rule 2.121(e) and 2.123(e)(3). Similarly, an objection to foundation or that exhibits to testimony were not adequately disclosed in pretrial disclosures may be waived if not promptly raised. *Moke Am. LLC v. Moke USA, LLC*, 2020 USPQ2d 10400, at \*5 (TTAB 2020); *Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at \*7 (TTAB 2020); *Int'l Dairy Foods Assoc. v. Interprofession du Gruyère and Syndicat Interprofessionnel de Gruyère, et al.*, 2020 USPQ2d 10892, at \*3-4 (TTAB 2020).

The manner for raising a procedural (or curable) objection to testimony by declaration or affidavit depends on the circumstances of the case. The non-proffering party may: (1) conduct oral cross-examination and object on the deposition record; (2) serve an objection on the offering party, file the objection with the Board, and assert the objection in its brief; or (3) file a motion to strike no later than the 20 days allowed to elect cross-examination. *Moke Am. LLC*, 2020 USPQ2d 10400, at \*6. If testimony is by deposition, a procedural objection is timely if it is raised during the deposition and maintained in the party's trial brief. *Id.* at \*5.



Objections to the substance of testimony may be made in a deposition or motion to strike renewed in the trial brief or in a motion to strike testimony filed at the time of briefing. *See* TBMP § 707.03(c) (2021). As a general rule, motions to strike testimony will be deferred until final decision if deciding the motion would require reading the testimony. Trademark Rule 2.123(j); *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1167 (TTAB 2017). If a deferred motion to strike is not renewed in a trial brief, it may be deemed waived. *McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559, at \*13-14 (TTAB 2021).

Trademark Rules 2.123(f)(2) and 2.125(d) concern **filing** requirements for testimony depositions; Trademark Rules 2.125(a)-(c) concern **service** requirements. Parties should be served with copies of the transcript within 30 days of the deposition. Corrected, certified transcripts need only be filed prior to final hearing to be considered timely.

### TIPS

- Deposition testimony must be submitted in written form. Transcripts must be full-sized (not condensed to multiple pages per sheet), and must include a word index. Trademark Rule 2.123(g)(1) and (3).
- Testimony declarations should be filed and served separately, rather than as exhibits to a notice of reliance. *Ricardo Media Inc. v. Inventive Software, LLC*, 2019 USPQ2d 311355, at \*2-3 (TTAB 2019); *WeaponX Performance Prods. Ltd. v. Weapon X Motorsports, Inc.*, 126 USPQ2d 1034, 1037 (TTAB 2018).
- A party may introduce through witness testimony documents and other exhibits that may not be made of record by notice of reliance. Be selective, however, in the introduction of exhibits to testimony. For example, the Board does not need to see every advertisement or every catalog. A representative sample is sufficient, with accompanying testimony about the extent of publication, circulation figures and the like which would bear on the degree of exposure to the relevant public. Too often, witnesses are asked during deposition simply to read what is in exhibits, without being asked important questions necessary to establish the foundation for introduction of the exhibit, knowledge of the subjects discussed in the exhibit, or even being asked if the exhibit accurately reflect what the witness knows.
- If a party wishes to make its registrations of record through testimony, the witness must have knowledge of the registrations and must specifically testify as to the title and status of each, i.e., that the party is the owner and that the registration is currently in effect. It is not unusual for a witness to be asked to “identify” a registration by reading the number, mark, and listed goods or services, without ever being asked to testify from personal knowledge that the party owns the registration and that it is valid (i.e., current and any necessary post registration filings have been made to maintain it).

- All exhibits must be submitted electronically and must be clear and legible. Trademark Rule 2.126(a). It is a party's duty to ensure that all evidence is properly made of record. *Luxco, Inc. v. Consejo Regulador del Tequila, A.C.*, 121 USPQ2d 1477, 1508 n.195 (TTAB 2017).

### (iii) Notices of reliance

Trademark Rule 2.122(g) addresses procedures for notices of reliance. Trademark Rules 2.120(k), 2.122(d)(2), 2.122(e)(1) and (e)(2) delineate the types of evidence that may be submitted by them, including registrations owned by a party, printed publications and official records, and internet materials.

As explained in the ex parte discussion *supra*, the Board does not take judicial notice of USPTO records. Third-party registrations may be made of record by submitting plain copies of the registrations or of electronic printouts retrieved from the database of the USPTO. Trademark Rule 2.122(e)(1); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1070 n.11 (TTAB 2011). Lists of such registrations and trademark search reports from private company databases are inadequate. TBMP § 704.03(b)(1)(B) (2021).

Evidence submitted by notice of reliance, as for other trial evidence, must be filed electronically, and must be clear and legible.<sup>1</sup> Trademark Rule 2.126(a).

### TIPS

- A notice of reliance must indicate generally the relevance of the evidence and associate it with one or more issues in the proceeding. Trademark Rule 2.122(g). Failure to meet this requirement is a curable procedural defect. *Id.*; see also *Barclays Capital Inc. v. Tiger Lily Ventures Ltd.*, 124 USPQ2d 1160, 1165 (TTAB 2017). Thus, this requirement should not be viewed as fertile ground for motion practice.
- Be judicious in submitting discovery responses to the Board and submit only those that advance the case. Bear in mind that denials of requests for admission and written responses to document requests (other than statements that no responsive documents exist) are inadmissible. Trademark Rule 2.120(k)(3)(i); *Hunter Indus., Inc. v. Toro Co.*, 110 USPQ2d 1651, 1657 n.13 (TTAB 2014); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1957 & n.10 (TTAB 2008).
- Documents may be authenticated through one comprehensive request for admission or stipulation and may be submitted by notice of reliance (along with the relevant request and admission or stipulation). Trademark Rule 2.120(k)(3)(ii) and 2.120(i); *Int'l Dairy Foods Assoc. v. Interprofession du*

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<sup>1</sup> Evidence that by its nature cannot presently be submitted through ESTTA, such as DVDs, must be mailed to the Board. This exception does **not** apply to bulky documents, which must be submitted via ESTTA. Trademark Rule 2.123(f)(2).

*Gruyère and Syndicat Interprofessionel de Gruyère, et al.*, 2020 USPQ2d 10892, at \*2 (TTAB 2020). Authenticated documents, however, remain subject to all Federal Rules of Evidence and may constitute hearsay if offered to prove the truth of the matter asserted.

- Although Trademark Rule 2.122(e)(2) allows for the submission of internet material under notice of reliance, in the absence of witness testimony, a website is admissible only for what is shown on its face. *See Spiritline Cruises LLC v. Tour Mgmt. Servs., Inc.*, 2020 USPQ2d 48324, at \*3-4 (TTAB 2020).

**(iv) Dismissal for failure to prosecute or file brief**

When a plaintiff has failed to file any evidence, or has filed only copies of pleaded registrations that the defendant believes are insufficient to allow the plaintiff to carry its burden of proof, the defendant may move for dismissal. Trademark Rule 2.132(a) and (b). The Board also may grant judgment for the defendant sua sponte when it is clear from the proceeding record that the plaintiff has taken no testimony or offered any other evidence during its testimony period. Trademark Rule 2.132(a).

When a plaintiff fails to timely file a brief on the case, the Board may issue an order to plaintiff to show cause why the case should not be dismissed as conceded. If a plaintiff files a response to the order and shows good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against the plaintiff for failure to submit evidence. Trademark Rule 2.128(a)(3); *see also* TBMP § 536 (2021).

**(v) Briefs and evidentiary objections**

Briefs should discuss the pertinent facts of a case in light of the relevant statutory and case law. All briefs should adhere to the page limits in Trademark Rule 2.128(b): 55 pages for main briefs and 25 pages for reply briefs. If a party files a brief in excess of the page limit without prior leave of the Board, the brief may not be considered. *Id.* Briefs must meet the requirements of Trademark Rule 2.126 and must contain an alphabetical index of cited cases, which is included in the page limit.

Evidentiary objections may either be raised in a party's brief on the case or set out in a separate appendix, which does not count against the briefing page limit. Trademark Rule 2.128(b).

**TIPS**

- Always cite the relevant record evidence by its location in TTABVUE; *e.g.*, 10 TTABVUE 15-16. A party that does not cite to TTABVUE docket entries “plac[es] the persuasiveness of their presentation at risk.” *RxD Media, LLC v. IP Application Dev. LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018).

- Parties are reminded that inter partes proceedings are akin to a bench trial. The Board is capable of weighing the inherent strength or weakness of evidence. *McGowen Precision Barrels, LLC v. Proof Research, Inc.*, 2021 USPQ2d 559, at \*14-15 (TTAB 2021); *Peterson v. Awshucks SC, LLC*, 2020 USPQ2d 11526, at \*3-4 (TTAB 2020); *Société des Produits Nestlé S.A. v. Cándido Viñuales Taboada*, 2020 USPQ2d 10893, at \*7-8 (TTAB 2020).
- If an evidentiary objection is deferred until final decision, the objecting party must renew the objection in its trial brief or it may be waived. *McGowen Precision Barrels, LLC*, 2021 USPQ2d 559, at \*13.

#### **K. Oral hearing**

An oral hearing will be scheduled by the Board on request of at least one of the parties and payment of the requisite fee. Trademark Rule 2.6(a)(24). Each side is allotted 30 minutes, and a plaintiff may reserve some of its time for rebuttal.

At hearing, stick to the facts of the case. The judges will have read the briefs but generally will not have reviewed the record and therefore may have questions about what is in the record and what is not.

#### **TIPS**

- Counsel must know the record and should be prepared to outline the most important aspects of the case at the hearing. The primary focus at the hearing, however, should be to answer questions asked by the panel and engage the judges in conversation about the case. For this reason, PowerPoint presentations are ineffective and strongly discouraged.
- If using a demonstrative exhibit, bear in mind that at least one judge is likely to participate in the hearing remotely. Therefore, be prepared with the record citation to the exhibit. New evidence should not be introduced at a hearing.

#### **IV. JUDICIAL REVIEW OF TTAB DECISIONS**

There are two mutually exclusive avenues of appeal from final decisions of the Board in both ex parte and inter partes cases. First, a party may appeal to the U.S. Court of Appeals for the Federal Circuit, which will review the decision from which the appeal is taken on the record before the USPTO. Second, a party may have remedy by civil action in a U.S. District Court. Appeals are discussed in detail in TBMP Chapter 900.

#### **TIPS**

- A notice of appeal or commencement of a civil action must be filed within 63 days (i.e., nine weeks) from the date of the final decision of the Board. Trademark Rule 2.145.

- Copies of notices of appeal, notices of election, and notices of civil action must be filed with the Board via ESTTA and separately with the Office of the General Counsel.
- Parties seeking review of ex parte decisions by way of civil action must serve the summons and complaint on the Director addressed to the Office of the General Counsel and a copy of the complaint via ESTTA.
- A notice of a civil action for review of a Board decision in an inter partes case must be filed no later than five business days after filing the complaint in district court, and must identify the civil action with particularity, i.e., by case name, case number, and court.
- It is unnecessary to request reconsideration before filing an appeal of a Board decision, but a party requesting reconsideration must do so before filing a notice of appeal or a civil action.
- Pursuant to Trademark Act Section 21(b)(3), in cases where there is no adverse party, the appealing party pays “all expenses” whether or not the appeal succeeds. *See Shammass v. Focarino*, 784 F.3d 219, 114 USPQ2d 1489 (4th Cir. 2015) (ordering applicant to pay \$36,320 in USPTO expenses); *but see Peter v. NantKwest, Inc.*, 589 U.S. \_\_\_, 2019 USPQ2d 474054 (2019) (USPTO cannot recover salaries of its attorneys and paralegals).