

UNITED STATES
PATENT AND TRADEMARK OFFICE



Practical Tips and Updates from the TTAB

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Trademark Trial and Appeal Board



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Updates from the TTAB

TTAB workload: Fiscal year 2022

- Appeals: 3,240
- Extensions of time to oppose: 16,814
- Oppositions: 6,989
- Cancellations: 2,285
- Concurrent Use: 27

Ex parte appeals

Fiscal year ending September 30, 2022

New appeals filed: 3,213

Appeals terminated without formal decision: 2,484

Final decisions issued: 392

Appeals pending: 1,854

Oppositions and cancellations

- Fiscal year ending September 30, 2022
- New proceedings filed: 8,999
 - Oppositions: 6,702
 - Cancellations: 2,290
- Proceedings terminated
 - Without decisions: 9,154
 - **Final decisions issued: 169**
- Proceedings pending: 7,340

TTAB updates

- Trademark Modernization Act of 2020
- TTAB decision precedential decision nomination (re-designation) form
- Pretrial Conference pilot program
- Renewal of in-person (and hybrid) hearings
- New TTAB judges: Wendy Boldt Cohen, Jennifer L. Elgin, and Thomas L. Casagrande

Expungements and reexaminations

- Expungement must be requested between three and ten years after registration date. Additionally, until December 27, 2023, expungement may be requested for any registration at least three years old
- Reexamination must be requested within the first five years after registration
- The Director may institute an ex parte expungement or reexamination on the Director's own initiative
- The determination whether or not to institute an expungement or reexamination proceeding is final and non-reviewable and cannot be the subject of an appeal
- The Board has received its first appeals from reexaminations

Re-designation of non-precedential decisions as precedential

- The Board now allows for nominations of issued decisions to be re-designated as precedents:
uspto.gov/trademarks/trademark-trial-and-appeal-board/ttab-decision-nomination
- Apparently rarely used

Pretrial Conference pilot program

- Not intended for use in all (or even most) cases
- Cases will be selected for inclusion in the program based on various factors, including anticipated size of the record, past motion practice, etc.
- After an initial orientation conference, parties will prepare/submit a proposed final pretrial conference order using a model template provided by the Board
- Parties will participate in final pretrial conferences before a Board judge and attorney
- The Board will issue a final pretrial conference order governing trial

Ex parte appeals

Procedure: Ex parte appeals

- Final refusal to register or second refusal on the same issue
- Must file an appeal within a set period from issuance of the final office action
 - Three months for an application
 - Optional three-month extension may be requested for a fee
 - Six months for a Madrid application (Trademark Act § 66(a))
 - Three months for a registration
- No new evidence permitted during appeal
- Appellant and examining attorney submit briefs
- Appellant may request oral hearing
 - Participation by video optional

Grounds for refusal (1 of 3)

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

Grounds for refusal (2 of 3)

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

Grounds for refusal (3 of 3)

- § 3 – Applies to service marks
- § 4 – Applies to collective and certification marks
- § 5 – Use by related companies
- § 6 – Disclaimers
- § 23 – Supplemental register

5 Do's and don'ts in appeals

- Do make a complete record during prosecution (including declarations)
- Do consider the elements of the claim that need to be proven to provide the outline for development of the record and presentation in the briefs
- Don't argue the actual use of the involved marks in a Section 2(d) appeal except in the very rare circumstances in which that is appropriate
- Don't argue a *DuPont* factor in a Section 2(d) appeal where you have no good argument
- Don't attach any materials to your appeals briefs unless they are properly the subject of judicial notice

Inter partes (trial) proceedings

Opposition: Filing

- Registration may be opposed by any party which believes it would be damaged by registration
- Opposer must file a notice of opposition within thirty days of publication or within a granted extension of time to oppose
- Must include the filing fee
- May be based on any ground for refusal of registration

Cancellation: Filing

Same as opposition but filed after registration

- **Within five years of registration** – cancellation may be based on any ground for refusal
- **After three years of registration** – mark was never used
- **After five years** – grounds for cancellation limited, including:
 - Genericness
 - Functionality
 - Abandonment
 - Obtained by fraud
 - Likelihood of confusion and descriptiveness are *not* available after five years

Grounds to oppose/cancel

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

Inter partes timeline: Pleadings

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



Pleading tips

- Need not outline entire case or evidence at the pleading stage
- Aside from pleaded registrations, exhibits to pleadings are not evidence on behalf of the party to whose pleading they are attached
- Defenses must set forth sufficient facts to provide fair notice for the basis of each defense
- The time to act against an application runs from when the mark was published for opposition; laches and acquiescence are generally unavailable defenses in oppositions
- Some defenses are not available against all grounds. For example, equitable defenses are unavailable against fraud, abandonment, and descriptiveness due to public interest

Inter partes timeline: Discovery

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

Discovery tips

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

Inter partes timeline: Trial

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

Trial tips

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

Inter partes timeline: Briefing

- **Briefs:** Written arguments on law and facts
 - No new evidence
 - Attachments discouraged (and usually ignored)
 - Page limits strictly enforced
 - Cite to evidence by referencing the TTABVUE record
- **Plaintiff's brief**
 - 55 pages maximum
 - Due 60 days after close of rebuttal testimony
- **Defendant's brief**
 - 55 pages maximum
 - Due 30 days after due date of plaintiff's brief
- **Rebuttal brief**
 - 25 pages maximum
 - Due 15 days after due date of defendant's brief

Inter partes timeline: Oral hearing

- Scheduled only at the request of either party
- Attendance of non-requesting party not required
- Participation by video optional
- Not a formal part of the record; no transcript or recording
- No new evidence or testimony at hearing
- Now again offered in person

Inter partes timeline: Decision

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

Abbreviated proceedings

- Motion to dismiss for failure to state a claim
 - When the facts alleged do not constitute grounds for relief, the proceeding may be dismissed
- Motion for summary judgment
 - No genuine dispute of material fact
 - Movant is entitled to win as a matter of law
- Accelerated Case Resolution (ACR)
 - Similar to summary judgment, but the Board may determine disputed facts

Alternative Dispute Resolution

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

Review of Board decisions

- Judicial review of Board's decision
 - Must be taken within sixty-three days of final decision
- U.S. Court of Appeals for the Federal Circuit
 - Appeal on the administrative record
 - Briefs and oral argument
- United States District Court
 - Administrative record
 - New testimony or evidence allowed
 - De novo review by new trial

5 Do's and don'ts in trial cases

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



Useful resources

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

Other USPTO links

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



Notable Recent Decisions

- Jack Daniel's Properties, Inc. v. VIP Products LLC, 143 S. Ct. 1578, 2023 USPQ2d 677 (2023)
- Abitron Austria GmbH v. Hetronic International, Inc., ___ S. Ct. ___, 2023 USPQ2d 760 (2023); Ahal Al-Sara Group for Trading v. American Flash, Inc., 2023 USPQ2d 79 (TTAB 2023)
- In re Elster, petition for a writ of certiorari granted June 5, 2023
- Spireon, Inc. v. Flex Ltd., (Fed. Cir. 2023)
- Common Sense Press Inc. d/b/a Pocket Jacks Comics v. Ethan Van Sciver and Antonio J. Malpica, 2023 USPQ2d 601 (TTAB 2023)

