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## **TRADEMARK OFFICE COMES TO CALIFORNIA**

Practical Tips and Updates from the TTAB  
Tuesday and Thursday, June 13 & 15, 2023  
1:45 p.m. – 2:45 p.m.

MCLE: 1 Hour

Speakers:

Judge Christopher Larkin, TTAB  
Interlocutory Attorney Mary Beth Myles

### **Conference Reference Materials**

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UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Practical Tips and Updates from the TTAB

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Trademark Trial and Appeal Board



UNITED STATES  
PATENT AND TRADEMARK OFFICE ®

# 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# Re-designation of non-precedential decisions as precedential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](https://www.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 a different approach and refined arguments on appeal from those adopted and made during prosecution
- Don't argue the actual use of the involved marks in a Section 2(d) appeal except in the very rare circumstances in which that is appropriate
- Don't argue a *DuPont* factor in a Section 2(d) appeal where you have no good argument
- Don't attach any materials to your appeals briefs unless they are properly the subject of judicial notice

**Inter partes (trial) proceedings**

# 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** – expungement
- **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 allege a prima facie case or 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](http://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog)

# Other USPTO links

- USPTO home page
  - [www.uspto.gov](http://www.uspto.gov)
- Trademark Examining Operations
  - [www.uspto.gov/trademark](http://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](http://www.uspto.gov/ttab)
    - File TTAB documents (ESTTA)
    - View TTAB dockets and files (TTABVUE)
    - Statute and Rules
    - TTAB Manual (TBMP)



