

UNITED STATES
PATENT AND TRADEMARK OFFICE



Introduction to the Trademark Trial and Appeal Board (TTAB)

Christopher C. Larkin

Administrative Trademark Judge

Trademark Trial and Appeal Board



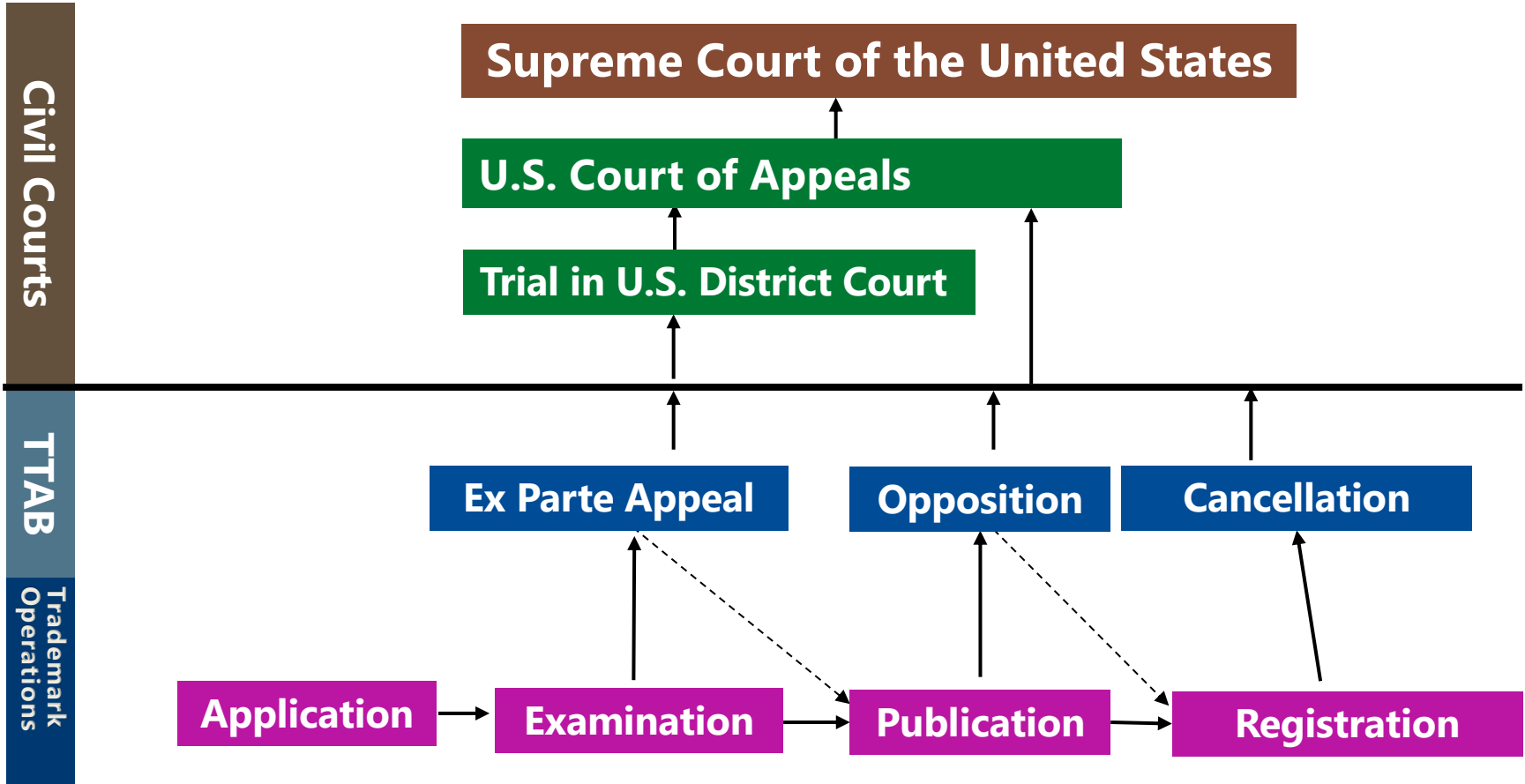
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General information about TTAB

Trademark Trial and Appeal Board

- Established in 1958 to streamline administrative proceedings
- In 1993, the title of the decision makers was changed from “Board members” to “Administrative Trademark Judges”
- The leadership title was changed from “Chairman of the Board” to “Chief Administrative Trademark Judge;” four individuals have held this position
- In 2000, a Managing Interlocutory Attorney position was created; five individuals have held this position
- In 2012, a Senior Level position for the editor of the TTAB Manual of Procedure (TBMP) was established; one individual has held this position
- In 2015, the position of “Deputy Chief Administrative Trademark Judge” was created; two individuals have held this position

Administrative proceedings



Types of proceedings

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

Limited jurisdiction

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

Board personnel

- Chief Administrative Trademark Judge
- Deputy Chief Administrative Trademark Judge
- Senior Attorney and TBMP Editor
- Managing Interlocutory Attorney
- Administrative Trademark Judges
- Interlocutory Attorneys
- Chief Clerk
- Lead Paralegal and Paralegals
- Administrative Officer
- Administrative & Technical Staff

Administrative trademark judges

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

Interlocutory attorneys

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

Paralegals

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

Client services

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



The rest...

- Chief clerk
- Analytics and information technology
- Administrative staff
 - TTAB administrative officer
 - Human capital
 - Budget and contracts
 - Telework, communications and space
 - Visual information

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

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
 - Six months for an application
 - 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

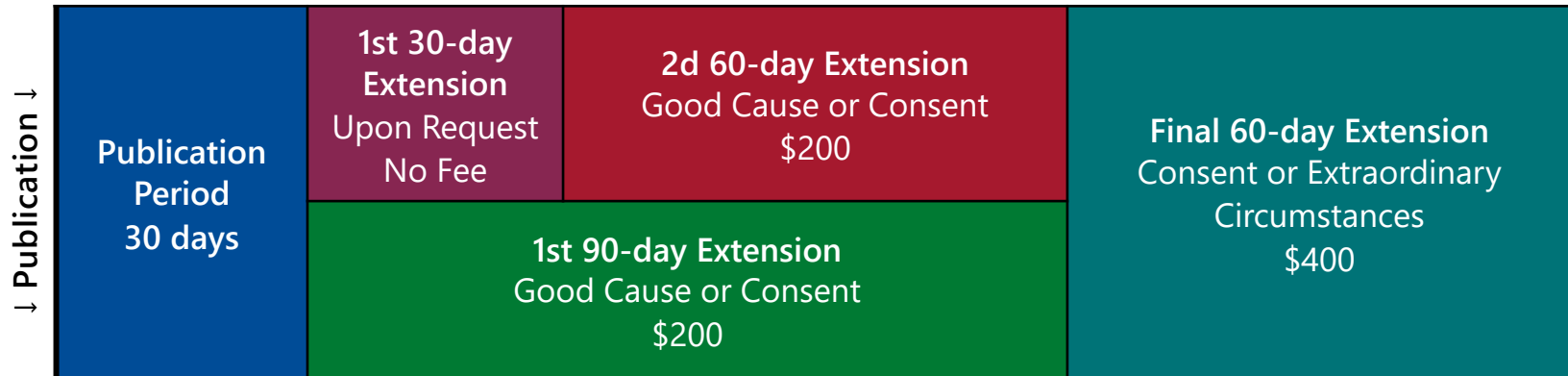
Grounds for refusal (3 of 3)

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

Inter partes (trial) proceedings

Publication for opposition

- Official Gazette – published weekly
- Initial opposition period is 30 days
- Extensions of time to oppose may be granted to a maximum of 180 days from publication
- Fee is per application



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

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**

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

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; currently required
- Not a formal part of the record; no transcript or recording
- No new evidence or testimony at hearing

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

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 \(TTAB electronic dockets and case files\)](#)
 - <http://ttabvue.uspto.gov/ttabvue/>
- [TTAB decision summaries at TTAB Reading Room](#)
 - <https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions>
- [Official Gazette of the USPTO](#)
 - www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog

Other USPTO links

- USPTO home page
 - www.uspto.gov
- Trademark Examining Operations
 - www.uspto.gov/trademark
 - Search pending and registered trademarks (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)



