

UNITED STATES  
PATENT AND TRADEMARK OFFICE



# Introduction to and Best Practices Before the Trademark Trial and Appeal Board (TTAB)

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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 attorney 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

# 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](mailto: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

**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
    - Optional one-month extension may be requested for a fee
- No new evidence permitted during appeal
- Appellant and examining attorney submit briefs
- Appellant may request oral hearing
  - Participation by video optional

# Evidence on appeal

- The record in an application should be complete before an appeal is filed. Trademark Rule 2.142(d)
- Do not attach evidence to an appeal brief

*In re Integra Biosciences Corp.*, 2022 USPQ2d 93, at \*7-8 (TTAB 2022)

*In re Fallon*, 2020 USPQ2d 11249, at \*2 (TTAB 2020)

# Evidence on appeal (cont'd)

- Record is only as good as the quality of evidence submitted
  - Incomplete, illegible or otherwise unreadable evidence is of no probative value
  - Evidence that is not on point and does not address the issues on appeal is of no value
  - Quantity does not equate to quality
    - Cumulative evidence, especially if not on point, only adds bulk to the proceeding file



# Introducing internet evidence

- Must include URL address and date page accessed

*In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018)

- A web address or hyperlink is insufficient to make a webpage of record

*In re ADCO Indus. – Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020)

# Probative value of internet evidence

- Generally considered for what it shows on its face
  - In re Jasmin Larian, LLC*, 2022 USPQ2d 290, at \*22 (TTAB 2022)
  - In re Embiid*, 2021 USPQ2d 577, at \*5 n.19 (TTAB 2021)
- Internet searches lacking context generally have limited probative value
  - In re Consumer Protection Firm PLLC*, 2021 USPQ2d 238, at \*21 n.28 (TTAB 2021)
- Wikipedia evidence has inherent limitations; Board will consider whether non-offering party had an opportunity to rebut its accuracy
  - In re Lizzo LLC*, 2023 USPQ2d 139, at \*24 (TTAB 2023)



# Introducing third-party registrations

- The Board will not take judicial notice of third-party registrations

*In re MK Diamond Prods., Inc.*, 2020 USPQ2d 10882, at \*1 n.5 (TTAB 2020)

- Submit printouts from the USPTO's electronic databases showing current status and title
- Merely listing registrations is insufficient



# When and how to request remand

- Do not embed request in appeal brief; file request with the Board before briefing
  - In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717, 1724-25 (TTAB 2016)
- Must include a showing of good cause,
  - e.g., why the additional evidence sought to be introduced was not previously available
  - e.g., proposed amendment complies with a requirement or will obviate a ground for refusal
- Board will consider timing of request in assessing whether there is good cause to remand
  - In re NextGen Mgmt., LLC*, 2023 USPQ2d 14, at \*5 (TTAB 2023)
- Remand not permitted in appeals of ex parte expungement and reexamination proceedings



# Reasons for requesting suspension

- Registration cited as a bar under Trademark Act Section 2(d) is in maintenance window
- Registration cited as a bar under Trademark Act Section 2(d) is subject to a cancellation proceeding
- Applicant is involved in a civil action or other Board proceeding that may have an effect on outcome of the appeal
- Consent agreement with owner of a registration cited as a bar under Trademark Act Section 2(d)



# Briefing pitfalls

- Repeating verbatim your last response to the examining attorney during prosecution
- Engaging in extensive discussion of legal standards, unless the standards themselves are in dispute
- Advancing arguments that are unavailable under the statute or the case law (e.g., arguing that applicant's and/or registrant's actual use restricts the goods identified in the cited registration)

*In re Embiid*, 2021 USPQ2d 577, at \*26-28 (TTAB 2021)



# Briefing pitfalls (cont'd)

- Asserting arguments without evidentiary support

*In re NextGen Mgmt., LLC*, 2021 USPQ2d 14, at \*4 (TTAB 2023)

- Relying on cases with different factual records

*In re Lizzo LLC*, 2023 USPQ2d 139, at \* 39-40 (TTAB 2023)

*In re Pound Law, LLC*, 2022 USPQ2d 1062, at \*43 (TTAB 2022)

*In re Ala. Tourism Dept.*, 2020 USPQ2d 10485, at \*11 (TTAB 2020)



# Briefing pitfalls (cont'd)

- Wasting space on string cites
- Attaching to the brief any evidentiary materials other than proper subjects for judicial notice
- Offering ad hominem commentary about the owner of the cited registration, the examining attorney, the administrative trademark judges or the USPTO



# Oral argument

- Consider whether an oral argument would help the judges understand the issues, evidence and your arguments
  - Does your case raise an issue of first impression?
  - Are you arguing for the Board to overrule existing precedent?
  - Is there specific evidence you want to highlight or explain?
- Focus on your strongest arguments
- Have command of the record. The judges may ask you to point to specific evidence that supports your argument

**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

# 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 currently preferred; in person upon request
- 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

# 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 \(TTAB electronic docketing and case files\)](#)
  - <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)



