TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

OLD EDITION

First Edition
September 1995

U. S. Department of Commerce • Patent and Trademark Office

PREFACE TO THE FIRST EDITION

In the 37 years since the Trademark Trial and Appeal Board (TTAB) was established by Congress, the body of trademark law has grown substantially. So, too, has the complexity of administrative practice before the TTAB.

The TTAB's practice and procedure are governed by the Lanham Act and other statutory provisions, the Trademark Rules of Practice, the Federal Rules of Civil Procedure, the Federal Rules of Evidence, and reported cases. But there are elements of TTAB practice and procedure that are not easily extracted from those several sources, particularly by practitioners who represent parties before the TTAB only occasionally. And there are certain elements of TTAB practice and procedure that are not to be found in those statutes, rules, and cases.

With the Trademark Trial and Appeal Board Manual of Procedure (TBMP), we aim to provide, in one publication, a comprehensive statement of our administrative procedures. We intend this manual to be a dynamic document that will be changed and supplemented, on a regular basis, as TTAB practice changes.

Although many people were involved in the numerous discussions that attended the writing of this volume, the TBMP is essentially the work of one person: TTAB Administrative Trademark Judge Janet E. Rice. Without her encyclopedic knowledge of TTAB practice and her indefatigable effort as reporter, publication of the manual, in its present form, would not have happened.

OLD EDITION

J. David Sams
Chief Administrative Trademark Judge
Trademark Trial and Appeal Board

September 1, 1995

INTRODUCTION

The purpose of this manual is to provide practitioners with basic information generally useful for litigating cases before the Trademark Trial and Appeal Board. It is not meant to modify, amend, or serve as a substitute for any existing statutes, rules, or decisional law. Rather, it is intended to describe current practice and procedure thereunder, as of the date of preparation of the manual.

Practitioners should bear in mind that statutes, rules, decisional law, and practice and procedure thereunder are subject to frequent change (albeit not by means of statements in this manual). Moreover, the manual is not binding upon the Board, its reviewing tribunals, the Commissioner, or the PTO. Cf., In re Wine Society of America Inc., 12 USPQ2d 1139 (TTAB 1989).

The bulk of the manual relates primarily to the two most common types of inter partes proceedings before the Board, namely, opposition and cancellation proceedings. However, the first chapter includes general information useful for all proceedings, and the latter part of the manual contains chapters devoted specifically to interference and concurrent use proceedings, as well as a chapter pertaining to ex parte appeals to the Board.

The manual will be updated periodically. Suggestions for improving the content of the manual are welcome. They should be addressed as follows:

Assistant Commissioner for Trademarks
Box TTAB No Fee
Attention: Chief Administrative Trademark Judge
2900 Crystal Drive
Arlington, Virginia 22202-3513

The title of the manual is abbreviated as "TBMP". A citation to a section of the manual may be written as "TBMP §_____" (e.g. "TBMP §110.01," "TBMP §113.06," etc.).

OLD EDITION

TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP)

TABLE OF CONTENTS

OLD EDITION

Chapter 100 General Information

101 Applicable Authority

102 Nature of Board Proceedings

103 Location and Address of Board

104 Business to be Conducted in Writing

105 Contact With Board Personnel

106 Identification, Signature, and Form of Papers

107 How and Where to File Papers and Fees

108 Filing Receipts

109 Filing Date

110 Certificate of Mailing or Transmission Procedure

111 Certificate of Mailing by "Express Mail" Procedure

112 Times for Taking Action

113 Service of Papers

114 Representation of Party

115 Conduct of Practitioner

116 Termination of Representation

117 Correspondence - With Whom Held

118 Payment of Fees

119 Papers and Fees Generally Not Returnable

120 Proceeding Files and Exhibits

121 Access to Files

122 Copying of Files

123 Certification

124 Application and Registration Status Information

125 Action by Assignee

Chapter 200 Extensions of Time to Oppose

201 In General

202 Time for Filing Request

203 Form of Request

204 Fee

205 Mark on Supplemental Register Not Subject to Opposition

206 Identification of Potential Opposer

OLD EDITION

207 Requirements for Showing of Cause

208 Essential Element Omitted

209 Action by Board on Request

210 Objections to Request

211 Relief From Action of Board

212 Amendment of Application During or After Extension

213 Effect of Restoration of Jurisdiction

214 Effect of Republication

215 Effect of Letter of Protest

216 Inadvertently Issued Registration

217 Relinquishment of Extension

218 Abandonment of Application

219 Amendment to Allege Use; Statement of Use

Chapter 300 Pleadings

301 Commencement of Proceeding

302 Mark on Supplemental Register Not Subject to Opposition

303 Who May Oppose or Petition to Cancel

304 Joint Opposers or Petitioners

305 Proceeding Against Multiple Class Application or Registration

OLD EDITION

306 Consolidated and Combined Complaints

307 Time for Filing Opposition

308 Time for Filing Petition to Cancel

309 Fee for Filing Opposition

310 Fee for Filing Petition to Cancel

311 Scope of Opposition and Petition to Cancel

312 Form of Opposition and Petition to Cancel

313 Exhibits to Pleadings

314 FRCP 11 Applicable

315 Notification of Proceeding

316 Time for Filing Answer

317 Default

318 Form of Answer

319 Counterclaims

320 Reply to Answer Should Not be Filed

321 Unpleaded Matters

322 Amendment of Pleadings

323 Motions Relating to Pleadings

324 Amendment to Allege Use; Statement of Use

OLD EDITION

Chapter 400 Discovery

401 In General

402 Scope of Discovery

403 Timing of Discovery

404 Discovery Depositions

405 Discovery Deposition Objections

406 Interrogatories

407 Responses to Interrogatories

408 Requests for Production of Documents and Things

409 Responses to Requests for Production

410 Requests for Admission

411 Responses to Requests for Admission

412 Duties to Cooperate, Search Records, Supplement

413 Filing Discovery Requests and Responses With Board

414 Motions Attacking Requests for Discovery

415 Remedy for Failure to Provide Discovery

416 Protective Orders

417 Telephone and Pre-trial Conferences

418 Discovery Sanctions

419 Discovery Guidelines

OLD EDITION

Chapter 500 Stipulations and Motions

501 Stipulations

502 Motions--In General

503 Motion to Dismiss for Failure to State a Claim

504 Motion for Judgment on the Pleadings

505 Motion for a More Definite Statement

506 Motion to Strike Matter From Pleading

507 Motion to Amend Pleading

508 Motion for Default Judgment for Failure to Answer

509 Motion to Extend Time; Motion to Reopen Time

510 Motion to Suspend; Motion to Resume

511 Motion to Consolidate

512 Motion to Join or Substitute

513 Motion to Withdraw as Representative; Petition to Disqualify

514 Motion to Amend Application or Registration

515 Motion to Remand Application to Examining Attorney

516 Motion to Divide Application

517 Motion to Strike Brief on Motion

518 Motion for Reconsideration of Decision on Motion

OLD EDITION

519 Motion for Leave to Serve Additional Interrogatories

520 Motion to Take Foreign Deposition Orally

521 Motion to Quash Notice of Deposition

522 Motion for Order re Manner or Place of Document Production

523 Motion to Compel Discovery

524 Motion to Test Sufficiency of Response to Admission Request

525 Motion to Withdraw or Amend Admissions

526 Motion for a Protective Order

527 Motion for Discovery Sanctions

528 Motion for Summary Judgment

529 Motion for FRCP 11, or Other Non-Discovery, Sanctions

530 Motion to Offer Discovery Deposition of Self or Nonparty

531 Motion to Use Testimony From Another Proceeding

532 Motion That Deposition Upon Written Questions Be Taken Orally

533 Motion to Strike Notice of Reliance

534 Motion to Strike Trial Testimony Deposition

535 Motion for Judgment for Plaintiff's Failure to Prove Case

536 Motion for Order to Show Cause Under Rule 2.134(b)

537 Motion for Order to Show Cause Under Rule 2.128(a)(3)

538 Motion for Leave to Exceed Page Limit for Brief on Case

OLD EDITION

539 Motion for Leave to File Amicus Brief

540 Motion to Strike Brief on Case

541 Motion for Augmented Panel Hearing

542 Motion to Change Oral Hearing Date; For Additional Time

543 Motion for Leave to Audiotape Oral Hearing

544 Motion for Reconsideration of Final Decision

545 Motion for Relief From Final Judgment

Chapter 600 Withdrawal; Settlement

601 Withdrawal by Opposition or Cancellation Plaintiff

602 Withdrawal by Opposition or Cancellation Defendant

603 Withdrawal by Interference or Concurrent Use Applicant

604 Consent to Judgment

605 Settlement

606 Effect on Counterclaim

Chapter 700 Introduction of Evidence

701 Time of Trial

702 Manner of Trial

703 Applications and Registrations

OLD EDITION

704 Statements and Things in Application or Registration

705 Exhibits to Pleadings or Briefs

706 Statements in Pleadings or Briefs

707 Official Records

708 Printed Publications

709 Discovery Depositions

710 Interrogatory Answers; Admissions

711 Produced Documents

712 Judicial Notice

713 Oral Depositions

714 Depositions Upon Written Questions

715 Testimony From Another Proceeding

716 Stipulated Evidence

717 Noncomplying Evidence

718 Objections to Evidence

Chapter 800 Briefs on Case, Oral Hearing, Final Decision

801 Briefs on the Case

802 Oral Hearing

803 Final Decision

OLD EDITION

804 Request for Reconsideration of Final Decision

805 Final Decision Remand to Examining Attorney

806 Termination of Proceeding

807 Status of Application After Proceeding

Chapter 900 Review of Decision of Board

901 Appeals--In General

902 Appeal to Court of Appeals for the Federal Circuit

903 Appeal by Civil Action

904 Access to Record During Appeal

905 Petition to Commissioner

Chapter 1000 Interferences

1001 In General

1002 Declaration of Interference

1003 Institution of Interference

1004 Issues in Interference

1005 Burden of Proof

1006 Addition of Party

1007 Conduct of Proceeding

OLD EDITION

Chapter 1100 Concurrent Use Proceedings

1101 In General

1102 Generation of Proceeding

1103 Parties to Proceeding; Involved Applications, Registrations

1104 Applications and Registrations Not Subject to Proceeding

1105 Commencement of Proceeding

1106 Answer

1107 Issue; Burden of Proof

1108 Conduct of Proceeding

1109 Settlement Providing for Concurrent Registration

1110 Effect of Abandonment of Involved Application

1111 Effect of Adverse Decision in Opposition or Cancellation

1112 "Conversion" of Opposition to Concurrent Use Proceeding

1113 Alteration of Limitations on Concurrent Registration

Chapter 1200 Ex Parte Appeals

1201 Propriety of Appeal

1202 Filing an Appeal

OLD EDITION

1203 Appeal Briefs

1204 Effect of Request for Reconsideration of Final Action

1205 Amendment of Application During Appeal

1206 Amendment to Allege Use; Statement of Use

1207 Submission of Evidence During Appeal

1208 Treatment of Evidence

1209 Remand for New Refusal or New Requirement

1210 Approval for Publication During Appeal

1211 Abandonment During Appeal

1212 Cancellation or Assignment of Cited Registration

1213 Suspension of Appeal

1214 Consolidation

1215 Alternative Positions

1216 Oral Hearing

1217 Final Decision

1218 Reopening (Amendment, etc., After Final Decision)

1219 Review of Final Decision

Appendix

OLD EDITION

Table of Cases Cited

Index

OLD EDITION

CHAPTER 100 GENERAL INFORMATION

101 Applicable Authority

102 Nature of Board Proceedings

103 Location and Address of Board

104 Business to be Conducted in Writing

105 Contact With Board Personnel

106 Identification, Signature, and Form of Papers

107 How and Where to File Papers and Fees

108 Filing Receipts

109 Filing Date

110 Certificate of Mailing or Transmission Procedure

111 Certificate of Mailing by "Express Mail" Procedure

112 Times for Taking Action

113 Service of Papers

114 Representation of Party

115 Conduct of Practitioner

116 Termination of Representation

117 Correspondence - With Whom Held

118 Payment of Fees

119 Papers and Fees Generally Not Returnable

OLD EDITION

120 Proceeding Files and Exhibits

121 Access to Files

122 Copying of Files

123 Certification

124 Application and Registration Status Information

125 Action by Assignee

OLD EDITION

101 Applicable Authority

101.01 Statute and Rules of Practice

All proceedings before the Trademark Trial and Appeal Board ("TTAB" or "Board") are governed by the Trademark Act of 1946 ("Act of 1946" or "Act"), 15 U.S.C. §1051 et seq.; the rules of practice in trademark cases (commonly known as the Trademark Rules of Practice), which may be found in Part 2 of Title 37 of the Code of Federal Regulations ("CFR"); the rules pertaining to assignments in trademark cases, which may be found in Part 3 of 37 CFR; and the rules relating to representation of others before the Patent and Trademark Office, which may be found in Part 10 of 37 CFR. In addition, Trademark Rule 2.1, 37 CFR §2.1, makes applicable to trademark cases certain rules from Part 1 of 37 CFR, which contains the rules of practice in patent cases. The PTO rules governing procedure in inter partes proceedings before the Board are adapted, in large part, from the Federal Rules of Civil Procedure, with modifications due primarily to the administrative nature of Board proceedings. See Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

A copy of 37 CFR may be obtained at a nominal cost from the U.S. Government Printing Office. Price and ordering information may be obtained by calling (202) 512-1800. Written orders sent by mail should be sent to the U.S. Government Printing Office, Superintendent of Documents, P.O. Box 371954, Pittsburgh, PA 15250-7954. In addition, orders or inquiries may be submitted by fax to (202) 512-2250.

OLD EDITION

101.02 Federal Rules

Inter partes proceedings before the Board are also governed by the Federal Rules of Civil Procedure ("FRCP"), except as otherwise provided in the Trademark Rules of Practice, and wherever applicable and appropriate; and by the Federal Rules of Evidence ("FRE"). See 37 CFR §§2.116, 2.120(a), and 2.122(a).

There is no provision in the Trademark Rules of Practice concerning the applicability of the Federal Rules of Evidence to ex parte appeals before the

Board. Certain of the principles embodied in the Federal Rules of Evidence are applied by the Board, in practice, in evaluating the probative value of evidence submitted in ex parte cases. See In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); In re American OleanTile Co., 1 USPQ2d 1823 (TTAB 1986); and In re Foundry Products, Inc., 193 USPQ 565 (TTAB 1976). For information concerning the treatment of evidence in Board ex parte proceedings, see TBMP §1208, and authorities cited therein.

101.03 Decisional Law

Proceedings before the Board are also governed, to a large extent, by published decisions in prior cases. These decisions include not only the decisions of the Board itself, but also the decisions of the Court of Appeals for the Federal Circuit (which determines appeals from decisions of the Board); the Court of Customs and Patent Appeals (predecessor of the Court of Appeals for the Federal Circuit); and the Commissioner (who determines petitions seeking review of Board actions on procedural matters).

Decisions of the Board, the Commissioner, and the Court of Appeals for the Federal Circuit may or may not be designated for publication. Those decisions which are designated for publication are published in the United States Patent Quarterly ("USPQ"), a periodical publication of The Bureau of National Affairs, Inc., Washington, D.C. They may also be found in Mead Data Central, Inc.'s "LEXIS" legal data base, and in the Intellectual Property Library of West Publishing Company's WESTLAW data base.

Decisions which are designated for publication in full are citable as precedent. Decisions which are not designated for publication, or which are designated for publication only in digest form, are not citable as precedent, even if a complete copy of the unpublished or digest decision is submitted. See General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992); In re American Olean Tile Co., 1 USPQ2d 1823 (TTAB 1986); Marcon, Ltd. v. Merle Norman Cosmetics, Inc., 221 USPQ 644 (TTAB 1984); and Roberts Proprietaries, Inc. v. Rumby International, Inc., 212 USPQ 302 (TTAB 1981). See also Franklin Pierce Law Center v. Georgetown University, 14 USPQ2d 1255, Editor's Note at 1256 (Fed. Cir. 1990). An unpublished or digest decision will, however, be considered in determining issues of claim preclusion, issue preclusion, judicial estoppel, law of the case, or the like, provided that (1) a party to the pending

OLD EDITION

Board proceeding, or its privy, was also a party to the prior proceeding, and (2) a complete copy of the decision is submitted. See General Mills Inc. v. Health Valley Foods, supra.

101.04 Commissioner's Orders and Notices

Occasionally, the Commissioner of Patents and Trademarks, or another PTO official acting under the Commissioner's authority, publishes in the Official Gazette an Order or Notice relating to a particular PTO policy, practice, procedure, or other such matter of interest to the public. Some of these Orders and Notices affect practice and procedure before the Trademark Trial and Appeal Board. One example is a Commissioner's Notice announcing the late mailing of an issue of the Official Gazette and the consequent change in the time for opposing marks published therein, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. See TBMP §202.03.

102 Nature of Board Proceedings

102.01 Jurisdiction of Board

The Trademark Trial and Appeal Board is an administrative tribunal of the United States Patent and Trademark Office. The Board is empowered to determine only the right to register. See Sections 17, 18, 20, and 24 of the Act of 1946, 15 U.S.C. §§1067, 1068, 1070, and 1092.

The Board is not authorized to determine the right to use, nor may it decide broader questions of infringement or unfair competition. See Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) [Board cannot adjudicate unfair competition issues; function of Board is to determine whether there is a right to secure or to maintain a registration]; Paramount Pictures Corp. v. White, 31 USPQ2d 1768 (TTAB 1994) [Board has no jurisdiction over claims of trademark infringement and unfair competition]; Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992) [Board is not empowered to render declaratory judgment that one party's use of mark is not an infringement of mark of other party]; Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985) [dilution and tarnishment are not matters which may be entertained

OED EDITION

by the Board as grounds for cancellation]; Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 USPQ 431 (TTAB 1985) [Board may not entertain any claim based on Section 43(a) of the Act, 15 U.S.C. 1125(a)]; Electronic Water Conditioners, Inc. v. Turbomag Corp., 221 USPQ 162 (TTAB 1984) [unfair competition and Section 43(a) claims are outside the jurisdiction of the Board]; Hershey Foods Corp. v. Cerreta, 195 USPQ 246 (TTAB 1977) [determination of whether opposer is guilty of unfair business practices is not within the province of the Board]; Yasutomo & Co. v. Commercial Ball Pen Co., 184 USPQ 60 (TTAB 1974) [Board does not have jurisdiction to address itself to anti-trust issues]; and American-International Travel Service, Inc. v. AITS, Inc., 174 USPQ 175 (TTAB 1972) [Board is without jurisdiction to determine whether opposer violated criminal statute]. But see Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992) [Board may have erred in stating that it lacked jurisdiction over equitable defenses which were based on allegations of trademark infringement and unfair competition, but error was harmless because equitable defenses are not applicable against claim that mark is generic]; Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983) [although other courts would be the proper tribunals in which to litigate a cause of action for enforcement or breach of contract, that is not sufficient reason for the Board to decline to consider an agreement, its construction, or its validity if necessary to decide the issues properly before it, including the issue of estoppel]; and Knickerbocker Toy Co. v. Faultless Starch Co., 467 F.2d 501, 175 USPQ 417 (CCPA 1972) [Board has no jurisdiction over the issues raised by the pleadings insofar as they allege copyright infringement, unfair competition, and the like, but Board is not precluded from passing on the validity of a copyright if it is necessary to do so in the course of the exercise of its statutory jurisdiction]. See also Scotch Whiskey Ass'n v. United States Distilled Products Co., 13 USPQ2d 1711 (TTAB 1989), recon. denied, 17 USPQ2d 1240 (TTAB 1990) [Board cannot consider claims of unfair competition standing alone, but can consider such claims in determining the registrability of a mark, that is, in determining a separate, properly pleaded ground for opposition or cancellation], dismissed, Scotch Whiskey Ass'n v. United States Distilled Products Co., 18 USPQ2d 1391 (TTAB 1991) [because petitioner has not pleaded a separate ground on which to base the petition to cancel, petitioner's claims under Articles 10 and 10bis of the Paris Convention cannot be considered by Board], rev'd on other grounds, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

Similarly, the Board, being an administrative tribunal, has no authority to declare any portion of the Act of 1946, or any other act of Congress, unconstitutional.

OLD EDITION

See Harjo v. Pro Football Inc., 30 USPQ2d 1828 (TTAB 1994), and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991).

102.02 Types of Board Proceedings

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings.

An opposition is a proceeding in which the plaintiff seeks to prevent the issuance of a registration of a mark on the Principal Register. "Any person who believes that he would be damaged by the registration" of a mark may file an opposition thereto, but the opposition may be filed only in response to the publication of the mark, under Section 12(a) of the Act, in the Official Gazette of the Patent and Trademark Office ("PTO"). See Section 13 of the Act of 1946, 15 U.S.C. §1063.

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a mark. The proceeding may only be filed after the issuance of the registration. A petition for cancellation may be filed by "any person who believes that he is or will be damaged by the registration" of the mark. See Sections 14 and 24 of the Act of 1946, 15 U.S.C. §§1064 and 1092.

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict), is entitled to registration. See Section 18 of the Act, 15 U.S.C. §1068. The proceeding is declared by the PTO only upon petition to the Commissioner showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. See Section 16 of the Act of 1946, 15 U.S.C. §1066; 37 CFR §2.91; and TBMP §1002. An interference which has been declared by the Commissioner is not instituted by the Board until after all of the marks which are to be involved in the proceeding have been published in the Official Gazette for opposition. See TBMP §1003. For further information concerning interference proceedings, see TBMP chapter 1000.

A concurrent use proceeding is a proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in

OLD EDITION

connection with which the mark is used (usually, a concurrent registration is restricted as to the territory which it covers). See TBMP §1101.01, and authorities cited therein. The proceeding may be generated only through the filing of an application for registration as a lawful concurrent user, and is instituted by the Board only after each of the one or more involved applications has been published for opposition in the Official Gazette, and all oppositions thereto (if any) have been withdrawn or dismissed. See TBMP §§1102.01 and 1105, and authorities cited therein. For further information concerning concurrent use proceedings, see TBMP chapter 1100.

The Board also has jurisdiction over ex parte appeals, that is, appeals from an Examining Attorney's final refusal to register a mark in an application. See Sections 12(b) and 20 of the Act of 1946, 15 U.S.C. §§1062(b) and 1070; 37 CFR §§2.141 and 2.142; and TBMP chapter 1200.

OLD EDITION

102.03 General Description of Board Proceedings

An inter partes proceeding before the Board is very similar to a civil action in a Federal district court. There are pleadings (at least in an opposition or cancellation proceeding); a wide range of possible motions; discovery; testimony periods; briefs; and an oral hearing (if requested), followed by a decision on the case. However, because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. See Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). See also La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976). Cf. TBMP §§502.01 and 702. The principal difference is that proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. For example, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. Indeed, a party to a proceeding before the Board need never come to the offices of the Board at all, unless the Board requests that the parties meet with the Board at its offices for a pre-trial conference pursuant to 37 CFR §2.120(i)(2), or unless the party wishes to argue its case at oral hearing (an oral hearing is held only if requested by a party to the proceeding).

An ex parte appeal, being appellate in nature, is a much simpler and shorter procedure, involving only the filing of briefs by the applicant and Examining Attorney, and, if requested by the applicant, an oral hearing.

The Board includes both interlocutory attorneys, and administrative trademark judges (known also as Board members). Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Board judge, or by a single interlocutory attorney to whom such authority has been delegated. See 37 CFR §2.127(c). Decisions on the case, and on potentially dispositive motions, are rendered by a panel of at least three Board judges. See Section 17 of the Act, 15 U.S.C. §1067.

OLD EDITION

103 Location and Address of Board

The Board is located at 2900 Crystal Drive, Ninth Floor, Arlington, Virginia 22202-3513. The mailing address of the Board, however, is Box TTAB No Fee (or Box TTAB Fee), Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. If papers are not accompanied by a fee, "Box TTAB No Fee" should be used. If papers are accompanied by a fee, "Box TTAB Fee" should be used.

104 Business to be Conducted in Writing

37 CFR §1.2 All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

All business with the Board should be transacted in writing. The personal attendance of parties or their attorneys or other authorized representatives at the offices of the Board is unnecessary, except in the case of a pre-trial conference as provided in 37 CFR §2.120(i)(2), or upon oral argument at final hearing, if a party so desires, as provided in 37 CFR §2.129. Decisions of the Board will be based exclusively on the written record before it. Cf. In re Sovran Financial

Corp., 25 USPQ2d 1537 (Comm'r 1992); In re Merck & Co., 24 USPQ2d 1317 (Comm'r 1992); and In re Investigacion Y Desarrollo de Cosmeticos S.A., 19 USPQ2d 1717 (Comm'r 1991).

105 Contact With Board Personnel

37 CFR 10.93(b) In an adversary proceeding, including any inter partes proceeding before the Office, a practitioner shall not communicate, or cause another to communicate, as to the merits of the cause with a judge, official, or Office employee before whom the proceeding is pending, except:

(1) In the course of official proceedings in the cause.

(2) In writing if the practitioner promptly delivers a copy of the writing to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(3) Orally upon adequate notice to opposing counsel or to the adverse party if the adverse party is not represented by a practitioner.

(4) As otherwise authorized by law.

Parties or their attorneys or other authorized representatives may telephone the Board, or come to the offices of the Board, to inquire about the status of a case or to ask for procedural information, but not to discuss the merits of a case or of any particular issue. The telephone number of the Board is (703) 308-9300. If an inquiry involves a particular case, the person making the inquiry should be prepared to give the number of the proceeding or application in question.

OLD EDITION

106 Identification, Signature, and Form of Papers

106.01 Identification of Papers

A paper filed in a proceeding before the Board should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name and number of the inter partes proceeding (or, in the case of an ex parte appeal, the application) to which it relates. Cf. 37 CFR §1.5(c). The paper should also include a title describing its nature, i.e., "Notice of Opposition," "Answer,"

"Motion to Compel," "Brief in Opposition to Respondent's Motion for Summary Judgment," "Notice of Reliance," etc.

Papers filed in an application which is the subject of an inter partes proceeding before the Board should be filed with the Board, and should bear at the top of its first page both the application serial number, and the inter partes proceeding number and title. Similarly, requests under Section 7 of the Act, 15 U.S.C. §1057, to amend, correct, or surrender a registration which is the subject of a Board inter partes proceeding, and any new power of attorney, designation of domestic representative, or change of address submitted in connection with such a registration, should be filed with the Board, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. Cf. 37 CFR §1.5(c).

OLD EDITION

106.02 Signature of Papers

37 CFR §2.119(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

37 CFR §10.14(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

37 CFR §10.18(a) Except where a copy, including a photocopy or facsimile transmission, of a personally signed piece of correspondence is permitted to be filed pursuant to §1.4 of this chapter, every piece of correspondence filed by a practitioner on behalf of himself or herself or representing an applicant or a party to a proceeding in the Patent and Trademark Office must bear an original signature personally signed in permanent ink by such practitioner except for

correspondence which is required to be signed by the applicant or party. The signature of a practitioner on correspondence filed by the practitioner, regardless of whether the correspondence has an original signature or is a copy, including a photocopy or facsimile transmission, of correspondence bearing an original signature, constitutes a certificate that:

(1) The correspondence has been read by the practitioner;

(2) The filing of the correspondence is authorized;

(3) To the best of practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and

(4) The correspondence is not interposed for delay.

(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See §10.23(c)(15).

37 CFR §1.4(d) Each piece of correspondence, except as provided in paragraphs (e) and (f) of this section, filed in a patent or trademark application, reexamination proceeding, patent or trademark interference proceeding, patent file or trademark registration file, trademark opposition proceeding, trademark cancellation proceeding, or trademark concurrent use proceeding, which requires a person's signature, must either:

(1) be an original, that is, have an original signature personally signed in permanent ink by that person; or

(2) be a copy, such as a photocopy or facsimile transmission (§1.6(d)), or an original. In the event that a copy of the original is filed, the original should be retained as evidence of authenticity. If a question of authenticity arises, the Patent and Trademark Office may require submission of the original.

37 CFR §1.4(f) When a document that is required by statute to be certified must be filed, a copy, including a photocopy or facsimile transmission, of the certification is not acceptable.

Every paper filed in an inter partes or ex parte proceeding before the Board, and every request for an extension of time to file an opposition, must be personally signed by the party filing it, or by the party's attorney or other authorized representative, as appropriate. See 37 CFR §§1.4(d); 2.119(e); and 10.18(a).

A party may act in its own behalf in a proceeding before the Board, or the party may be represented by an attorney or other authorized representative. See 37 CFR §10.14, and TBMP §114.01. Cf. 37 CFR §2.11. When an individual who

OLD EDITION

is a party to a Board proceeding elects to act in his or her own behalf, the individual must sign any papers which he or she files with the Board. If a party which is a partnership elects to act in its own behalf, papers filed by the partnership should be signed by a partner. If a party which is a corporation or association elects to act in its own behalf, papers filed by the corporation or association should be signed by an officer thereof who is authorized to sign for the corporation or association. See 37 CFR §10.14(e).

If a paper is filed on behalf of a party by the party's attorney or other authorized representative, it must bear the signature of, and be personally signed by, that attorney or other representative, unless it is a paper required to be signed by the party. An attorney or other authorized representative who signs a paper, and then files it with the Board on behalf of a party, should remember that his or her signature to the paper constitutes a certification of the elements specified in 37 CFR §10.18(a), and that a knowing violation of the provisions of that rule by an attorney or other authorized representative will leave him or her open to disciplinary action. See 37 CFR §10.18. Cf. FRCP 11. For information concerning the meaning of the designation "other authorized representative," see TBMP §114.04.

Under the written signature on a paper filed in a proceeding before the Board there should appear the name, in typed or printed form, of the person who signed; a description of the capacity in which he or she signed (e.g., as the individual who is a party, if the filing party is an individual; as a corporate officer, if the filing party is a corporation; as the filing party's attorney; etc.); and his or her business address and telephone number. The inclusion of the signing person's address and phone number on the paper itself is vital because mail sent to the PTO is opened in the PTO Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the PTO. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings.

It is not appropriate for one person to sign a paper for another person, as, for example, "John Smith, for John Doe" or "John Doe, by John Smith." See 37 CFR §§2.119(e) and 10.18(a); In re Cowan, 18 USPQ2d 1407 (Comm'r 1990); and Cerveceria India Inc. v. Cerveceria Centroamericana, S.A., 10 USPQ2d 1064 (TTAB 1989), aff'd Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989).

OLD EDITION

Either the original of the personally signed paper, or a legible copy thereof, may be filed with the Board. If a copy is filed, the original should be retained as evidence of authenticity. If a question as to the authenticity of a filed copy arises, the PTO may require submission of the original. See 37 CFR §1.4(d). For information concerning fax copies, see TBMP §107.

Notwithstanding the requirement that a paper filed before the Board be signed, an unsigned paper will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. See 37 CFR §2.119(e). Similarly, a telegram, being in effect an unsigned paper, will not be refused consideration if the subject matter thereof is subsequently presented in a properly signed paper filed within the time limit set by the Board in its notification of the defect.

OLD EDITION

106.03 Form of Papers

Apart from proper identification and signature, there is no particular form which papers filed in proceedings before the Board must follow. Nor does the PTO have printed forms for any papers filed in such proceedings. As an aid to litigants, however, the PTO has prepared suggested formats for certain types of papers filed in Board proceedings. These include the notice of opposition, petition for cancellation, notice of appeal to the Board, designation of domestic representative, certificate of mailing or certificate of transmission under 37 CFR §1.8(a), and certificate of "Express Mail" under 37 CFR §1.10. Copies of these formats are included in this manual at the place where the particular type of paper or certificate is discussed (e.g., the suggested format for a notice of opposition is included in the chapter on pleadings), as well as in an appendix to the manual.

A paper filed with the Board may be either the original or a legible copy thereof, on good quality paper. See, with respect to fax copies: TBMP §107. Ordinarily, extra copies of a paper should not be submitted. See SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994). However, in inter partes cases, briefs at final hearing must be submitted in triplicate (see 37 CFR §2.128(b)); stipulations to extend trial dates should be submitted in multiple form, i.e., one copy for the Board proceeding file plus as many other copies as there are parties (see 37 CFR §2.121(d)); and the notice of opposition and petition for cancellation must be submitted in duplicate (see 37 CFR §§2.104(a) and

2.112(a)). In addition, requests for extensions of time to oppose should be filed in triplicate (see 37 CFR §2.102(e)).

With the exception of deposition transcripts, exhibits thereto, and inter partes briefs on the case, papers filed with the Board should not be bound. Proceeding papers, with the noted exceptions, are placed by the Board on the prongs of the proceeding file to which they pertain. See TBMP §120.01. If proceeding papers, other than the noted exceptions, are filed in bound form, the Board must remove the binding in order to place the papers on the proceeding file prongs. Because of their size, deposition transcripts, exhibits thereto, and inter partes briefs on the case are not kept by the Board on proceeding file prongs, and thus may be filed in bound form.

Briefs at final hearing in inter partes cases, and appeal briefs in ex parte cases, are required to be submitted in typewritten or printed form, double spaced, on letter-size paper. See 37 CFR §§2.128(b) and 2.142(b)(2). The Board prefers that other papers, too, be submitted in typewritten or printed form, double spaced. Although other papers may be submitted on either legal or letter-size paper, letter-size paper is recommended. This is the size preferred by many Federal district courts, and their size preference is significant because review of a final decision of the Board may be had either by way of appeal to the Court of Appeals for the Federal Circuit or by way of civil action in a Federal district court. See Section 21 of the Act of 1946, 15 U.S.C. §1071; 37 CFR §2.145; and TBMP §§901-903.

OLD EDITION

107 How and Where to File Papers and Fees

37 CFR §1.6 Receipt of correspondence.
(a) Date of receipt and Express Mail date of deposit.
Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) No correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia;

(2) Correspondence filed in accordance with §1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unlesss the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia in which case the date stamped will be the next succeeding

day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia;

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) Patent and Trademark Office Post Office pouch.
Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays and Federal holidays within the District of Columbia, by the post office at Washington, D.C. serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.

(c) Correspondence delivered by hand.
In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) Facsimile transmission.
Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding before the Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent, or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

(1) Correspondence as specified in §1.4(e), requiring an original signature;

(2) Certified documents as specified in §1.4(f);

OLD EDITION

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);

(4) Drawings submitted under §§1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;

(5) A request for reexamination under §1.510;

(6) Correspondence to be filed in a patent application subject to a secrecy order under §§5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;

(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);

(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under §1.621; a transcript of a deposition under §1.676 or interrogatories, cross-interrogatories, or recorded answers under §1.684(c); or an evidentiary record and exhibits under §1.653.

(e) Interruptions in U.S. Postal Service.
If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter.

Papers relating to proceedings before the Board, and not accompanied by a fee, may be filed during regular office hours by delivery (by hand or by courier service) to the Board at 2900 Crystal Drive, South Tower Building, Ninth Floor, Arlington, Virginia 22202-3513; or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513; or to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B-03, Arlington, Virginia 22202; or (by courier delivery

OLD EDITION

only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202 (but delivery of papers intended for the Board to one of the Crystal Plaza Building 2 locations is not recommended, because papers delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board). Such papers may also be filed by depositing them in the mail addressed to the Board's mailing address (Box TTAB No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513). See "Change of Address For Trademark Applications and Trademark Related [sic] Papers," 1163 TMOG 80 (June 28, 1994). The Board's physical address, which is subject to change, should not be used on papers sent to the Board.

Papers accompanied by fees may be filed by mailing them to the Board's mailing address for fee papers, i.e., Box TTAB Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513. Papers with fees may also be filed by delivery (by hand or by courier service) to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513 (from which the paper will be routed in due course to the PTO's Office of Finance for handling of the fee); or to the Finance Window at 2900 Crystal Drive, South Tower Building, Third Floor, Arlington, Virginia 22202-3513 (which will record the fee as "received" or "posted" immediately and then give the paper to the Intake Processing Unit on the same floor--this procedure saves the time involved in routing a paper to the Office of Finance); or to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B-03, Arlington, Virginia 22202; or (by courier delivery only) to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202 (but delivery of papers intended for the Board to one of the Crystal Plaza Building 2 locations is not recommended, because papers delivered to these locations, rather than to one of the South Tower Building locations, may take considerably longer to reach the Board).

To facilitate the handling of mail intended for the Board, the PTO has established two special box designations which may be used thereon. The box designations are as follows:

BOX TTAB NO FEE	For use on papers intended for the Board which do not include a fee, such as extension requests, motions,

OLD EDITION

briefs, etc.

BOX TTAB FEE	For use on papers intended for the Board which include a fee, such as a notice of opposition, a petition for cancellation, or a notice of appeal in an ex parte appeal

It is strongly recommended that these box designations be used on all papers intended for the Board. Documents being sent to a TTAB box should be addressed as follows (with the designation "BOX TTAB" on one line, and the "NO FEE" or "FEE" indicator on the line below):

BOX TTAB
FEE (or "NO FEE")
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

For best results, the TTAB box designation, including the "FEE/NO FEE" indicator, should be used both on the mailing envelope and on the cover sheet or first page of each document intended for the Board. Preferably, envelopes addressed to a TTAB box designation should include only documents designated for the box specified on the envelope. The inclusion in a single envelope of documents destined for more than one location may cause delay in the processing of those documents. However, documents destined for more than one location may be included in a single envelope (albeit this is not the preferred practice), provided that each document bears on its cover sheet or first page its box designation, including the "FEE/NO FEE" indicator, and provided also that each complete filing is stapled or secured in some fashion. If documents destined for more than one location are included in a single envelope, all of the box designations, with "FEE/NO FEE" indicators, of the included documents should be listed on the envelope. See "Special Boxes and 'Fee/No Fee' Indicators For Trademark-Related Mail And Guidelines For Filing Requests To Extend Time To Oppose With The Trademark Trial And Appeal Board (TTAB)," 1168 TMOG 89 (November 22, 1994).

With the exception of the notice of appeal in an ex parte appeal, papers to be filed with the Board may not be filed by facsimile transmission ("fax"). See 37 CFR §1.6(d)(8). If papers other than the notice of appeal in an ex parte appeal

OLD EDITION

are filed with the Board by fax transmission, they will not receive a filing date.

However, the Board will accept, and give filing dates to, fax copies of papers, when the fax copies are hand delivered to the Board, or are sent to the Board by mail or courier service. In addition, the Board may request that a party send by fax transmission a copy of a paper which has already been filed in the PTO by one of the acceptable methods described above, such as by mail, but which paper has not yet been received by the Board and/or entered in the proceeding file for which it is intended. The Board may make such a request when, for example, (1) a Board attorney needs a copy of the paper in order to make an immediate ruling, by telephone conference, on a motion, or (2) the Board needs to see a copy of a paper which was assertedly filed in the PTO, but which the Board does not have or cannot locate. When the Board requests that a copy of a paper be sent to the Board by fax transmission, the name of the Board employee making the request must appear on the cover sheet of the transmission, so that the Board staff member receiving the transmission will know that the transmission is authorized, and can immediately give the paper to the employee who requested it. If the name of the requesting Board employee does not appear on the cover sheet, the staff member receiving the transmission will presume that the transmission is unauthorized, and return the paper to its sender.

When correspondence allowed to be submitted by fax transmission is submitted in that manner, the requirements of 37 CFR §1.6(d) should be met. In addition, it is recommended that the fax cover sheet specify the number of pages being transmitted, and the name, address, fax number, and telephone number of the transmitting party.

A document transmitted by fax must be legible. The document that is used as the original for the fax transmission should be retained by the sender as evidence of the content of the transmission. See 37 CFR §1.4(d).

Correspondence filed by fax transmission should be transmitted to the fax number of the PTO location for which it is intended. Transmission of correspondence to the fax number of the wrong PTO location will cause delay in matching the correspondence with the file to which it pertains. The Board itself has several different fax numbers. The Board fax number to be used for a notice of appeal in an ex parte appeal is (703) 308-9333. In those cases where the Board requests that a party send a copy of some other paper by fax transmission, the party will be provided with the appropriate fax number.

OLD EDITION

The Board's fax machines are attended between the business hours of 8:30 a.m. and 5:00 p.m., Eastern Standard Time, Monday through Friday, excluding holidays. Normally, the machines may be accessed 24 hours a day. However, there may be times when reception is not possible because of equipment failure or maintenance requirements. Accordingly, persons transmitting correspondence to the Board by fax should be cautious about relying on the availability of this service near time deadlines, such as the end of the six-month period for filing a notice of appeal in an ex parte appeal to the Board.

For information concerning how to pay fees, see TBMP §118.

OLD EDITION

108 Filing Receipts

When a paper (with or without a fee) intended for the Board is filed in the PTO, it is possible to obtain a receipt evidencing the filing, and the date of such filing. In the case of a paper sent by mail, a receipt may be obtained by submitting with the paper a stamped, self-addressed postcard with sufficient information to identify clearly the paper, the party in whose behalf the paper is being filed, and the proceeding or application in connection with which the paper is being filed. When the PTO receives the paper and the postcard, it will date-stamp both of them and mail the postcard back.

If a paper intended for the Board is delivered by hand or by courier service to the offices of the Board, or to the Intake Processing Unit at 2900 Crystal Drive, South Tower Building, Third Floor, Room 3C06, Arlington, Virginia 22202-3513, or to the Finance Window on the same floor of that building, the receipt may take the form of a postcard bearing appropriate identifying information, or a duplicate copy of the paper, or a transmittal letter with appropriate identifying information. The receipt and the paper will be date-stamped and the receipt will be handed back to the person who delivered the paper. If a paper is delivered by hand or by courier service to the Customers' Window at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1B03, Arlington, Virginia 22202, the receipt may be in the form of a postcard, or, alternatively, a handwritten receipt will be furnished. If a paper is delivered by courier service to the Patent and Trademark Office Mail Room (Correspondence and Mail Division) at 2011 S. Clark Place, Crystal Plaza Building 2, Room 1A-01, Arlington, Virginia 22202, the postcard receipt must be used.

When a paper is submitted to the Board by fax transmission, the Board will not formally acknowledge receipt of the paper. However, the Board fax machine usually will confirm to the sending unit that the transmission is complete. With the exception of the notice of appeal in an ex parte appeal to the Board, papers intended for the Board may not be filed by fax transmission. See 37 CFR §1.6(d)(8). See also TBMP §107.

109 Filing Date

37 CFR §1.6 Receipt of correspondence.
(a) Date of receipt and Express Mail date of deposit.
Correspondence received in the Patent and Trademark Office is stamped with the date of receipt except as follows:

(1) No correspondence is received in the Patent and Trademark Office on Saturdays, Sundays or Federal holidays within the District of Columbia;

(2) Correspondence filed in accordance with §1.10 will be stamped with the date of deposit as "Express Mail" with the United States Postal Service unlesss the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia;

(3) Correspondence transmitted by facsimile to the Patent and Trademark Office will be stamped with the date on which the complete transmission is received in the Patent and Trademark Office unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date stamped will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia.

(b) Patent and Trademark Office Post Office pouch.
Mail placed in the Patent and Trademark Office pouch up to midnight on any day, except Saturdays, Sundays and Federal holidays within the District of Columbia, by the post office at Washington, D.C. serving the Patent and Trademark Office, is considered as having been received in the Patent and Trademark Office on the day it was so placed in the pouch by the U.S. Postal Service.

(c) Correspondence delivered by hand.

OLD EDITION

In addition to being mailed, correspondence may be delivered by hand during hours the Office is open to receive correspondence.

(d) Facsimile transmission.
Except in the cases enumerated below, correspondence, including authorizations to charge a deposit account, may be transmitted by facsimile. The receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §1.6(a)(3). To facilitate proper processing, each transmission session should be limited to correspondence to be filed in a single application or other proceeding beforethe Patent and Trademark Office. The application number of a patent or trademark application, the control number of a reexamination proceeding, the interference number of an interference proceeding, the patent number of a patent,
or the registration number of a trademark should be entered as a part of the sender's identification on a facsimile cover sheet. Facsimile transmissions are not permitted and if submitted, will not be accorded a date of receipt, in the following situations:

(1) Correspondence as specified in §1.4(e), requiring an original signature;

(2) Certified documents as specified in §1.4(f);

(3) Correspondence which cannot receive the benefit of the certificate of mailing or transmission as specified in §1.8(a)(2)(i)(A) through (D) and (F); 1.8(a)(2)(ii)(A) and (D); and 1.8(a)(2)(iii)(A);

(4) Drawings submitted under §§1.81, 1.83 through 1.85, 1.152, 1.165, 1.174, 1.437, 2.51, 2.52, or 2.72;

(5) A request for reexamination under §1.510;

(6) Correspondence to be filed in a patent application subject to a secrecy order under §§5.1 through 5.8 of this chapter and directly related to the secrecy order content of the application;

(7) Requests for cancellation or amendment of a registration under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e); and certificates of registration surrendered for cancellation or amendment under section 7(e) of the Trademark Act, 15 U.S.C. 1057(e);

(8) Correspondence to be filed with the Trademark Trial and Appeal Board, except the notice of ex parte appeal;

(9) Correspondence to be filed in an interference proceeding which consists of a preliminary statement under §1.621; a transcript of a deposition

OLD EDITION

under §1.676 or interrogatories, cross-interrogatories, or recorded answers under §1.684(c); or an evidentiary record and exhibits under §1.653.

(e) Interruptions in U.S. Postal Service.
If interruptions or emergencies in the United States Postal Service which have been so designated by the Commissioner occur, the Patent and Trademark Office will consider as filed on a particular date in the Office any correspondence which is:

(1) Promptly filed after the ending of the designated interruption or emergency; and

(2) Accompanied by a statement indicating that such correspondence would have been filed on that particular date if it were not for the designated interruption or emergency in the United States Postal Service. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter.

Correspondence received in the PTO is stamped with the date of receipt (i.e., the "filing" date) unless the correspondence is filed by the "Express Mail" procedure provided in 37 CFR §1.10, or by fax transmission (for correspondence which is permitted to be filed by fax) in accordance with 37 CFR §1.6(d), in which case the correspondence is date-stamped as described below. See 37 CFR §1.6(a). The "date of receipt" of correspondence mailed to the PTO is the date stamped by the Post Office on the mail bags in which the correspondence is delivered to the PTO. See 37 CFR §1.6(b), and In re Klein, 6 USPQ2d 1528, 1536 (Dep't Comm.. 1986).

When correspondence intended for the Board is filed by the "Express Mail Post Office to Addressee" service of the United States Postal Service with a certificate of mailing, in accordance with the procedure described in 37 CFR §1.10, it is stamped with the date the correspondence is shown to have been deposited with the United States Postal Service (unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date assigned will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia). See 37 CFR §§1.6(a)(2) and 1.10. If the correspondence is filed by the "Express Mail Post Office to Addressee" service without a certificate of mailing by "Express Mail," or with a deficient certificate, and the correspondence is actually received at the PTO bearing a clear indication on the "Express Mail" label of the "date in," the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). See

OLD EDITION

"Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10," 1174 TMOG 92 (May 16, 1995).

If correspondence which is permitted to be filed by fax transmission to the Board is filed by that method with a certificate of transmission in accordance with 37 CFR §1.8(a), the transmission date specified in the certificate of transmission is used for purposes of determining the timeliness of the correspondence. The date of receipt, as described in 37 CFR §1.6(a)(3), is used for all other purposes. See 37 CFR §1.8(a). For further information concerning correspondence which may be filed by fax transmission to the Board, see TBMP §107.

When correspondence intended for the Board is filed by first-class mail with a certificate of mailing, in accordance with the procedure described in 37 CFR §1.8(a), it is stamped with the date of receipt of the correspondence in the PTO, i.e., the date on the mail bags in which the correspondence is delivered to the PTO. The mailing date specified in the certificate of mailing is used for purposes of determining the timeliness of the correspondence. The date of receipt is used for all other purposes. See 37 CFR §§1.6(a) and 1.8(a).

For information concerning the date stamped by the PTO on correspondence when interruptions or emergencies occur in the United States Postal Service, see 37 CFR §1.6(e).

OLD EDITION

110 Certificate of Mailing or Transmission Procedure

110.01 In General

37 CFR §1.8 Certificate of mailing or transmission.
(a) Except in the cases enumerated in paragraph (a)(2) of this section, correspondence required to be filed in the Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) the correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) deposited with the U.S. Postal Service with sufficient postage as first class mail addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231; or

(B) transmitted by facsimile to the Patent and Trademark Office in accordance with §1.6(d); and

(ii) the correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

(2) The procedure described in paragraph (a)(1) of this section does not apply to, and no benefit will be given to a Certificate of Mailing or Transmission on the following:

(i) Relative to Patents and Patent Applications

* * *

(ii) Relative to Trademark Registrations and Trademark Applications

A. The filing of a trademark application;

B. The filing of an affidavit showing that a mark is still in use or containing an excuse for nonuse under section 8(a) or (b) or section 12(c) of the Trademark Act, 15 U.S.C. 1058(a), 1058(b), 1062(c);

C. The filing of an application for renewal of a registration under section 9 of the Trademark Act, 15 U.S.C. 1059;

D. The filing of a petition to cancel a registration of a mark under section 14, subsection (1) or (2) of the Trademark Act, 15 U.S.C. 1064;

E. In an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), the filing of an amendment to allege use in commerce under section 1(c) of the Trademark Act, 15 U.S.C. 1051(c); or the filing of a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1);

F. In an application under section 1(b) of the Trademark Act, 15 U.S.C. 1051(b), the filing of a request under section 1(d)(2) of the Trademark Act, 15 U.S.C. 1051(d)(2), for an extension of time to file a statement of use under section 1(d)(1) of the Trademark Act, 15 U.S.C. 1051(d)(1).

(iii) Relative to Disciplinary Proceedings

A. Correspondence filed in connection with a disciplinary proceeding under Part 10 of this chapter.

B. Reserved.

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in

OLD EDITION

the Patent and Trademark Office, and the application is held to be abandoned or the proceeding dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence,

(2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and

(3) includes a statement which attests on a personal knowledge basis or to the satisfaction of the Commissioner to the previous timely mailing or transmission. Such statement must be a verified statement if made by a person other than a practitioner as defined in §10.1(r) of this chapter. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

(c) The Office may require additional evidence to determine if the correspondence was timely filed.

Except in certain instances, specified in 37 CFR §1.8(a), as amplified by 37 CFR §1.6(d), correspondence required to be filed within a set period of time will be considered as being timely filed, even though the correspondence is not received by the PTO until after the expiration of the set period, if, prior to the expiration of the set period, (1) the correspondence is mailed to the PTO by first-class mail, with the proper address, or (for correspondence which is permitted to be filed by fax) is transmitted to the PTO by fax, in accordance with 37 CFR §1.6(d), and (2) includes a certificate of mailing or transmission which meets the requirements specified in 37 CFR §1.8(a). See 37 CFR §1.8(a), and In re LS Bedding, 16 USPQ2d 1451 (Comm'r 1990).

In effect, the certificate of mailing or transmission procedure permits certain types of correspondence, as specified in 37 CFR §§1.8(a) and 1.6(d), to be sent to the PTO by first-class mail, or by fax transmission, even on the due date for the correspondence and still be considered timely, notwithstanding the fact that the mailed correspondence will not be received in the PTO until after the due date, or that the fax transmission may not, because of equipment failure or maintenance requirements, be completed until the next day.

However, the PTO, in its discretion, may require additional evidence to determine if correspondence which bears a certificate of mailing or a certificate

OLD EDITION

of transmission was timely filed, i.e., was mailed or transmitted on the date stated in the certificate. See 37 CFR §1.8(c), and In re Klein, 6 USPQ2d 1547 (Comm'r 1987), aff'd sub nom. Klein v. Peterson, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), aff'd 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), cert. denied, 490 U.S. 1091, 109 S.Ct. 2432 (1989).

The certificate of mailing procedure applies to the filing of all types of correspondence in Board proceedings, except the filing of a petition to cancel a registration of a mark under Section 14(1) or 14(2) of the Act, 15 U.S.C. §1064(1) or 1064(2). See 37 CFR §1.8(a), and TBMP §110.07.

The certificate of transmission procedure is available in Board proceedings only for the filing of a notice of ex parte appeal to the Board. See 37 CFR §§1.6(d) and 1.8(a), and TBMP §107.

OLD EDITION

110.02 Requirements for Certificate

The requirements for filing trademark-related papers (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) by the certificate of mailing or transmission procedure are as follows:

1. Prior to the expiration of the set period, the correspondence must be either (i) deposited with the U.S. Postal Service, with sufficient postage as first-class mail, addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, or (ii) (for correspondence which is permitted to be filed by fax) transmitted to the PTO by fax, in the manner described in 37 CFR §1.6(d); and
2. Each piece of correspondence must include a certificate which states the date of deposit or transmission, and which is signed (separate and apart from any signature for the piece of correspondence itself) by a person who has reasonable basis to expect that the correspondence will be mailed or transmitted on or before the date indicated.

See 37 CFR §1.8(a), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).

Alternatively, until such time as 37 CFR §1.8 has been amended to specify that trademark-related mail (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark

application and registration documents) must be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, such correspondence may continue to be sent to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 address. Any certificate of mailing used on correspondence sent to the Washington, D.C. address should specify that address. See "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).

Trademark-related documents sent to the Assignment Branch for recordation, and requests for certified copies of trademark application and registration documents, should be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. If a certificate of mailing is used on such correspondence, it should specify that address.

The certificate of mailing procedure may not be used for mail sent to the Patent and Trademark Office from a foreign country, because U.S. Postal Service first-class mail services are not available in foreign countries.

A certificate of mailing or a certificate of transmission should be clearly labeled as such.

OLD EDITION

110.03 Suggested Format

Shown below is a suggested format for a certificate of mailing, under 37 CFR §1.8, for trademark-related mail (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents)

Certificate of Mailing

I hereby certify that this correspondence
is being deposited with the United States
Postal Service with sufficient postage as
first-class mail in an envelope addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

.

on _____ _____
Date Signature

_____
Typed or printed name
of person signing
certificate

See "Changes in Signature and Filing Requirements for Correspondence filed in the Patent and Trademark Office," l157 TMOG 86 (December 28, 1993), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).

Shown below is a suggested format for a certificate of transmission under 37 CFR §1.8:

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on _____
Date .

_____
Signature

_____
Typed or printed name
of person signing
certificate

OLD EDITION

See "Changes in Signature and Filing Requirements for Correspondence filed in the Patent and Trademark Office," l157 TMOG 86 (December 28, 1993).

110.04 Location of Certificate

If one of the simple certificate of mailing or certificate of transmission formats shown in TBMP §110.03 is used, it may be applied by rubber stamp to the first page of the correspondence, if feasible. Otherwise, it should be stamped or typed in its entirety on the last page of the correspondence to which it pertains. If the

certificate is typed, and there is not enough room on the last page to type the certificate in its entirety, it should at least be started on the last page, so that only part of it continues over to another page. The simple certificate of mailing or certificate of transmission format should never be used by itself on a separate page at the end of the correspondence. If it is, and the page becomes detached from the rest of the submission, there will be no way of determining the identity of the correspondence to which it relates, and the benefit of the certificate will be lost.

In some cases, there may not be room for a certificate of mailing or a certificate of transmission on a piece of correspondence. In such a case, the certificate may be typed on a separate sheet of paper securely attached to the correspondence. However, the simple certificate formats shown in TBMP §110.03 are not appropriate for use on a separate sheet of paper. Rather, a certificate placed on a separate sheet of paper must include additional information, namely, a description of the nature of the correspondence to which it pertains, as well as the identity of the application, registration, or PTO proceeding in connection with which the correspondence is being filed. If there is any doubt concerning the identity of the correspondence to which a certificate of mailing or certificate of transmission on a separate sheet pertains, the certificate will not be accepted.

OLD EDITION

110.05 Loss of Certificate of Mailing

If a certificate of mailing is typed on a separate sheet of paper attached to a piece of correspondence, and the certificate becomes detached, after the correspondence is filed in the PTO, and does not contain identifying information sufficient to enable the PTO to associate the certificate with the appropriate piece of correspondence, the PTO will accept, as evidence that the certificate was filed with the specified correspondence, a postcard receipt (see TBMP §108) which identifies the separate certificate of mailing sheet and the correspondence to which it was attached; accompanied by a copy of the certificate of mailing sheet as originally mailed.

110.06 Nonreceipt of Correspondence Bearing Certificate

In the event that correspondence intended for the PTO is timely filed with an appropriate certificate of mailing or certificate of transmission, pursuant to 37 CFR §1.8, but is not received in the PTO, and there is a resulting PTO action, in a proceeding or an application, which is adverse to the submitting party, the correspondence will be considered timely if the party which submitted it (1) informs the PTO of the previous mailing or facsimile transmission of the correspondence promptly after becoming aware that the PTO has no evidence of receipt of the correspondence, (2) supplies an additional copy of the previously mailed or transmitted correspondence and certificate, and (3) includes a statement attesting, on a personal knowledge basis or to the satisfaction of the Commissioner, to the previous timely mailing or transmission. The statement must be verified if it is made by a person other than a practitioner, as defined in 37 CFR §10.1(r). If the correspondence was filed by fax transmission, a copy of the sending fax machine's report confirming transmission may be used to support the statement. See 37 CFR §1.8(b).

For lost or misplaced correspondence intended for the Board, the evidence required by 37 CFR §1.8(b) should be submitted to the Board for consideration. If the requirements of 37 CFR §1.8(b) cannot be met, the only alternative is a petition to the Commissioner.

OLD EDITION

110.07 Excluded Filings

The certificate of mailing procedure is not applicable to the filing of certain types of correspondence. The excluded filings include:

(1) A petition to cancel the registration of a mark under Section 14(1) or 14(2) of the Act, 15 U.S.C. §1064(1) or 1064(2);

(2) Certain other filings, as specified in 37 CFR §1.8(a), not pertaining to Board proceedings.

The certificate of mailing procedure is applicable to all other types of filings in Board proceedings, including a notice of opposition; a request for an extension of time to oppose; a notice of appeal to the Board from a final refusal of registration; a notice of appeal to the Court of Appeals for the Federal Circuit from a decision of the Board; and a notice of election (in an inter partes proceeding) to proceed by civil action under Section 21(a)(1) of the Act of 1946, 15 U.S.C. §1071(a)(1), in response to another party's appeal to the Court of Appeals for the Federal Circuit.

At present, the certificate of transmission procedure is not applicable to any correspondence intended for the Board, except for the notice of appeal in an ex parte appeal to the Board. See 37 CFR §1.6(d). See also TBMP §107.

110.08 A Certificate of Mailing or Transmission is Not...

As is evident from the requirements for a certificate of mailing, specified in 37 CFR §1.8(a), the certificate of mailing procedure is not the same as mailing by certified mail. Correspondence sent to the Board by certified mail, and not in compliance with the 37 CFR §1.8(a) requirements for a certificate of mailing, will be stamped with the date of receipt of the correspondence in the PTO, and that date will be used for all purposes, including the timeliness of the filing of the correspondence. See 37 CFR §§1.6 and 1.8.

Further, a certificate of mailing or certificate of transmission is not the equivalent of a certificate of service. A certificate of mailing or certificate of transmission indicates when correspondence was sent to the PTO pursuant to the provisions of 37 CFR §1.8(a). The mailing date recited in a certificate of mailing, or the transmission date recited in a certificate of transmission, is used for purposes of determining the timeliness of the filing of the correspondence bearing the certificate. A certificate of service, on the other hand, indicates the date when a copy of the correspondence was served (by hand delivery, first-class mail, "Express Mail," or overnight courier) upon another party. A certificate of service has no bearing on the timeliness of the filing of the correspondence.

OLD EDITION

111 Certificate of Mailing by "Express Mail" Procedure

111.01 In General

37 CFR §1.10 Filing of papers and fees by "Express Mail" with certificate.
(a) Any paper or fee to be filed in the Patent and Trademark Office can be filed utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service and be considered as having been filed in the Office on the date the paper or fee is shown to have been deposited as "Express Mail" with the

United States Postal Service unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia. See §1.6(a).

(b) Any paper or fee filed by "Express Mail" must have the number of the "Express Mail" mailing label placed thereon prior to mailing, be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, and any such paper or fee must also include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee.

(c) The Patent and Trademark Office will accept the certificate of mailing by "Express Mail" and accord the paper or fee the certificate date under 35 U.S.C. 21(a) (unless the certificate date is a Saturday, Sunday, or Federal holiday within the District of Columbia--see §1.6(a)) without further proof of the date on which the mailing by "Express Mail" occurred unless a question is present regarding the date of mailing. If more than a reasonable time has elapsed between the certificate date and the Patent and Trademark Office receipt date or if other questions regarding the date of mailing are present, the person mailing the paper or fee may be required to file a copy of the "Express Mail" receipt showing the actual date of mailing and a statement from the person who mailed the paper or fee averring to the fact that the mailing occurred on the date certified. Such statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

Any paper or fee to be filed in the PTO, including any paper or fee intended for the Board, can be filed by the certificate of mailing by "Express Mail" procedure described in 37 CFR §1.10. Under this procedure, papers or fees can be filed utilizing the "Express Mail Post Office to Addressee" service (not the "Express Mail Post Office to Post Office" service) of the United States Postal Service, and be considered as having been filed in the PTO on the date the paper or fee is shown to have been deposited as "Express Mail" with the United States Postal Service (unless the date of deposit is a Saturday, Sunday, or Federal holiday within the District of Columbia, in which case the date assigned will be the next succeeding day which is not a Saturday, Sunday, or Federal holiday within the District of Columbia). See 37 CFR §1.10(a).

In effect, the certificate of mailing by "Express Mail" procedure permits all types of correspondence to be sent to the PTO by the "Express Mail Post Office to Addressee" service even on the due date for the correspondence and still be

OLD EDITION

considered timely, notwithstanding the fact that the mailed correspondence may not be received in the PTO until after the due date.

NOTE: Pending amendment of 37 CFR §1.10 to delete the requirement for a certificate of mailing and to incorporate requirements for the resubmission of misplaced correspondence which parallel those requirements specified in 37 CFR §1.8, if correspondence is filed by the "Express Mail Post Office to Addressee" service without a certificate of mailing by "Express Mail," or with a deficient certificate, and the correspondence is actually received at the PTO bearing a clear indication on the "Express Mail" label of the "date in," the paper will be stamped with the "date in" as the date of receipt (unless the "date in" is a Saturday, Sunday, or Federal holiday within the District of Columbia). See "Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10," 1174 TMOG 92 (May 16, 1995).

OLD EDITION

111.02 Requirements for Certificate

Trademark-related papers (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) filed by the certificate of mailing by "Express Mail" procedure must:

1. Have the number of the "Express Mail" mailing label placed thereon prior to mailing;
2. Be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513; and
3. Include a certificate of mailing by "Express Mail" which states the date of mailing by "Express Mail" and is signed by the person mailing the paper or fee. See 37 CFR §1.10(b), and "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).

Alternatively, until such time as 37 CFR §1.10 has been amended to specify that trademark-related mail (except for trademark-related documents sent to the Assignment Branch for recordation and requests for certified copies of trademark application and registration documents) must be addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, such correspondence may continue to be sent to the Commissioner of Patents and Trademarks, Washington, D.C. 20231 address. Any certificate of mailing by "Express Mail" used on correspondence sent to the Washington, D.C.

address should specify that address. See "Change of Address For Trademark Applications and Trademark Related Papers," 1163 TMOG 80 (June 28, 1994).

Trademark-related documents sent to the Assignment Branch for recordation, and requests for certified copies of trademark application and registration documents, should be addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231. If a certificate of mailing by "Express Mail" is used on such correspondence, it should specify that address.

When a piece of mail is sent by the "Express Mail Post Office to Addressee" service of the United States Postal Service, the Postal Service applies a numbered mailing label, with the date of mailing written thereon, to the envelope. Each paper or fee filed by the certificate of mailing by "Express Mail" procedure must bear both the number of this "Express Mail" mailing label and the required certificate of mailing by "Express mail."

A party which wishes to send mail to the PTO by the "Express Mail" service of the U.S. Postal Service should be careful to use the "Express Mail Post Office to Addressee" service, rather than the "Express Mail Post Office to Post Office" service. Mail sent to the PTO, pursuant to 37 CFR §1.10, by the "Express Mail Post Office to Addressee" service of the United States Postal Service is delivered to a PTO employee. Mail sent to an addressee by the "Express Mail Post Office to Post Office" service, on the other hand, is sent to a post office near the addressee, where it is held for 15 days for pickup by the addressee and then, if no pickup is made, returned to the sender. The PTO does not pick up mail from post offices. Thus, correspondence sent to the PTO by the "Express Mail Post Office to Post Office" service will not reach the PTO but instead will be returned to the sender.

OLD EDITION

111.03 Location of Certificate

When correspondence is filed with the PTO by the certificate of mailing by "Express Mail" procedure provided in 37 CFR §1.10, the number of the "Express Mail" mailing label, and the certificate of mailing by "Express Mail," should be placed directly on the piece of correspondence itself, or, if that is not feasible, on a separate paper securely attached thereto. Cf.: TBMP §110.04. As in the case of a certificate of mailing by first-class mail or a certificate of

transmission, the certificate of mailing by "Express Mail" may be applied to a piece of correspondence by means of a rubber stamp.

111.04 Suggested Format

Shown below is a suggested format for a certificate of mailing by "Express Mail" under 37 CFR §1.10:

Certificate of Mailing by "Express Mail"

"Express Mail" mailing label number _____

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on _____.
Date

_____
Signature of person mailing correspondence

_____
Typed or printed name of person mailing correspondence

OLD EDITION

111.05 Questionable Date of Mailing

If more than a reasonable time has elapsed between the "Express Mail" mailing date specified in a 37 CFR §1.10 certificate of mailing by "Express Mail" and the date of receipt of the correspondence by the PTO, or if there are other questions regarding the date of mailing, the party filing the correspondence may be required to file a copy of the "Express Mail" receipt (furnished by the Postal Service at the time of mailing) showing the actual date of mailing, together with a statement from the person who mailed the correspondence averring to the fact

that the mailing occurred on the date specified. If the person who makes the statement is not registered to practice before the PTO, the statement must be verified. See 37 CFR §1.10(c).

112 Times for Taking Action

37 CFR §1.7 Expiration on Saturday, Sunday or Federal holiday. Whenever periods of time are specified in this part in days, calendar days are intended. When the day, or the last day fixed by statute or by or under this part for taking any action or paying any fee in the Patent and Trademark Office falls on Saturday, Sunday or on a Federal holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a Federal holiday. See §1.304 for time for appeal or for commencing civil action.

See also Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991); and Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990).

For example, if, as set by the Board, an answer to a complaint falls due on a Saturday, Sunday, or Federal holiday within the District of Columbia, an answer filed on the next business day will be considered timely. If, as set by the Board, the close of discovery falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, written requests for discovery (i.e., interrogatories, requests for production of documents, and requests for admission) may be served, and discovery depositions may be taken, on the next business day. Similarly, if, as set by the Board, the close of a testimony period falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, testimony depositions may be taken, and other evidence may be offered, on the next business day.

If, because of some unscheduled event, such as adverse weather conditions, the PTO is officially closed by Executive Order of the President or by the Office of Personnel Management for an entire day, that day will be regarded by the PTO as a federal holiday within the District of Columbia. Any action due to be taken, or fee due to be paid, on that day, will be considered timely if the action is taken, or the fee paid, on the next succeeding business day on which the PTO is open. If, because of an unscheduled event, the PTO is closed for part of a business day, but is open for business for some part of the day between 8:30 a.m. and 5:00

OLD EDITION

p.m., any action due to be taken, or fee due to be paid, on that day remains due on that day. See "Filing of Papers During Unscheduled Closings of the Patent and Trademark Office," 1076 TMOG 6 (March 10, 1987).

113 Service of Papers

37 CFR §2.119 Service and signing of papers.
(a) Every paper filed in the Patent and Trademark Office in inter partes cases, including notice of appeal, must be served upon the other parties except the notice of interference (§2.93), the notification of opposition (§2.105), the petition for cancellation (§2.113), and the notice of a concurrent use proceeding (§2.99), which are mailed by the Patent and Trademark Office. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service.

(b) Service of papers must be on the attorney or other authorized representative of the party if there be such or on the party if there is no attorney or other authorized representative, and may be made in any of the following ways:

(1) By delivering a copy of the paper to the person served;

(2) By leaving a copy at the usual place of business of the person served, with someone in the person's employment;

(3) When the person served has no usual place of business, by leavina a copy at the person's residence, with a member of the person's family over 14 years of age and of discretion;

(4) Transmission by the "Express Mail Post Offfice to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered;

(5) Transmission by overnight courier.

Whenever it shall be satisfactorily shown to the Commissioner that none of the above modes of obtaining service or serving the paper is practicable, service may be by notice published in the Official Gazette.

(c) When service is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier will be considered the date of service. Whenever a party is required to take some action within a prescribed period after the service of a paper upon the party by another

OLD EDITION

party and the paper is served by first-class mail, "Express Mail," or overnight courier, 5 days shall be added to the prescribed period.

* * *

113.01 Requirement for Service of Papers

Every paper filed in an inter partes proceeding before the Board, including a notice of appeal from a decision of the Board, must be served by the filing party upon every other party to the proceeding. The only exceptions to this rule are the notice of opposition and petition for cancellation, which are mailed by the Board to the defendant or defendants; and any requests for discovery filed by an opposer or petitioner with the notice of opposition or petition for cancellation (i.e., the complaint) for service by the Board along with the complaint. See 37 CFR §2.119(a), and FRCP 33(a), 34(b), and 36(a).

The requirement for service of papers applies not only to papers filed in an inter partes proceeding before the Board, but also to papers filed in an application or registration which is the subject of such a proceeding, if the papers could have an effect on the inter partes proceeding. For example, a request to amend or correct an application or registration which is the subject of an inter partes proceeding; an abandonment of the application; or a voluntary surrender of the registration, must all be served by the defendant upon every other party to the proceeding.

113.02 Requirement for Proof of Service

When a party to an inter partes proceeding before the Board files a paper required, by 37 CFR §2.119(a), to be served upon every other party to the proceeding, proof that the required service has been made ordinarily must be submitted before the paper will be considered by the Board. Occasionally, in order to expedite matters, and when the interests of the other party or parties would be served thereby, the Board itself will serve, along with an action of the Board relating thereto, a copy of a paper which does not include the required proof of service. For example, if an applicant in an opposition files an abandonment of its involved application without the written consent thereto of the opposer, and the abandonment does not include proof of service upon the

OLD EDITION

opposer, the Board does not send out an action stating that the abandonment will not be considered until proof of service has been submitted. Rather, the Board itself mails a copy of the abandonment to the opposer, along with a copy of an action by the Board entering judgment in opposer's favor pursuant to 37 CFR §2.135 (which provides, in part, that after the commencement of an opposition, if the applicant files a written abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant).

113.03 Elements of Certificate of Service

The Board will accept, as prima facie proof that a party filing a paper in a Board inter partes proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. The statement should also specify the name of each party or person upon whom service was made. The statement must appear on, or be securely attached to, the paper being filed. If the statement is on a separate sheet attached to the paper being filed, it should clearly identify the paper and proceeding to which it relates. See 37 CFR §2.119(a).

113.04 Manner of Service

When a party to an inter partes proceeding before the Board files a paper required, by 37 CFR §2.119(a), to be served upon every other party to the proceeding, service may be made in any of the ways specified in 37 CFR §2.119(b). They are: (1) by hand delivering a copy of the paper to the person being served; (2) by leaving a copy of the paper at the usual place of business of the person being served, with someone in the person's employment; (3) when the person being served has no usual place of business, by leaving a copy of the paper at the person's address, with a member of the person's family over 14 years of age and of discretion; (4) transmission by the "Express Mail Post Office to Addressee" service of the United States Postal Service or by first-class mail, which may also be certified or registered; and (5) transmission by overnight courier. In addition, whenever it is satisfactorily shown to the Commissioner that

OLD EDITION

none of the specified modes of serving the paper is practicable, service may be made by notice published in the Official Gazette of the PTO.

When service of a paper is made by mail, pursuant to 37 CFR §2.119(b)(4), the Board considers the mailing date of the paper to be the date when the paper is deposited with the United States Postal Service, i.e., the date when custody of the paper passes to the Postal Service. As provided in 37 CFR §2.119(a), the Board ordinarily accepts, as prima facie proof of the date of mailing, the statement signed by the filing party, or by its attorney or other authorized representative, as to the date and manner of service. However, where the prima facie proof of the certificate of service is rebutted by other evidence, and the paper would be timely served if mailed on the date specified in the certificate of service, but untimely served if not mailed until the date indicated by the rebutting evidence, the Board may request that the person who signed the certificate of service submit an affidavit specifying the date when the paper was actually deposited with the United States Postal Service.

A party filing a paper in a Board inter partes proceeding may always, as a courtesy, send a copy of the paper to an adverse party by telephonic facsimile transmission ("fax"). However, transmission of the paper by fax does not constitute "service" thereof under the provisions of 37 CFR §2.119. Notwithstanding the fax transmission, the paper must still be served upon the adverse party by one of the methods specified in 37 CFR §2.119(b), and the date of service of the paper upon the adverse party is the date when service is made by one of those specified methods.

OLD EDITION

113.05 Additional Time for Taking Action After Service by Mail

Whenever a party to an inter partes proceeding before the Board is required to take some action within a prescribed period of time after the service of a paper upon that party by another party to the proceeding, and the paper is served by first-class mail, "Express Mail," or overnight courier, the time for taking action is enlarged by 5 days. See 37 CFR §2.119(c).

For example, if one party to a proceeding serves, upon another party to the proceeding, a motion to compel discovery, and service of the motion is made by first-class mail, "Express Mail," or overnight courier, the served party's time for filing a response to the motion will be 20 days from the date of service of the

motion, that is, from the date of mailing or of delivery to the overnight courier. Because the service was made by first-class mail, "Express Mail," or overnight courier, 5 days are added to the 15-day period prescribed in 37 CFR §2.127(a) for filing a response to a motion.

Trademark Rule 2.119(c), 37 CFR §2.119(c), applies only when a party has to take some action within a prescribed period after the service of a paper upon it by another party, and service of the paper was made in one of three specified ways. It does not apply to an action which must be taken by a party within a time set in a communication from the Board. Thus, for example, when a Board letter notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the date of the notification letter in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day.

113.06 A Certificate of Service is Not...

A certificate of service is not the equivalent of a certificate of mailing or transmission for any purpose. Cf. TBMP §110.08.

114 Representation of a Party

37 CFR §10.14 Individuals who may practice before the Office in trademark and other non-patent cases.
(a) Attorneys. Any individual who is an attorney may represent others before the Office in trademark and other non-patent cases. An attorney is not required to apply for registration or recognition to practice before the Office in trademark and other non-patent cases.

(b) Non-lawyers. Individuals who are not attorneys are not recognized to practice before the Office in trademark and other non-patent cases, except that individuals not attorneys who were recognized to practice before the Office in trademark cases under this chapter prior to Jan. 1, 1957, will be recognized as agents to continue practice before the Office in trademark cases.

OLD EDITION

(c) Foreigners. Any foreign attorney or agent not a resident of the United States who shall prove to the satisfaction of the Director that he or she is registered or in good standing before the patent or trademark office of the country in which he or she resides and practices, may be recognized for the limited purpose of representing parties located in such country before the Office in the presentation and prosecution of trademark cases, provided: the patent or trademark office of such country allows substantially reciprocal privileges to those permitted to practice in trademark cases before the United States Patent and Trademark Office. Recognition under this paragraph shall continue only during the period that the conditions specified in this paragraph obtain.

(d) Recognition of any individual under this section shall not be construed as sanctioning or authorizing the performance of any act regarded in the jurisdiction where performed as the unauthorized practice of law.

(e) No individual other than those specified in paragraphs (a), (b), and (c) of this section will be permitted to practice before the Office in trademark cases. Any individual may appear in a trademark or other non-patent case in his or her own behalf. Any individual may appear in a trademark case for (1) a firm of which he or she is a member or (2) a corporation or association of which he or she is an officer and which he or she is authorized to represent, if such firm, corporation, or association is a party to a trademark proceeding pending before the Office.

OLD EDITION

114.01 Party May Represent Itself

A party may represent itself in an ex parte or inter partes proceeding before the Board, or the party may be represented by an attorney or other authorized representative. See 37 CFR §10.14(e).

If a partnership which is a party to a Board proceeding elects to represent itself, the partnership may act through an individual who is a partner. If a party electing to represent itself is a corporation or an association, the party may act through any individual who is an officer of the party and who is authorized to represent it. See 37 CFR §10.14(e).

However, because the governing practices and procedures in proceedings before the Board are quite technical and highly specialized, it is strongly recommended that a party be represented by an attorney familiar with trademark law.

114.02 Selection of Attorney

The Board cannot aid a party in the selection of an attorney, nor does the PTO maintain a register or list of trademark attorneys. See 37 CFR §2.11.

114.03 Representation by Attorney

Any attorney, as that term is defined in 37 CFR §10.1(c) [i.e., "an individual who is a member in good standing of the bar of any United States court or the highest court of any state"], is eligible to represent others before the PTO in trademark cases, including proceedings before the Board, and in other non-patent cases. Such an attorney is not required to apply to the PTO for registration or recognition to practice before the PTO in trademark and other non-patent cases. See 37 CFR §§10.1(c) and 10.14(a), and Weiffenbach v. Klempsay, 29 USPQ2d 2027 (Dep't Comm. 1993).

An attorney, as defined in 37 CFR §10.1(c), will be accepted as a representative of a party in a proceeding before the Board if the attorney either (1) makes an appearance in the proceeding (as, for example, by filing a paper) on behalf of the party and satisfactorily identifies himself or herself as an attorney, see Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991), or (2) files a written power of attorney signed by the party the attorney represents.

When an attorney, as defined in 37 CFR §10.1(c), acting in a representative capacity signs a paper or appears in person in a proceeding before the Board, his or her personal signature or appearance constitutes, inter alia, a representation to the PTO that, under the provisions of 37 CFR §10.14 (which specifies the types of individuals who may practice before the PTO in trademark and other non-patent cases) and the laws he or she is authorized to represent the particular party in whose behalf he or she acts. If there is some question as to whether an individual who makes such an appearance is authorized to act in a representative

OLD EDITION

capacity, further proof of his or her authority may be required. See 37 CFR §2.17(a).

If a formal power of attorney is filed in a proceeding before the Board, it should state the name and address of the individual or individuals to whom the power is granted, identify the party granting the power, indicate the power being granted (e.g., "to represent Opposer in this proceeding, with full power of substitution and revocation, and to transact all business in the United States Patent and Trademark Office in connection therewith"), and be signed by the party granting the power. The PTO requires that a power of attorney specify the names of one or more individuals. A power which specifies both the names of one or more individuals and the name of a firm will be regarded as a power to the individual(s). A power which specifies only the name of a firm will be regarded not as a power to the firm but rather simply as a designation of an address to which correspondence is to be sent. See TMEP §602.01 and TBMP §117.

OLD EDITION

114.04 Representation by Non-lawyer (i.e., "Other Authorized Representative")

The only non-lawyers permitted to represent others in trademark cases before the PTO, including proceedings before the Board, are those who were recognized to practice before the PTO in trademark cases under Chapter 1 of 37 CFR prior to January 1, 1957. See 37 CFR §10.14(b); Weiffenbach v. Klempsay, 29 USPQ2d 2027 (Dep't Comm. 1993); and Weiffenbach v. Frank, 18 USPQ2d 1397 (Comm'r 1991). Before such a representative may take any action of any kind in a proceeding before the Board, however, the representative must file in the proceeding a written authorization from the party which he or she represents, or from another person entitled to prosecute the case (e.g., the party's appointed attorney of record). See 37 CFR §2.17(b).

114.05 Representation by Foreign Attorney or Agent

Under certain conditions, specified in 37 CFR §10.14(c), a foreign attorney or agent who is not a resident of the United States may be recognized for the limited purpose of representing, in trademark cases before the PTO, parties located in the country in which the attorney or agent resides or practices. For information on

how to meet the specified conditions, contact the PTO's Office of Enrollment and Discipline.

114.06 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board. For information concerning who is entitled to practice before the PTO in trademark cases, see TBMP §§114.03-114.05.

If it comes to the attention of the Board that an individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, is attempting to represent a party in a Board proceeding, the Board will notify the individual that he or she is not entitled to do so. If the individual signs and files a paper on behalf of a party to a Board proceeding, the paper will not be considered unless a new copy thereof, signed by the party or by an authorized representative who is entitled to practice before the PTO in trademark cases, is filed. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the PTO in trademark cases. See 37 CFR §2.18 and TBMP §117.

OLD EDITION

114.07 Designation of Domestic Representative

37 CFR §2.24 Designation of representative by foreign applicant.
If an applicant is not domiciled in the United States, the applicant must designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If this document does not accompany or form part of the application, it will be required and registration refused unless it is supplied. Official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event official communications will be sent to the attorney at law or other qualified person duly authorized. The mere designation of a domestic representative does not authorize the person designated to

prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).

37 CFR 2.119(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party must designate by written document filed in the Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. In such cases, official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under §10.14(c) of this subchapter. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under §10.14(a), or qualified under paragraph (b) or (c) of §10.14 and authorized under §2.17(b).

Shown below is a suggested format for the designation of a domestic representative (the suggested format should appear below information identifying the proceeding in connection with which it is filed):

Designation of Domestic Representative

(Name of Domestic Representative), whose postal address is _____

_____,

is hereby designated (Name of Designating Party)'s representative upon whom notice or process in this proceeding may be served.

_____

(Signature of Designating Party)

_____

(Identification of Person Signing)

_____

(Date of Signature)

Once a party has appointed a domestic representative, all correspondence in the case will be sent to the domestic representative, unless the party is represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR §10.14(c). See TBMP §117.06.

OLD EDITION

114.08 Adverse Parties Represented by Same Practitioner

37 CFR §10.66 Refusing to accept or continue employment if the interests of another client may impair the independent professional judgment of the practitioner.
(a) A practitioner shall decline proffered employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the acceptance of the proffered employment, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(b) A practitioner shall not continue multiple employment if the exercise of the practitioner's independent professional judgment in behalf of a client will be or is likely to be adversely affected by the practitioner's representation of another client, or if it would be likely to involve the practitioner in representing differing interests, except to the extent permitted under paragraph (c) of this section.

(c) In the situations covered by paragraphs (a) and (b) of this section a practitioner may represent multiple clients if it is obvious that the practitioner can adequately represent the interest of each and if each consents to the representation after full disclosure of the possible effect of such representation on the exercise of the practitioner's independent professional judgment on behalf of each.

(d) If a practitioner is required to decline employment or to withdraw from employment under a Disciplinary Rule, no partner, or associate, or any other practitioner affiliated with the practitioner or the practitioner's firm, may accept or continue such employment unless otherwise ordered by the Director or Commissioner.

As a general rule, a practitioner (i.e., attorney or other authorized representative) may not represent parties with conflicting interests in proceedings before the PTO. That is, a practitioner normally may not accept proffered employment, or continue multiple employment, if the exercise of the practitioner's independent professional judgment on behalf of one client is likely to be adversely affected by the practitioner's representation of another client, or if the employment would be likely to involve the practitioner in representing differing interests. See 37 CFR

OLD EDITION

§§10.66(a) and (b); Gilman Corp. v. Gilman Brothers Co., 20 USPQ2d 1238 (Comm'r 1991); Halcon International, Inc. v. Werbow, 228 USPQ 611 (Comm'r 1980); Unico American Corp. v. Unico Banking Group, 223 USPQ 684 (Comm'r 1984); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 221 USPQ 1077 (Comm'r 1984); and Plus Products v. Con-Stan Industries, Inc., 221 USPQ 1071 (Comm'r 1984). See also Rules 1.7 and 1.9 of the American Bar Association's Model Rules of Professional Conduct.

However, a practitioner may represent multiple clients under the particular circumstances specified in 37 CFR §10.66(c).

If it comes to the attention of the Board that two or more parties whose interests are in conflict appear to be represented by the same practitioner, or by different practitioners within the same firm, each of the parties and their practitioner(s) will be notified by the Board, in writing, of the possible conflict of interest.

It is the responsibility of a practitioner to ensure that there is no violation of the rules cited above. If an impermissible conflict exists, a practitioner should take appropriate action immediately. A practitioner who fails to do so may be subjected to disciplinary action. See 37 CFR §10.20(b).

OLD EDITION

115 Conduct of Practitioner

115.01 Applicable Rules

The conduct of an attorney or other authorized representative in proceedings before the Board is governed by Part 10 of 37 CFR. Part 10 contains both Canons (set out in Rules 10.21, 10.30, 10.46, 10.56, 10.61, 10.76, 10.83, 10.100, and 10.110) and Disciplinary Rules (set out in Rules 10.22-10.24, 10.31-10.40, 10.47-10.57, 10.62-10.68, 10.77, 10.78, 10.84, 10.85, 10.87-10.89, 10.92, 10.93, 10.101-10.103, 10.111, and 10.112). Canons are "statements of axiomatic norms, expressing in general terms the standards of professional conduct expected of practitioners in their relationships with the public, with the legal system, and with the legal profession," while Disciplinary Rules are "mandatory in character and state the minimum level of conduct below which no practitioner can fall without being subjected to disciplinary action." See 37 CFR §10.20.

115.02 Disciplinary Proceedings

37 CFR 10.130 Reprimand, suspension or exclusion.
(a) The Commissioner may, after notice and opportunity for a hearing, (a) reprimand or (b) suspend or exclude, either generally or in any particular case, any individual, attorney, or agent shown to be incompetent or disreputable, who is guilty of gross misconduct, or who violates a Disciplinary Rule.

* * *

See Klein v. Peterson, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989); Weiffenbach v. Logan, 27 USPQ2d 1870 (Comm'r 1993); McCandlish v. Doe, 22 USPQ2d 1223 (Comm'r 1992); Weiffenbach v. Turner, 20 USPQ2d 1103 (Comm'r 1991); Weiffenbach v. Frank, 18 USPQ2d 1397 (Comm'r 1991); Small v. Weiffenbach, 10 USPQ2d 1898 (Comm'r 1989); In re Kalil, 2 USPQ2d 1614 (Dep't Comm. 1986); and In re Slater, 231 USPQ 497 (Comm'r 1985). See also Weiffenbach v. Klempay, 29 USPQ2d 2027 (Dep't Comm. 1993).

The rules governing disciplinary proceedings are set out in 37 CFR §§10.130-10.170. Such a proceeding is instituted only under the circumstances specified in 37 CFR §§10.131-10.132.

OLD EDITION

115.03 Petitions to Disqualify

37 CFR §10.130(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

Petitions to disqualify practitioners representing parties in ex parte or inter partes cases before the Board are not disciplinary proceedings and hence are not governed by 37 CFR §§10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR §10.130(b). For examples of cases involving petitions to disqualify, see the decisions cited in TBMP §114.08.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending

proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition.

For further information concerning petitions to disqualify, see TBMP §513.02.

116 Termination of Representation

116.01 Revocation of Authority

37 CFR §2.19 Revocation of power of attorney or of other authorization to represent; withdrawal.
(a) Authority to represent an applicant or a party to a proceeding may be revoked at any stage in the proceedings of a case upon notification to the Commissioner; and when it is so revoked, the Office will communicate directly with the applicant or party to the proceeding or with such other qualified person as may be authorized. The Patent and Trademark Office will notify the person affected of the revocation of his or her authorization.

* * *

Authority to represent a party in a proceeding before the Board may be revoked, at any stage of the proceeding, by filing a written revocation with the Board. Thereafter, the Board will not recognize that person as a representative in the case, or give any consideration to any papers which he or she may file therein, unless a new written authorization of that person, signed by the party, is filed in the proceeding.

OLD EDITION

116.02 Withdrawal as Representative--In General

37 CFR §2.19(b) An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Commissioner.

37 CFR §10.40 Withdrawal from employment.
(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this

subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

OLD EDITION

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;

(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

Under certain circumstances, a practitioner may withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board. A practitioner who wishes to withdraw must file a written request with the Board for permission to do so. The practitioner may not withdraw until he or she has complied with the conditions specified in 37 CFR §10.40(a).

OLD EDITION

116.03 When Withdrawal is Mandatory

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is mandatory under the circumstances specified in 37 CFR §10.40(b).

116.04 When Withdrawal is Permissive

Withdrawal from employment as the attorney or other authorized representative of a party to a Board proceeding is permissive under the circumstances specified in 37 CFR §10.40(c).

116.05 Request to Withdraw

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a

written request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§10.40(b) and (c). Moreover, the practitioner must comply with the requirements of 37 CFR §10.40(a). See 37 CFR §§2.19(b) and 10.40. Cf. In re Legendary Inc., 26 USPQ2d 1478 (Comm'r 1992).

For further information concerning the requirements for a request to withdraw as representative, and the action taken by the Board when such a request is granted, see TBMP §513.01.

117 Correspondence - With Whom Held

37 CFR §2.18 Correspondence, with whom held.
Correspondence will be sent to the applicant or a party to a proceeding at its address unless papers are transmitted by an attorney at law, or a written power of attorney is filed, or written authorization of other person entitled to be recognized is filed, or the applicant or party designates in writing another address to which correspondence is to be sent, in which event correspondence will be sent to the attorney at law transmitting the papers, or to the attorney at law designated in the power of attorney, or to the other person designated in the written authorization, or to the address designated by the applicant or party for correspondence. Correspondence will continue to be sent to such address until the applicant or party, or the attorney at law or other authorized representative of the applicant or party, indicates in writing that correspondence is to be sent to another address. Correspondence will be sent to the domestic representative of a foreign applicant unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event correspondence will be sent to the attorney at law or other qualified person duly authorized. Double correspondence will not be undertaken by the Patent and Trademark Office, and if more than one attorney at law or other authorized representative appears or signs a paper, the Office reply will be sent to the address already established in the file until another correspondence address is specified by the applicant or party or by the attorney or other authorized representative of the applicant or party.

37 CFR §2.24 Designation of representative by foreign applicant.
If an applicant is not domiciled in the United States, the applicant must designate by a written document filed in the Patent and Trademark Office the name and

OLD EDITION

address of some person resident in the United States on whom may be served notices or process in proceedings affecting the mark. If this document does not accompany or form part of the application, it will be required and registration refused unless it is supplied. Official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the application is being prosecuted by an attorney at law or other qualified person duly authorized, in which event official communications will be sent to the attorney at law or other qualified person duly authorized. The mere designation of a domestic representative does not authorize the person designated to prosecute the application unless qualified under paragraph (a), (b) or (c) of §10.14 of this subchapter and authorized under §2.17(b).

37 CFR 2.119(d) If a party to an inter partes proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, the party must designate by written document filed in the Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in the proceeding. In such cases, official communications of the Patent and Trademark Office will be addressed to the domestic representative unless the proceeding is being prosecuted by an attorney at law or other qualified person duly authorized under §10.14(c) of this subchapter. The mere designation of a domestic representative does not authorize the person designated to prosecute the proceeding unless qualified under §10.14(a), or qualified under paragraph (b) or (c) of §10.14 and authorized under §2.17(b).

OLD EDITION

117.01 In General

Whenever the Board takes an action in a proceeding before it, the Board sends a copy of the action to each party or to the party's attorney or other authorized representative. If a party is domiciled in the United States, such correspondence will be sent to the party at the party's address of record in the proceeding, unless an appearance is made on behalf of the party by an attorney (as defined in 37 CFR §10.1(c)), or a written power of attorney is filed, or written authorization of some other person entitled to be recognized is filed, or the party designates in writing another address to which correspondence is to be sent. If one of these events occurs, correspondence will be sent not to the party's address of record, but rather to the attorney who makes the appearance, or to the attorney designated in the power of attorney, or to the other person designated in the

written authorization, or to the address designated by the party for correspondence. See Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992) (power of attorney); and Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991) (appearance). Correspondence will continue to be sent to such address until the party, or the party's attorney or other representative, indicates in writing that correspondence is to be sent to another address. See 37 CFR §2.18.

117.02 When There is More Than One Attorney or Other Authorized Representative

If a power of attorney names more than one individual, and does not specify which of them is to have primary responsibility for the case and receive correspondence, the name(s) of the individual attorney(s) in the signature block of the covering transmittal letter will be used by the Board on the proceeding file, on correspondence for the party, and on the final decision of the Board, to identify counsel for the party, unless the party or one of the named attorneys requests otherwise in writing. This is because the typing of a large number of names on a proceeding file, correspondence, and final decision consumes an excessive amount of space and time, and hence is impractical and burdensome. If there is no transmittal letter, and no other indication as to which of the named attorneys is to have primary responsibility for the case and receive correspondence, the name of the first listed attorney will be used by the Board on the proceeding file, on correspondence for the party, and on the Board's final decision, unless the party or one of the named attorneys requests otherwise in writing.

Double correspondence, that is, the mailing of correspondence to two addresses on behalf of a single party, ordinarily will not be undertaken by the Board. If more than one attorney or other authorized representative makes an appearance on behalf of a party, the papers filed by the additional attorney(s) or other authorized representative(s) will be accepted, but the Board will send correspondence to only one of them, to be determined according to the circumstances in the case. See 37 CFR §2.18.

For example, if one attorney or other authorized representative ("A") makes an appearance on behalf of a party, and his or her address is thus established in the proceeding file as the correspondence address, following which a second attorney

OLD EDITION

or other authorized representative ("B") makes an appearance on behalf of the party, and files a written request that correspondence be sent to him or her, the correspondence address on the proceeding file will be changed, and future correspondence will be sent to B, rather than A. No requirement will be made that B submit authorization, from the party or from A, for the change of correspondence address, nor will B be required to serve a copy of the request upon A. If B does not file a written request that correspondence be sent to him or her, correspondence will continue to be sent to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter another attorney or other authorized representative ("B") makes an appearance on behalf of the party and files a written request that correspondence be sent to him or her, B ordinarily will be required to submit authorization, from the party or from A, for the requested change in the correspondence address. However, if B's request for change of correspondence address bears proof of service of a copy thereof upon both the party and A, and neither files an objection to the request, the correspondence address will be changed, and future correspondence will be sent to B, rather than to A.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter a power of attorney from the party to another attorney ("B") is filed, the second power of attorney will be construed, even if there is no revocation of the first power, as a written request to change the correspondence address from A to B, unless the party or A directs otherwise. Cf. TMEP §603. Likewise, if an attorney makes an appearance on behalf of a party, and thereafter the party files a written power of attorney to another attorney, the Board will send subsequent correspondence to the appointed attorney.

If a power of attorney from a party to one attorney ("A") has been filed, and thereafter A files an "associate power of attorney" to another attorney ("B"), the correspondence address will remain unchanged, and the Board will continue to send correspondence to A, unless A or the party directs otherwise. Cf. TMEP §603.

If a power of attorney from a party to several attorneys ("A," "B," and "C") in the same firm ("XYZ") has been filed, and thereafter A leaves the firm but does not file a request that all future correspondence be sent to him or her, rather than to B and/or C, the Board will continue to send correspondence to B and/or C. If A, after leaving firm XYZ, does file a request that all future correspondence be sent to him or her, rather than to B and/or C, the correspondence address will be

OLD EDITION

changed as requested. If, however, B and C object, and maintain that it is they, rather than A, who continue to represent the party and are entitled to receive correspondence, proceedings in the case will be suspended until a designation of correspondence address by the party has been submitted.

If oppositions or petitions for cancellation filed by different opposers or petitioners against the same application or registration are consolidated, or if an opposition or petition for cancellation is filed by joint opposers or petitioners, and the different plaintiffs are represented by different attorneys or other authorized representatives, rather than by the same one(s), the Board, in its discretion, may request that the plaintiffs appoint one lead counsel, to whom the Board may send correspondence intended for the plaintiffs. After the lead counsel has been appointed, the Board will send one copy of any forthcoming Board order, decision, or other communication to the applicant or its attorney or other authorized representative, and one copy to plaintiffs' lead counsel. Lead counsel in turn will be responsible for making and distributing copies of such Board correspondence to each plaintiff or its attorney or other authorized representative. In these cases, the lead counsel is not substituted for the separate counsel of each plaintiff, but rather is responsible for coordinating the conduct of the plaintiffs' cases. A Board letter requesting the appointment of lead counsel normally includes a detailed explanation of the anticipated duties and responsibilities of lead counsel.

In special circumstances, the Board, in its discretion, may send a particular item of correspondence to more than one address on behalf of a single party. However, the Board will not send correspondence to more than one address on behalf of a single party on a continuing basis.

OLD EDITION

117.03 Continuation of Correspondence With Representative in Application or Registration When Inter Partes Proceeding Commences

In the case of a party whose application is the subject of a Board proceeding, any appearance or power of attorney (or designation of other authorized representative) of record in the application file at the time of the commencement of the Board proceeding is considered to be effective for purposes of the proceeding, and correspondence will be sent initially to that address. See 37 CFR §2.105. Thereafter, the correspondence address may be changed in appropriate circumstances.

However, in the case of a party whose registration is the subject of a proceeding before the Board, any representation which may be of record in the registration file at the time of the commencement of the Board proceeding is not considered to be effective for purposes of the Board proceeding. Rather, correspondence is sent to the registrant itself unless and until an attorney makes an appearance in the Board proceeding in the registrant's behalf, or a written power of attorney is filed in the proceeding by the registrant, or written authorization of some other person entitled to be recognized is filed in the proceeding by the registrant, or the registrant designates in writing another address to which correspondence is to be sent. See 37 CFR §§2.18 and 2.113.

OLD EDITION

117.04 Continuation of Correspondence with Representative of Potential Opposer After Opposition is Filed

When an attorney is appointed in a power of attorney accompanying an opposition, or makes an appearance by filing an opposition on behalf of the opposer, correspondence will be sent by the Board to that attorney, notwithstanding the fact that another attorney or attorneys may have obtained one or more extensions of time to oppose on behalf of the opposer. If, however, a power of attorney filed with an opposition names several attorneys, and there is no transmittal letter and no other indication as to which of them is to have primary responsibility for the case and receive correspondence, but one of the named attorneys obtained an extension of time to oppose, correspondence will be sent to that attorney; if none of the named attorneys obtained an extension of time to oppose, correspondence will be sent to the first named attorney. Thereafter, the correspondence address may be changed in appropriate circumstances.

117.05 Correspondence After Revocation or Withdrawal

If the authority of a practitioner (i.e., attorney or other authorized representative) to represent a party in a proceeding before the Board is revoked, or the practitioner is granted permission to withdraw upon request therefor to the Board, and the party is not represented by any other practitioner, correspondence will be sent to the party at its address of record unless another practitioner puts in

an appearance, or a written appointment of another practitioner is filed, or the party designates in writing another address to which correspondence is to be sent.

117.06 Correspondence With Foreign Party

If a party to a Board proceeding is not domiciled in the United States and is not represented by an attorney or other authorized representative located in the United States, or by a foreign attorney or agent duly qualified under 37 CFR §10.14(c), correspondence will be sent to the party's domestic representative. See 37 CFR §§2.24 and 2.119(d).

117.07 Change of Address

If a party to a Board proceeding or its attorney or other authorized representative moves, a separate written notice of the change of address should be filed with the Board. It is the responsibility of a party to a proceeding before the Board to ensure that the Board has the party's current correspondence address. If a party fails to notify the Board of a change of address, with the result that the Board is unable to serve correspondence on the party, default judgment may be entered against the party.

A party or its attorney or other authorized representative should not assume that the inclusion of a new address on a paper directed to another matter, or on the envelope in which the paper is filed, is sufficient to notify the Board of a change of address. Mail sent to the PTO is opened in the PTO Mail Room, and ordinarily the envelopes are discarded there before the mail is sent on to its ultimate destination within the PTO. Thus, the Board rarely sees the return addresses on the mailing envelopes of papers filed in Board proceedings. Moreover, while it is the normal practice of the Board to check the address on newly filed papers and to change its records to reflect any noted change of address, the Board has no obligation to do so. The responsibility for any failure to receive correspondence due to a change of address of which the Board has not been given separate written notice lies with the party or its attorney or other authorized representative.

OLD EDITION

117.08 Individual Not Entitled to Represent Others

An individual who is not entitled, under 37 CFR §10.14(a), (b), or (c), to practice before the PTO in trademark cases, will not be permitted to represent a party in a proceeding before the Board, and may not file papers on behalf of the party. Cf. TMEP §602.04. If it comes to the attention of a Board attorney that such an individual is attempting to represent a party in a Board proceeding, the Board attorney will bring the matter to the attention of the Chairman of the Board, who will coordinate appropriate action with the Office of Enrollment and Discipline. Moreover, no Board correspondence intended for the party will be sent to the individual. Rather, such correspondence will be sent by the Board to the party itself, or to the party's attorney or other authorized representative entitled to practice before the PTO in trademark cases. See 37 CFR §2.18.

118 Payment of Fees

118.01 Lists of Fees and Charges

A list of the fees and charges established by the PTO for trademark cases may be found in 37 CFR §2.6.

A list of fees and charges established by the PTO for miscellaneous services may be found in 37 CFR §1.21.

OLD EDITION

118.02 Fees Payable in Advance

37 CFR §1.22 Fees payable in advance.
(a) Patent and trademark fees and charges payable to the Patent and Trademark Office are required to be paid in advance, that is, at the time of requesting any action by the Office for which a fee or charge is payable with the exception that under §1.53 applications for patent may be assigned a filing date without payment of the basic filing fee.

(b) All patent and trademark fees paid to the Patent and Trademark Office should be itemized in each individual application, patent or other proceeding in such a manner that it is clear for which purpose the fees are paid.

118.03 Method of Payment--In General

37 CFR §1.23 Method of Payment.
All payments of money required for Patent and Trademark Office fees, including fees for the processing of international applications (§1.445), should be made in U.S. specie, Treasury notes, national bank notes, post office money orders, or by certified check. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents and Trademarks. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Patent and Trademark Office will be at the risk of the sender; letters containing money should be registered.

It is the practice of the PTO to routinely accept, as "conditional" payment of a fee, a signed uncertified check. If such a check is returned for insufficient funds, the fee remains unpaid, and the filing date of the fee will be the filing date of any resubmitted adequate payment. See In re Cantatore, 231 USPQ 742 (Comm'r 1986). An unsigned check will be returned to its sender, but the Commissioner has the discretion to accept such a check, as "conditional" payment, upon petition showing sufficient cause therefor. See Dubost v. U.S. Patent and Trademark Office, 777 F.2d 1561, 227 USPQ 977 (Fed. Cir. 1985), on remand, In re Dubost, 231 USPQ 887 (Comm'r 1986).

For further information concerning how and where to file fees, see TBMP §107.

118.04 Method of Payment--Deposit Accounts

For the convenience of attorneys and the general public in paying fees and charges to the PTO, deposit accounts may be established in the PTO. For information concerning the establishment of a deposit account in the PTO, see §1.25.

OLD EDITION

The fees for filing an ex parte appeal to the Board, an opposition, and a petition for cancellation, may all be charged to a deposit account, provided that the requirements of 37 CFR §1.25 are met. However, the charging of a fee against an account that does not contain sufficient funds to cover it cannot be regarded as payment of the fee. See 37 CFR §1.25(b). Thus, the overdrawing of a deposit account may result in the loss of a vital date. See notice at 824 TMOG 1200 (February 23, 1966)..

118.05 Method of Payment--Coupons

For the convenience of the general public, the PTO sells coupons for use in purchasing copies of trademark registrations, patents, designs, defensive publications, and statutory invention registrations. For information concerning these coupons, see 37 CFR §1.24.

OLD EDITION

119 Papers and Fees Generally Not Returnable

119.01 Fee Refunds--General Rule

37 CFR §1.26 Refunds.
(a) Money paid in excess will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw an application, an appeal, or a request for oral hearing, will not entitle a party to demand such a return. Amounts of twenty-five dollars or less will not be returned unless specifically requested within a reasonable time, nor will the payer be notified of such amount; amounts over twenty-five dollars may be returned by check or if requested, by credit to a deposit account.

* * *

119.02 Papers and Fees--Ex Parte Cases

After an application has received a filing date, papers filed in connection therewith, including ex parte appeal papers, will not normally be returned. See 37 CFR §2.25.

If a notice of appeal to the Board from an Examining Attorney's final refusal is late filed, the appeal will not be entertained, the application will be abandoned, the notice of appeal will be retained in the application file, and any appeal fee submitted therewith will be refunded. If a notice of appeal is filed prematurely, the appeal will not be entertained, the notice of appeal will be retained in the application file, the application will be returned to the Examining Attorney for further appropriate action, and applicant will be advised that if a timely appeal is subsequently filed in the case, any fee submitted with the premature appeal will be applied thereto, or, if no timely appeal is filed, applicant may request a refund of any such fee.

If a final refusal to register is withdrawn by the Examining Attorney, and the application is approved for publication, following which the applicant, not knowing that the application has been approved for publication, files a notice of appeal, the appeal will not be instituted, the notice of appeal will be retained in the application file, and any appeal fee submitted therewith will be refunded. In such a case, the notice of appeal, and appeal fee, are considered to have been filed in excess, rather than by change of purpose, since at the time of its filing, the appeal was unnecessary. If, however, the Examining Attorney withdraws the refusal to register, and approves the application for publication, after an appeal to the Board has been filed, the appeal will be dismissed as moot, and the appeal fee will not be refunded (the appeal having been necessary at the time of its filing).

OLD EDITION

119.03 Papers and Fees--Inter Partes Cases

After an inter partes proceeding before the Board has been filed, papers and other materials filed in connection therewith normally will not be returned, except that exhibits to testimony, and confidential materials filed under a protective order, ordinarily are returned, after the conclusion of a proceeding, to the party which filed them. Cf. TBMP §806.

However, if, because of a defect in an opposition or a petition for cancellation filed with the Board, a proceeding is not instituted, the papers will be returned to the party which filed them, and any fee submitted therewith will be refunded.

For example, if an opposition is filed after the time for opposing has expired; or is filed unsigned, and a signed copy is not submitted within the time limit set in the notification of this defect by the Board; or is filed without the required fee, and the fee is not submitted within the time allowed by the Board; or if the opposed application was abandoned before the opposition was filed (see TBMP §307.11), no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.

If an opposition filed during an extension of time to oppose is in the name of someone other than the person who obtained the extension, and the opposer is unable to show, pursuant to 37 CFR §2.102(b), that it is in privity with the person who obtained the extension, or that the person in whose name the extension was requested was misidentified by mistake, no proceeding will be instituted, the opposition papers will be returned, and any fee submitted therewith will be refunded.

If an opposition or a petition for cancellation is filed prematurely (i.e., prior to publication of the subject mark in the Official Gazette for purposes of opposition, or prior to issuance of a registration of the subject mark, respectively), no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded.

If a petition to cancel a Principal Register registration that is more than five years old does not allege any ground upon which such a registration can be cancelled (see Section 14 of the Act of 1946, 15 U.S.C. §1064), no proceeding will be instituted, the petition papers will be returned, and any fee submitted therewith will be refunded.

If a petition for cancellation is filed with respect to a registration which, at the time of the filing of the petition, was not a "live" registration (i.e., the time for filing an affidavit of use under Section 8 of the Act of 1946, 15 U.S.C. §1058, had expired, and no acceptable affidavit had been filed; the registration had already been cancelled as the result of a previous cancellation proceeding; etc.), no proceeding will be instituted, the petition papers will be returned, and any fee submitted therewith will be refunded.

If a party files an opposition or a petition for cancellation, and immediately thereafter changes its mind, and requests that the opposition or petition for cancellation not be instituted and that the papers be returned, the request

OLD EDITION

ordinarily will be denied, and the proceeding will be instituted, unless there is a defect in the opposition or petition for cancellation which precludes institution, in which case no proceeding will be instituted, the papers will be returned, and any fee submitted therewith will be refunded..

120 Proceeding Files and Exhibits

120.01 Description of Files

Papers in proceedings before the Board (both those filed by parties, and those mailed by the Board) are kept in three-fold manila file wrappers or jackets, known simply as "files." In the case of an ex parte appeal, the papers are simply added to the existing application file (described in TMEP §710).

In the case of a "potential opposition," that is, when the mark in an application has been published in the Official Gazette for purposes of opposition, and a request for extension of time to oppose has been filed pursuant to 37 CFR §2.102, but no opposition has yet been filed, the papers relating to the potential opposition are fastened by the Board to the inner left-hand side of the application file in question. In the event that an opposition is ultimately filed, the potential opposition papers are removed from the application file and placed instead in the file of the new opposition.

When an inter partes proceeding is commenced, a proceeding file is set up by the Board, and the proceeding papers are placed on prongs at the top of the inside center portion of the file, in inverse order by date of receipt in the PTO or mailing by the Board, so that the oldest paper is on the bottom of the prongs, and the most recent paper is on top. A numbered chronological list of proceeding docket entries, that is, of the papers and other materials filed and mailed in the proceeding, appears on the inside right-hand side of the file. The outside center portion, or "front," of the file bears information identifying the proceeding to which the file pertains, i.e., the proceeding name and number, the number(s) of the application(s) or registration(s) which is (are) the subject matter of the proceeding, the initials of the Board interlocutory attorney to whom the case has been assigned, etc. The outer left-hand side of the file bears the name of each party and each party's correspondence address (if a party is represented by

OLD EDITION

counsel, the correspondence address usually consists of the name and address of such counsel).

Because of their bulkiness, deposition transcripts, exhibits thereto, and inter partes briefs on the case are not placed on the prongs in the proceeding file, and hence may be filed in bound form.. If a proceeding paper, other than a deposition transcript, an exhibit thereto, or an inter partes brief on the case, is filed in bound form, the Board must remove the binding in order to place the paper on the proceeding file prongs. Thus, proceeding papers, with the noted exceptions, should not be filed in bound form.

For information concerning the disposition of inter partes proceeding files and exhibits after the proceeding has ended, see TBMP §806.

OLD EDITION

120.02 Storage of Files and Exhibits

The files of pending Board inter partes proceedings, together with the files of the applications or registrations which are the subject matter of the proceedings, are stored in the Board's offices. They are kept on shelves, where they are arranged in terminal two-digit numerical order. When a paper is filed in connection with a proceeding, or it is time for the Board to take some action in the proceeding, the proceeding file is removed from the shelf for entry and consideration of the paper, drafting of the action, etc. When a case is ready for a final decision on the merits, everything pertaining to the proceeding is given to the Board Member assigned to draft the decision.

The files of applications which are on appeal to the Board, and the files of applications with "potential oppositions," are also stored at the offices of the Board. They too are kept on shelves, in terminal two-digit numerical order.

Exhibits (and the like), filed in connection with pending Board inter partes and ex parte proceedings, often are too bulky to put in the proceeding files. These exhibits are kept in the boxes or envelopes in which they were mailed, or, sometimes, in PTO inter-office envelopes. Information clearly identifying the proceedings to which the packages of exhibits pertain is prominently written on the outside of each box and envelope. Those bulky exhibits which are kept in envelopes are stored together on shelves (separate from the proceeding files) in terminal two-digit numerical order. Those bulky exhibits which are so large that

they must be kept in boxes are stored together in a room at the offices of the Board.

For information concerning the disposition of inter partes proceeding files and exhibits after the proceeding has ended, see TBMP §806.

120.03 Storage of Confidential Materials

Confidential materials filed under seal pursuant to a protective order (see 37 CFR §§2.27, 2.120(f), and 2.125(e); and TBMP §§416, 526, and 713.16) in a pending Board proceeding are stored by the Board in a locked file cabinet. These materials may include certain responses to discovery requests, exhibits, portions of deposition transcripts, or portions of briefs. As in the case of nonconfidential exhibits, the boxes or envelopes in which these materials are kept are clearly marked with information identifying the proceedings to which the materials pertain. In addition, the designation "Cab." is written both on the boxes or envelopes and on the numbered list of docket entries in the pertinent proceeding files, next to the entry relating to the confidential materials.

OLD EDITION

121 Access to Files

37 CFR §2.27(d) Except as provided in paragraph (e) of this section, after a mark has been registered, or published for opposition, the file of the application and all proceedings relating thereto are available for public inspection and copies of the papers may be furnished upon paying the fee therefor.

37 CFR §2.27(e) Anything ordered to be filed under seal pursuant to a protective order issued or made by any court or by the Trademark Trial and Appeal Board in any proceeding involving an application or a registration shall be kept confidential and shall not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. When possible, only confidential portions of filings with the Board shall be filed under seal.

121.01 Nonconfidential Files

Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board, all pending proceeding files and exhibits thereto, and the files of applications which are the subject matter of "potential oppositions," are available for public inspection and copying at the offices of the Board. See 37 CFR §2.27.

An individual who wishes to inspect and/or copy one of the these files may come to the Board's reception desk, where the Board keeps a log of file requests, and ask for the file. The individual must identify the file by its number, so that it may be located by the Board. Once the file has been located, the Board will call the individual and tell him or her that the file is available. When the individual returns, the file will be given to him or her for inspection and/or copying on the premises of the Board. Files or portions thereof may not be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file in their proper order.

To save time, an individual who wishes to inspect a file which is in the possession of the Board may call and ask that the file be located. When the file has been located, the Board will call the individual back to tell him or her that the file is available.

For information concerning access to the files of cases which are on appeal from a decision of the Board, see TBMP §904.

OLD EDITION

121.02 Confidential Materials

Materials filed with the Board under seal pursuant to a protective order issued by any court or by the Board will be kept confidential and will not be made available for public inspection or copying unless otherwise ordered by the court or the Board, or unless the party protected by the order voluntarily discloses the matter subject thereto. These materials may be inspected only by those individuals who are entitled, under the terms of the protective order, to have access to the protected information. See 37 CFR §2.27(e).

121.03 Files of Terminated Proceedings

When an inter partes proceeding has been finally determined, i.e., when the proceeding is over, the PTO takes certain further steps based on the final decision, including those steps necessary to give effect to the decision. This process is referred to as the "termination" of the proceeding. For example, when a decision dismissing an opposition has become final, the word "TERMINATED" is stamped on the file of the opposition proceeding, the opposition file is sent to the warehouse where the files of terminated proceedings are stored, and the registration sought by the applicant is issued. See TBMP §806.

The files of terminated inter partes proceedings are stored by the PTO in a warehouse. The files of existing registrations; registrations which expired or were cancelled within the last two years; and applications abandoned within the last two years, are also stored in a warehouse.

The files of cancelled and expired registrations are destroyed two years after the date of cancellation or expiration; the files of abandoned applications are destroyed two years after the date of abandonment. In addition, the files of terminated opposition proceedings numbered from 30,000 through 53,999, and of terminated cancellation proceedings numbered from 1 through 9399, have been destroyed.

An individual who wishes to inspect and/or copy a file stored by the PTO in a warehouse can go to the Public Service Window located on the second floor of the South Tower building, 2900 Crystal Drive, Arlington, Virginia, and place an order for the file. Alternatively, the individual can order the file electronically from a computer terminal located in the Trademark Search Library, or from a computer terminal located in the Patent Search Room. Within a few days, the PTO will obtain the ordered file from the warehouse, and make it available to the individual for inspection and/or copying at the Trademark Search Library. The file may not be taken away from the premises of the Trademark Search Library. See TMEP §303.02.

OLD EDITION

122 Copying of Files

The Board has, on its office premises, a photocopier which is intended for use by members of the public who wish to photocopy files, exhibits, or other materials in the possession of the Board. Payment for use of the machine is made by way of a magnetic card, known as a "copy card," which may be purchased at, inter alia, the PTO Finance Window located on the third floor of the South Tower Building, 2900 Crystal Drive, Arlington, Virginia, or from a machine located in the Trademark Search Library on the second floor of the South Tower Building.. The photocopier will not operate until such a card has been inserted in it.

Files or portions thereof may not be taken away from the offices of the Board, and a person who removes papers from a file for copying at the offices of the Board should always return the papers to the file in their proper order.

Alternatively, the PTO will furnish photocopies (either certified or uncertified) of trademark application and registration files, or of one or more papers therefrom, or of papers from the files of Board proceedings, upon written request and payment of the fee prescribed in 37 CFR §2.6. The PTO will also furnish, upon written request and payment of the fee prescribed in 37 CFR §2.6, printed copies of trademark registrations, certified copies of registrations with information as to the current status and title of the registration, and abstracts of title to trademark applications and registrations.

All requests for certified and uncertified copies of trademark documents relating to applications or registrations, including copies of papers from the files of Board proceedings, and abstracts of title, are handled by the PTO's Certification Division, Office of Public Records. If a written request (with the required fee) for copies is mailed to the PTO, it should be addressed to the Commissioner of Patents and Trademarks, Box 10, Certification Division, Washington, D.C. 20231. The written request, with fee, may also be delivered by hand to the Public Service Window at 2900 Crystal Drive, South Tower Building, Second Floor, Arlington, Virginia 22202-3513; or to the Office of Public Records, 2800 Crystal Drive, North Tower Building, Tenth Floor, Arlington, Virginia 22202-3513; or to the Attorneys' Window at 2201 S. Clark Place, Crystal Plaza Building 4, First Floor, Arlington, Virginia 22202. Finally, if the written request includes an authorization to charge the required fee to a deposit account, the request may be sent by facsimile transmission to (703) 308-7048. See "Notice of a Change in Procedure Regarding Requests for Certification Services," 1165 TMOG 13 (August 2, 1994).

OLD EDITION

123 Certification

123.01 Court Requirements

If a copy of a Board proceeding file, or a portion thereof, is needed for use before a district court, the court may require a certified copy (which bears a seal). Some district courts, however, will accept a verification letter (which does not bear a seal) by the Board, together with a plain photocopy of the proceeding file or portion thereof.

An individual who needs a copy of a Board proceeding file, or a portion thereof, for use in a district court should contact the clerk of the court to determine whether the court will accept a Board verification letter, or will require a formal certified copy.

A paper cannot be certified or verified by the PTO as being a true copy of a paper filed in a Board proceeding unless and until it has, in fact, been filed therein. The paper may be filed at the same time that the request for certification or verification is made.

OLD EDITION

123.02 Certified Copies

Certified copies, bearing a seal, of PTO proceeding files, including Board proceeding files, or portions thereof, may be ordered from the PTO's Certification Division, Office of Public Records, upon written request and payment of the required fee. See TBMP §122.

123.03 Verified Copies

The Board, upon proper request, will prepare a verification letter, signed by the Board's Administrator (or, in the Administrator's absence, by a Member of the Board), stating that a particular proceeding (identified in the letter by name and number), involving a specified application(s) or registration(s), is pending before

the Board, and that attached to the letter is a true and correct copy of a paper or papers (identified in the letter by title and filing date) filed in connection with that proceeding.

An individual who wishes to obtain a verification letter from the Board may bring to the Offices of the Board a photocopy of the matter to be verified, or make a photocopy thereof at the Board's offices (see TBMP §122). The Board Administrator or Member will compare the photocopy with the file original, to verify that it is a true copy, before signing the verification letter. If necessary (that is, if required by the court before which the verification letter is to be used), the signature of the Board Administrator or Member may be notarized.

Board verification letters normally will be prepared by the Board immediately, on a "while you wait" basis. To save time, it is recommended that an individual seeking such a letter call the Board in advance of his or her visit and ask that the involved proceeding file be located and pulled prior to the visit.

An individual who is unable to come to the offices of the Board, or to send a local representative, but needs to obtain a Board verification letter quickly, may send a written request therefor (addressed to the Board at its physical location and including a photocopy of the matter to be verified) by any overnight courier service, and enclose a prepaid self-addressed overnight courier return envelope. In those cases where time is not of the essence, a written request for a verification letter may be sent to the Board by mail. When a request for a verification letter is sent to the Board by mail or by overnight courier, the individual sending the request should notify the Board's Administrator thereof by telephone so that the Administrator can watch for the request and respond to it as soon as it arrives at the offices of the Board.

The Board will issue other types of verification letters as well. For example, the Board may issue, upon request therefor, a verification letter stating simply that a particular proceeding (identified in the letter by name and number) involving a specified application or registration is pending before the Board; or that a specified application or registration is not the subject of any proceeding presently pending before the Board; or that a particular opposition (identified in the letter) to a specified application is pending before the Board, and no certificate of registration can be issued to the applicant unless and until the opposition is ultimately terminated in applicant's favor.

There is no fee for a Board verification letter.

OLD EDITION

124 Application and Registration Status Information

The PTO maintains a Trademark Status Line which provides access, by push-button telephone, to current status, status date (i.e., the date that a record entered its current status), and status location information for all active Federal trademark application and registration records maintained in the automated Trademark Reporting and Monitoring (TRAM) System. See In re Sovran Financial Corp., 25 USPQ2d 1537 (Comm'r 1992). The line is available on (703) 305-8747 from 6:30 a.m. until midnight, Eastern Time, Monday through Friday (except for Federal holidays).

For further information concerning the Trademark Status Line, see TMEP §413, and notices at 1112 TMOG 49 (March 27, 1990) and 1132 TMOG 33 (November 19, 1991).

OLD EDITION

125 Action by Assignee

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. §1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. See 37 CFR §§3.71 and 3.73(b). Similarly, when a mark which is not the subject of a Federal application or registration, but which is owned and pleaded by a plaintiff in a Board inter partes proceeding, has been assigned, the assignee may act in the proceeding (either itself, or through its attorney or other authorized representative) in place of the assignor, provided that proof of the assignment has been submitted in the proceeding. See TBMP §512.01.

CHAPTER 200 EXTENSIONS OF TIME TO OPPOSE

201 In General

202 Time for Filing Request

203 Form of Request

204 Fee

205 Mark on Supplemental Register Not Subject to Opposition

206 Identification of Potential Opposer

207 Requirements for Showing of Cause

208 Essential Element Omitted

209 Action by Board on Request

210 Objections to Request

211 Relief From Action of Board

212 Amendment of Application During or After Extension

213 Effect of Restoration of Jurisdiction

214 Effect of Republication

215 Effect of Letter of Protest

216 Inadvertently Issued Registration

217 Relinquishment of Extension

218 Abandonment of Application

219 Amendment to Allege Use; Statement of Use

OLD EDITION

201 In General

15 U.S.C. §1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

37 CFR §2.101 Filing an opposition.
(a) An opposition proceeding is commenced by the filing of an opposition in the Patent and Trademark Office.

(b) Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and may be signed by the opposer or the opposer's attorney or other authorized representative.

(c) The opposition must be filed within thirty days after publication (§2.80) of the application being opposed or within an extension of time (§2.102) for filing an opposition.

* * *

37 CFR §2.102 Extension of time for filing an opposition.
(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an

OLD EDITION

extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.

(d) Every request to extend the time for filing a notice of opposition should be submitted in triplicate (original plus two copies).

Any person (whether natural or juristic--see TBMP §303.02) who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may, upon payment of the prescribed fee, file an opposition in the PTO, stating the grounds therefor, within 30 days after the publication of the mark in the Official Gazette for purposes of opposition. See Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.101. For further information concerning the filing of an opposition, see TBMP chapter 300.

Similarly, any person who believes that he, she, or it would be damaged by the registration of a mark upon the Principal Register may file a written request to extend the time for filing an opposition. See Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102. Requests for extension of time to oppose are determined by the Board. See 37 CFR §2.102(c), and Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993).

OLD EDITION

The time for filing a request for an extension of time to oppose is governed by Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102(c). For further information concerning the time for filing a request for extension of time to oppose, see TBMP §202.

Other requirements for a request for extension of time to oppose are specified in 37 CFR §2.102. Moreover, certain requirements for papers filed in inter partes proceedings before the Board also apply to a request for extension of time to oppose. For information concerning the requirements (other than the time requirement) for a request for extension of time to oppose, see TBMP §§203-208.

OLD EDITION

202 Time for Filing Request

202.01 In General

15 U.S.C. §1063 (a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

37 CFR §2.102(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...

A first request for an extension of time to oppose an application for registration of a mark must be filed prior to the expiration of the thirty-day period after publication of the mark in the Official Gazette, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. Any request for a further

extension of time to oppose must be filed prior to the expiration of an extension granted to the requesting party or its privy. See Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §2.102(c). See also In re Cooper, 209 USPQ 670 (Comm'r 1980).

A potential opposer which has requested an extension of time to oppose should not wait until it has received notification from the Board of the grant or denial of the request before filing an opposition or a request for a further extension of time to oppose. If a request for an extension of time to oppose is granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. See In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990). While the Board attempts to notify a potential opposer of the grant of an extension request prior to the expiration of the granted extension, particularly where the length of the granted extension is less than that requested, the Board is under no obligation to do so, and in many cases cannot. See Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991), and In re Societe Des Produits Nestle S.A., supra. Cf. In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); In re L.R. Sport Inc., 25 USPQ2d 1533 (Comm'r 1992); and In re Application Papers Filed November 12, 1965, 152 USPQ 194 (Comm'r 1966).

OLD EDITION

202.02 Date of Publication of Mark

Normally, the date of publication of a mark is the cover date of the issue of the Official Gazette in which the mark is published, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. However, when an issue of the Official Gazette is mailed late, the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the Official Gazette was mailed, as specified in the Commissioner's Notice of the late mailing.

202.03 Late-mailed Official Gazette

Ordinarily, an issue of the Official Gazette is mailed to subscribers during the business week of the date appearing on its cover, and that cover date is considered to be the date of publication of the marks published therein, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition. However, it sometimes happens that an issue of the Official Gazette is mailed to subscribers late, that is, after the business week of the date appearing on its cover.

When an issue of the Official Gazette is mailed late, the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the Official Gazette was mailed, and the thirty-day opposition period is considered by the Commissioner to run from the Official Gazette mailing date, rather than from its cover date. Applicants and potential opposers are notified of the late mailing, and of the consequent change in both the publication date and the opposition period expiration date, by a Commissioner's Notice published in a subsequent issue of the Official Gazette. Cf. In re BPJ Enterprises Ltd., 7 USPQ2d 1375, 1376, at fn.1 (Comm'r 1988). In such cases, extensions of time to oppose run from the opposition period expiration date specified in the Commissioner's Notice, and the 120-day period of 37 CFR §2.102(c) runs from the Official Gazette mailing date specified in the Notice.

The Official Gazette mailing date, and the opposition period expiration date, specified in the Commissioner's Notice will be used by the Board as the basis for calculating the expiration date of a first extension of time to oppose, even if an extension request specifies an extension expiration date calculated from the Official Gazette cover date. Ordinarily, the dates specified in the Commissioner's Notice will also be used by the Board in calculating the expiration dates of further extensions of time to oppose. However, if a request for a further extension specifies a different extension expiration date, and the request meets the requirements of 37 CFR §2.102, the extension will be set to expire on the specified date.

OLD EDITION

202.04 Premature Request

Section 13(a) of the Act, 15 U.S.C. §1063(a), provides that an opposition to the registration of a mark upon the Principal Register may be filed "within thirty days after" the publication of the mark in the Official Gazette, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for opposition. Section 13(a) also provides for extensions of this time for filing an opposition, under certain

conditions. Thus, any opposition, and any request for an extension of time to oppose, filed prior to the publication of the mark sought to be opposed, is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. Cf. TBMP §§119.03 and 307.03.

202.05 Late Request

A request for an extension of time to oppose must be filed prior to the expiration of the thirty-day period after publication (for opposition) of the mark which is the subject of the request, in the case of a first request, or prior to the expiration of an extension granted to the requesting party or its privy, in the case of a request for a further extension. See Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §§2.102(b) and (c). See also In re Cooper, 209 USPQ 670 (Comm'r Pats 1980). Because these timeliness requirements are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Commissioner upon petition. See In re Cooper, supra. Accordingly, a first request filed after the expiration of the thirty-day period following publication of the subject mark, or a request for a further extension filed after the expiration of the previous extension granted to the requesting party or its privy, must be denied by the Board as late, even if the applicant has consented to the granting of the late filed request.

Moreover, once the time for opposing the registration of a mark has expired, the PTO will not withhold issuance of the registration while applicant negotiates for settlement with a party which failed to timely oppose. This is so even if the applicant itself requests that issuance be withheld.

OLD EDITION

203 Form of Request

203.01 In General

37 CFR §2.102(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

* * *

37 CFR §2.102(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. ...

37 CFR §2.102(d) Every request to extend the time for filing a notice of opposition should be submitted in triplicate (original plus two copies).

A request for an extension of time to oppose must be made in writing. See Section 13(a) of the Act, 15 U.S.C. §1063(a), and 37 CFR §§2.102(a) and 1.2. The request should specify the period of extension desired, and should be addressed to the mailing address of the Trademark Trial and Appeal Board (see TBMP §103).

In addition, every request for an extension of time to oppose should be filed in triplicate, so that if the request is approved, it may be so stamped; one copy may be placed in the application file; and the other copies may be mailed to the potential opposer and the applicant. See 37 CFR §2.102(d). If only a single copy of an extension request is filed, the request will not be refused consideration, but action thereon may be delayed because the Board itself will have to make the extra copies.

OLD EDITION

203.02 Identifying Information

A request for an extension of time to oppose should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application to which the request pertains, namely, the name of the applicant, and the application serial number, filing date, mark, and date of publication in the Official Gazette. Cf. 37 CFR §1.5(c), and In re Merck & Co., 24 USPQ2d 1317 (Comm'r 1992) (misidentification by potential opposer of application to which request for extension of time to oppose pertains). The request should also bear an appropriate title describing its nature, such as "Request for Extension of Time to Oppose" or "Request for Further Extension of

Time to Oppose." In addition, the request must identify the potential opposer with reasonable certainty. See 37 CFR §2.102(b), and TBMP §206.

203.03 Signature

37 CFR §2.102(a) Any person who believes that he would be damaged by the registration of a mark on the Principal Register may file a written request to extend the time for filing an opposition. The written request may be signed by the potential opposer or by an attorney at law or other person authorized, in accordance with §2.12(b) and (c) and §2.17(b), to represent the potential opposer.

A request for an extension of time to oppose may be signed either by the potential opposer or by its attorney or other authorized representative. See 37 CFR §2.102(a). See also La Maur, Inc. v. Andis Clipper Co., 181 USPQ 783 (Comm'r 1974). Under the written signature there should appear the name, in typed or printed form, of the person signing; a description of the capacity in which he or she signs (e.g., as the individual who is the potential opposer, if the potential opposer is an individual; as a corporate officer, specifying the particular office held, if the potential opposer is a corporation; as potential opposer's attorney; etc.); and his or her business address (to which correspondence relating to the request will be sent) and telephone number.

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the written notification of this defect by the Board. See 37 CFR §2.119(e) and TBMP §106.02.

A potential opposer which has submitted an unsigned request for an extension of time to oppose should not wait until it has submitted a signed copy of the request (in response to the Board's written notification of the defect), and the Board has acted thereon, before filing an opposition or a request for a further extension of time to oppose. If the extension request is ultimately granted, the length of the granted extension will be no greater (and may be less) than that sought in the extension request, and it will run from the expiration of the thirty-day opposition period after publication, in the case of a first request, or from the date of expiration of the previously granted extension, in the case of a request for a further extension. If no opposition or request for further extension of time to

OLD EDITION

oppose is filed prior to the expiration of any extension ultimately granted (after submission of a signed copy of the request) to the potential opposer, the time for opposing will be deemed to have expired, and the applicatiion which was the subject of the request will be sent to issue. Cf. TBMP §202.01.

203.04 Service

Rule 2.119(a), 37 CFR §2.119(a), requires, in part, that with certain stated exceptions, every paper filed in the PTO in inter partes cases must be served upon the other parties, and that proof of such service must be made before the paper will be considered by the Office. Rule 2.101(a), 37 CFR §2.101(a), provides that an opposition proceeding is commenced by the filing of an opposition in the PTO. Inasmuch as a request for an extension of time to oppose is a paper filed prior to the commencement of the opposition, it is ex parte, rather than inter partes, in nature. Accordingly, the request need not include proof of service upon the applicant unless the request seeks an extension beyond 120 days from the date of publication, and is based upon a statement by the potential opposer or its authorized representative that the applicant or its authorized representative has consented to the request. See 37 CFR §2.102(c) and La Maur, Inc. v. Andis Clipper Co., 181 USPQ 783 (Comm'r 1974). However, once the Board has acted upon a request for an extension of time to oppose, the Board itself will send the applicant a copy of the extension request (unless it bears proof of service by potential opposer) together with the Board's action thereon. See Section 13 of the Act, 15 U.S.C. §1063.

OLD EDITION

203.05 Duplicate Requests

It sometimes happens that duplicate requests for an extension of time to oppose are filed on behalf of the same party by two attorneys from the same firm, or from differing firms, or by an attorney from a firm and in-house counsel. Attorneys should make every effort to avoid the filing of such duplicate requests, which waste the time and resources both of the Board, and of the attorneys themselves.

When duplicate requests have been filed, and the first request has been granted, the second request is given no consideration, and the attorneys are notified in

writing of the duplicate filings and are requested to take appropriate action to avoid the filing of duplicate requests in the future. If requests filed by different attorneys on behalf of the same party are duplicates but for the fact that the second request seeks a longer extension than the first, the second request will be granted, if otherwise appropriate, but the attorneys will be requested in writing to avoid the filing of further duplicate requests.

204 Fee

There is no fee for filing a request for an extension of time to oppose. Cf. 37 CFR §2.6.

205 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. See Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§1062(a), 1063(a), and 1092, and 37 CFR §2.82. If it appears, after examination of an application for registration of a mark on the Supplemental Register, that applicant is entitled to the registration sought, a certificate of registration is issued, without any publication for opposition. See Sections 23(b) and 24 of the Act, 15 U.S.C. §§1091(b) and 1092, and 37 CFR §2.82. Upon issuance of the registration, the mark is published in the Official Gazette, not for opposition, but rather to give notice of the registration's issuance. See Section 24 of the Act, 15 U.S.C. §1092; 37 CFR §2.82; and TMEP §1502.

Accordingly, the Board must deny any request for an extension of time to oppose the mark in an application for registration on the Supplemental Register. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. See Section 24 of the Act, 15 U.S.C. §1092.

206 Identification of Potential Opposer

OLD EDITION

37 CFR §2.102(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

206.01 Requirement for Identification

A request for an extension of time to oppose must identify the potential opposer with reasonable certainty. See 37 CFR §2.102(b). If a request for extension of time to oppose fails to identify the potential opposer with reasonable certainty, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. See In re Spang Industries, Inc., 225 USPQ 888 (Comm'r 1985). Cf. In re Su Wung Chong, 20 USPQ2d 1399 (Comm'r 1991); In re Software Development Systems, Inc., 17 USPQ2d 1094 (Comm'r 1989); and In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990).

If a request for a further extension of time to oppose does not specifically name the potential opposer, but it is clear from the circumstances that the request is being submitted on behalf of the same potential opposer which obtained an earlier extension(s) (for example, the request is submitted by the same attorney(s) who submitted the earlier request(s) on behalf of the potential opposer, and, asks for an "additional" or "further" extension; or the request indicates that the "potential opposer" was granted an earlier extension(s) until a specified time, and asks for an additional or further extension; etc.), the request may be construed by the Board as identifying the potential opposer with reasonable certainty. However, the better, and safer, practice is to specifically name the potential opposer in each request for an extension of time to oppose.

206.02 Request for Further Extension Filed by Privy

OLD EDITION

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party. For this reason, a request for a further extension of time to oppose, or an opposition, filed during an extension of time ordinarily must be filed in the name of the party to which the extension was granted. However, a request for a further extension, or an opposition, filed by a different party will not be rejected on that ground if it is shown to the satisfaction of the Board that the different party is in privity with the party granted the previous extension(s). See 37 CFR §2.102(b); TMEP §1503.04(d); SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); and In re Cooper, 209 USPQ 670 (Comm'r 1980). The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the request for a further extension, or the opposition, is filed both in the name of the party granted the previous extension and in the name of one or more different parties, an explanation will be requested as to each different party, and the request will not be granted, or the opposition accepted, as to any different party which fails to make a satisfactory showing of privity.

The term "privity" is defined in Black's Law Dictionary (Fifth Edition, 1979) as follows:

> Mutual or successive relationship to the same rights of property. In its broadest sense, "privity" is defined as mutual or successive relationships to the same right of property, or such an identification of interest of one person with another as to represent the same legal right.

In the field of trademarks, the concept of privity generally includes, inter alia, the relationship of successive ownership of a mark (e.g., assignor, assignee) and the relationship of "related companies" within the meaning of Sections 5 and 45 of the Act, 15 U.S.C. §§1055 and 1127. Cf. Rolex Watch U.S.A., Inc. v. Madison Watch Co., 211 USPQ 352, 358 (TTAB 1981); In re Cooper, 209 USPQ 670 (Comm'r 1980); Argo & Co. v. Carpetsheen Mfg., Inc., 187 USPQ 366, 367 (TTAB 1975); and F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co., 140 USPQ 281 (Comm'r 1963). But see Tokaido v. Honda Associates Inc., 179 USPQ 861 (TTAB 1973). It does not, however, include the attorney/client relationship. See In re Spang Industries, Inc., 225 USPQ 888 (Comm'r 1985).

OLD EDITION

If, at the time when a first request for an extension of time to oppose is being prepared, it is not clear which of two or more entities will ultimately be the opposer(s), the better practice is to name each of them, in that and any subsequest extension request, as a potential opposer, thereby avoiding any need for a showing of privity when an opposition or subsequent extension request is later filed by one or more of them.

206.03 Misidentification

Ordinarily, a request for a further extension of time to oppose, or an opposition, filed during an extension of time to oppose must be filed in the name of the party to which the previous extension was granted. See 37 CFR §2.102(b). However, a request for a further extension, or an opposition, filed in a different name will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. See 37 CFR §2.102(b), and Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993). The phrase "misidentification by mistake," as used in 37 CFR §2.102(b), means a mistake in the form of the potential opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. See Cass Logistics Inc. v. McKesson Corp., supra. See also TMEP §1503.04. Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505 (TTAB 1974); Davidson v. Instantype, Inc., 165 USPQ 269 (TTAB 1970); Pyco, Inc. v. Pico Corp., 165 USPQ 221 (TTAB 1969); and Raker Paint Factory v. United Lacquer Mfg. Corp., 141 USPQ 407 (TTAB 1964). Cf. also TMEP §§802.06 and 802.07; In re Tong Yang Cement Corp., 19 USPQ2d 1689 (TTAB 1991); In re Atlantic Blue Print Co., 19 USPQ2d 1078 (Comm'r 1990); In re Techsonic Industries, Inc., 216 USPQ 619 (TTAB 1982); Argo & Co. v. Springer, 198 USPQ 626 (TTAB 1978); In re Eucryl, Ltd., 193 USPQ 377 (TTAB 1976); Argo & Co. v. Springer, 189 USPQ 581 (TTAB 1976); and U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc., 183 USPQ 613 (Comm'r 1974).

The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the request or opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

OLD EDITION

207 Requirements for Showing of Cause

37 CFR §2.102(c) The written request to extend the time for filing an opposition must be filed in the Patent and Trademark Office before the expiration of thirty days from the date of publication or within any extension of time previously granted, should specify the period of extension desired, and should be addressed to the Trademark Trial and Appeal Board. A first extension of time for not more than thirty days will be granted upon request. Further extensions of time may be granted by the Board for good cause. In addition, extensions of time to file an opposition aggregating more than 120 days from the date of publication of the application will not be granted except upon (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances, it being considered that a potential opposer has an adequate alternative remedy by a petition for cancellation.

OLD EDITION

207.01 First Extension of Thirty Days

A first extension of time to oppose for not more than thirty days will be granted upon written request therefor, if the request is otherwise appropriate (i.e., is timely filed; identifies the potential opposer with reasonable certainty; etc.). No showing of cause is required. See Section 13(a) of the Act, 15 U.S.C. §1063(a); 37 CFR §2.102(c); and Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991).

207.02 Further Extensions

Extensions of time to oppose beyond the first thirty-day extension may be granted by the Board for good cause, provided that the extensions do not aggregate more than 120 days from the date of publication of the subject mark. See 37 CFR §2.102(c), and Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991). If a request for a further extension of

time to oppose does not include a showing of good cause, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. Cf. In re Su Wung Chong, 20 USPQ2d 1399 (Comm'r 1991); In re Software Development Systems, Inc., 17 USPQ2d 1094 (Comm'r 1989); In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990); and In re Spang Industries, Inc., 225 USPQ 888 (Comm'r 1985).

A showing of good cause for a further extension of time to oppose should be in the form of a recitation of the reasons why additional time is needed for filing an opposition. The merits of the potential opposition are not relevant to the issue of whether good cause exists for the requested extension.

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days. See Kimberly-Clark Corp. v. Paper Converting Industry, Inc., 21 USPQ2d 1875 (Comm'r 1991). If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, the potential opposer will be granted an extension of only thirty days. However, a request for a further extension, showing good cause, may be submitted during that thirty-day extension period.

If a request for a further extension of time to oppose includes a showing which constitutes good cause for part, but not all, of the requested extension, any extension granted to a potential opposer will be limited to the time for which good cause has been shown.

OLD EDITION

207.03 Extensions Beyond 120 Days From Publication

Extensions of time to oppose aggregating more than 120 days from the date of publication of the subject mark will not be granted unless the potential opposer submits, in addition to the showing of good cause required for extensions of time beyond the first thirty-day extension period, one of the following: (1) a written consent or stipulation signed by the applicant or its authorized representative, or (2) a written request by the potential opposer or its authorized representative stating that the applicant or its authorized representative has consented to the request, and including proof of service on the applicant or its authorized representative, or (3) a showing of extraordinary circumstances. See 37 CFR

§2.102(c). If one of these elements (i.e., the showing of extraordinary circumstances, or applicant's written consent, or the statement that applicant has consented, or the proof of service upon applicant) is omitted from an extension request based in whole or in part upon the omitted element, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the previous extension. See In re Su Wung Chong, 20 USPQ2d 1399 (Comm'r 1991); In re Software Development Systems, Inc., 17 USPQ2d 1094 (Comm'r 1989); and In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990). Cf. In re Spang Industries, Inc., 225 USPQ 888 (Comm'r 1985).

If a showing of extraordinary circumstances is submitted in support of a request for an extension running beyond 120 days from the date of publication, the requirement for a showing of good cause is satisfied thereby. If a request for an extension running beyond 120 days from publication is based upon applicant's consent, but includes no recitation of other facts relating to good cause, applicant's consent will be construed as good cause for that request, but potential opposer will be advised by the Board, in writing, that any further extension request based upon applicant's consent must include also a recitation of circumstances showing good cause for the request.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR §2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication. See Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991), and In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990).

OLD EDITION

208 Essential Element Omitted

If any element (e.g., identification of potential opposer, showing of good cause, showing of extraordinary circumstances, applicant's written consent, statement

that applicant has consented, proof of service on applicant) essential to a particular request for extension of time to oppose is omitted from the request, the Board can allow the defect to be corrected only if the correction is made prior to the expiration of the time for filing the request, that is, prior to the expiration of the thirty-day opposition period following publication of the subject mark, in the case of a first request, or prior to the expiration of the previous extension, in the case of a request for a further extension. See In re Su Wung Chong, 20 USPQ2d 1399 (Comm'r 1991); In re Software Development Systems, Inc., 17 USPQ2d 1094 (Comm'r 1989); In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990); and In re Spang Industries, Inc., 225 USPQ 888 (Comm'r 1985).

While a request for an extension of time to oppose must be signed, an unsigned request will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the written notification of this defect by the Board. See 37 CFR §2.119(e) and TBMP §106.02.

OLD EDITION

209 Action by Board on Request

209.01 Obtaining Application File

When a first request for an extension of time to oppose is received by the Board, the Board pulls the file of the involved application from issue. The application file generally is retained at the offices of the Board until all Board proceedings relating to the application have ended, that is, until the opposition period has expired without any opposition having been filed, or until all Board inter partes proceedings involving the application have been finally determined. Thereafter, the application is either sent to issue (if no opposition was filed, or if all oppositions filed were dismissed, and the decision in any interference or concurrent use proceeding was favorable to applicant), or stamped "ABANDONED" and sent to the PTO warehouse for storage (if an opposition was sustained, or if the decision in an interference or concurrent use proceeding was unfavorable to applicant).

The file of an application which is the subject matter of an opposition, an extension of time to oppose, an interference, or a concurrent use proceeding, is readily available at the offices of the Board for public inspection and copying. However, files or portions thereof may not be taken away from the offices of the

Board, and a person who removes papers from a file for copying at the ofices of the Board should always return the papers to the file in their proper order. See TBMP §121.01.

209.02 Notification of Action on Request

A request for an extension of time to oppose is examined by a member of the Board's administrative staff. Ordinarily, if the request is granted, it is stamped "APPROVED"; marked with both the date of approval and the date of expiration of the extension granted; and signed by the administrative staff member who granted it. One copy of the approved extension request is placed in the file of the subject application, one copy is mailed to the potential opposer, and one copy is mailed to the applicant.

Sometimes it is necessary for the administrative staff member to prepare a letter in connection with an extension that is being granted, as, for example, when the extension granted is shorter than that sought because a request for a further extension shows good cause for only part, rather than all, of the requested extension. In such a case, one copy each of the request and letter is placed in the file of the subject application, one copy of each is mailed to the applicant, and a copy of the letter is mailed to the potential opposer.

If a request for an extension of time to oppose is denied, a letter stating the reason(s) for the denial is prepared by the administrative staff member. One copy each of the request and letter is placed in the file of the subject application, one copy of each is mailed to the applicant, and a copy of the letter is mailed to the potential opposer.

OLD EDITION

209.03 Grant or Denial of Extensions - General Policy

The Board is relatively liberal in granting extensions of time to oppose. A liberal policy is necessary in order to afford potential opposers adequate time to make appropriate investigations and to decide, on the basis of the information so gathered, whether or not to oppose. The policy also allows potential opposers and applicants a reasonable opportunity to negotiate for settlement prior to the

filing of an opposition. Cf. Pickering & Co. v. Bose Corp., 174 USPQ 172 (Comm'r 1972).

Balanced against these considerations, however, must be applicant's interest in obtaining a registration quickly; the need of third parties, who may be using marks similar to applicant's and/or own conflicting applications, to know as soon as possible whether or not applicant's application will be opposed and, if so, on what basis; and the PTO's interest in minimizing application pendency time. See In re Universal Card Group Inc., 25 USPQ2d 1157 (Comm'r 1992).

In view thereof, the time for filing an opposition will not be suspended, or extended for an inordinate period, pending, for example, the final determination of another proceeding between the potential opposer and the applicant; or the conclusion of unduly prolonged settlement negotiations between them; or the filing of a new application, and prosecution thereof to publication or registration, by the potential opposer or applicant.

When a potential opposer files a request to suspend, or further extend, its time to oppose, pending the final determination of another proceeding between potential opposer and applicant, the request will be granted to the extent that potential opposer will be given a reasonable extension of time to oppose. However, potential opposer will be advised by the Board, in writing, that it is not the practice of the Board to suspend, or extend for an inordinate period, the time for opposing pending the final determination of another proceeding, and that any further request for an extension of time to oppose should be based upon other circumstances.

When a potential opposer files repeated extension requests based upon applicant's consent coupled with an assertion that the parties are negotiating for settlement, the Board ordinarily will require, for extensions aggregating more than 180 days from the date of publication of applicant's mark, that the extension request include also a short summary of the progress of the negotiations. In such a case, potential opposer will be advised by the Board, in writing, that any further extension requests made on the basis of consent and settlement negotiations should include a summary of the progress of the negotiations.

As a general rule, the Board will not grant extensions of time to oppose beyond 360 days from the date of publication, unless settlement has been reached and only needs to be executed. The general rule, however, will be applied flexibly and reasonably, depending upon the circumstances in a given case. For example,

OLD EDITION

if a foreign party is involved, or if parties are trying to settle several cases at once, or if numerous parties are involved, more time may be allowed.

After 120 days from the date of publication of applicant's mark, the Board, as a general rule, will not grant extensions for more than sixty days at a time for requests made without the consent of the applicant, or more than ninety days at a time for requests made with the consent of the applicant. Again, however, the general rule will be applied flexibly and reasonably, depending upon the circumstances in a particular case.

209.04 Determination of Extension Expiration Date

The extension expiration date stamped on an approved request, or stated in a letter granting an extension, is the date upon which the extension actually expires, even if that date is a Saturday, Sunday, or a Federal holiday within the District of Columbia. However, if the expiration date falls on a Saturday, Sunday, or a Federal holiday within the District of Columbia, an opposition, or a request for a further extension, filed by the potential opposer on the next succeeding day which is not a Saturday, Sunday, or a Federal holiday will be considered timely. See 37 CFR §1.6; Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991); and TBMP §112.

A first request for an extension of time to oppose sometimes asks for an extension of "thirty days," but specifies an extension expiration date which is different from the expiration date of the requested thirty days. In this case, the extension, if granted, will be set to expire on the thirtieth day, rather than on the specified date, unless the specified date is beyond thirty days, and good cause has been shown for the time in excess of thirty days. Cf. 37 CFR §2.102(c), and TBMP §207.02.

Similarly, a request for a further extension of time to oppose sometimes asks for a certain number of days, but specifies an extension expiration date which is different from the expiration date of the requested number of days. In this case, the extension, if granted, will normally be set to expire on the specified date. However, if part of the extension would fall beyond 120 days from the date of publication, and the request does not meet the 37 CFR §2.102(c) requirements for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent;

OLD EDITION

or a statement that applicant has consented, accompanied by proof of service on applicant), the extension, if granted, will be set to expire no later than 120 days from the date of publication. See Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991), and In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990). See also 37 CFR §2.102(c), and TBMP §207.03.

A first request for an extension of time to oppose may seek an extension of more than thirty days, but good cause must be shown for the time in excess of thirty days. See 37 CFR §2.102(c); Kimberly-Clark Corp. v. Paper Converting Industry, Inc., 21 USPQ2d 1875 (Comm'r 1991); and TBMP §207.02. If an otherwise proper first extension request seeks an extension of more than thirty days, but does not include a showing of good cause for the time in excess of thirty days, potential opposer will be granted an extension of only thirty days.

A request for a further extension of time to oppose may seek an extension for a period beginning prior to 120 days from the date of publication of the subject mark and ending after the 120th day. If such a request includes a showing of good cause, but does not meet the requirements of 37 CFR §2.102(c) for extensions aggregating more than 120 days from publication (i.e., does not include a showing of extraordinary circumstances; or applicant's written consent; or a statement that applicant has consented, accompanied by proof of service on applicant), any extension granted to potential opposer will be limited to the time for which good cause has been shown, and will end on or before the 120th day after publication. See 37 CFR §2.102(c); Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991); In re Societe Des Produits Nestle S.A., 17 USPQ2d 1093 (Comm'r 1990); and TBMP §207.03.

When an issue of the Official Gazette is mailed late (see TBMP §202.03), extensions of time to oppose run from the opposition period expiration date specified in the Commissioner's Notice of the late mailing, and the 120-day period of 37 CFR §2.102(c) runs from the Official Gazette mailing date specified in the Notice. The Official Gazette mailing date, and the opposition period expiration date, specified in the Commissioner's Notice will be used by the Board as the basis for calculating the expiration date of a first extension of time to oppose, even if an extension request specifies an extension expiration date calculated from the Official Gazette cover date. Normally, the dates specified in the Commissioner's Notice will also be used by the Board in calculating the expiration dates of further extensions of time to oppose. However, if a request for a further extension specifies a different extension expiration date, and the

OLD EDITION

request meets the requirements of 37 CFR §2.102, the extension will be set to expire on the specified date.

210 Objections to Request

Inasmuch as a request for an extension of time to oppose is ex parte in nature, there is no requirement that a copy thereof be served upon the applicant, unless the request seeks an extension beyond 120 days from the date of publication and is based upon an allegation of applicant's oral consent. See TBMP §203.04. For the same reason, an applicant is not notified of the filing of an extension request prior to action thereon by the Board. It is not until after the Board has acted upon an extension request that the Board sends the applicant a copy of the request (if there is no proof of service by potential opposer), together with notification of the Board's action thereon.

An applicant may learn of the filing of an extension request, and file objections thereto, before applicant receives anything from the Board relating to the request. This may happen, for example, when potential opposer serves a courtesy copy of the request upon applicant; or when the request is based upon an allegation of applicant's oral consent thereto, so that proof of service upon applicant is a required element of the request. If the objections are received by the Board before it acts upon the request, the Board will consider them in determining the request. If the objections are received after action on the request, and the request has been granted, they will be treated as a request for reconsideration of the Board's action.

An applicant which receives notification from the Board that an extension request has been filed and granted may, if it so desires, submit objections thereto in the form of a request for reconsideration of the Board's action. For information concerning a request for reconsideration of an action of the Board relating to a request for extension of time to oppose, see TBMP §211.01.

Further, an applicant which receives notification from the Board that a request for extension of time to oppose has been granted may submit objections to the granting of any further extensions of time to the potential opposer. In such a case, the objections will be considered by the Board in determining any subsequent request, filed by the potential opposer, for an extension of time to oppose. If the objections are not received by the Board until after the Board has

OLD EDITION

granted a subsequent extension request, they will be treated as a request for reconsideration of the Board's action.

Any paper objecting to a request for an extension of time to oppose, or to the granting of any further extensions of time to oppose, should state clearly the reasons for objection. There is no requirement that the paper be served upon the potential opposer. If there is no indication that service has been made, the Board will send potential opposer a copy of the paper together with the Board's action on the extension request, or, if the paper is treated by the Board as a request for reconsideration, with the Board's action on the request for reconsideration.

211 Relief From Action of Board

211.01 Request for Reconsideration

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a request for reconsideration of the action, stating the reasons therefor. The request should be filed promptly after receipt by the filing party of the action in question.

A request for reconsideration of a Board action relating to a request for an extension of time to oppose is examined by one of the Board's administrative staff members, who will prepare a letter granting or denying the request. One copy of the letter is placed in the file of the subject application, one copy is mailed to the applicant, and one copy is mailed to the potential opposer.

There is no requirement that a request for reconsideration be served upon the nonfiling party. If there is no indication that service has been made, the Board will send the nonfiling party a copy of the request together with that party's copy of the Board's letter granting or denying the request.

The filing of a request for reconsideration of the denial, or the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the request. Cf. 37 CFR §2.89(g).

OLD EDITION

211.02 Petition to the Commissioner

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a petition to the Commissioner, pursuant to 37 CFR §2.146, for review of the action in question. See also TMEP §§1702 and 1704.

The petition to the Commissioner must include a statement of the facts relevant to the petition; the points to be reviewed; the action or relief requested; and the requisite fee, as specified in 37 CFR §2.6. Any brief in support of the petition must be embodied in or accompany the petition. If facts are to be proved, the proof must be in the form of affidavits or declarations in accordance with 37 CFR §2.20, and these affidavits or declarations, with any exhibits thereto, must accompany the petition. See 37 CFR §2.146(c).

A petition from the denial of a request for an extension of time to oppose must be filed within 15 days from the mailing date of the denial of the request and must be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition must be made as provided in 37 CFR §2.119(a) (see also TBMP §§113.03 and 113.04). Applicant may file a response within 15 days from the date of service of the petition. A copy of the response must be served upon the petitioner, with proof of service as provided by 37 CFR §2.119(a). No further paper relating to the petition may be filed. See 37 CFR §2.146(e)(1).

Rule 2.146(e)(1), 377 CFR §2.146(e)(1), the provisions of which are summarized in the preceding paragraph, presently makes no reference to a petition from the granting of a request for an extension of time to oppose. However, the provisions of the rule may appropriately be followed in the case of such a petition.

The filing of a petition from the denial, or from the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition. That is, if the Commissioner's decision on the petition is favorable to the potential opposer, the term of the extension which was the subject of the petition will run from the expiration of the previously existing period for filing an opposition, not from the date of the Commissioner's decision on the petition.

OLD EDITION

Cf. 37 CFR §§2.89(g) and 2.146(g). Any opposition, or request for a further extension of time to oppose, filed by the involved potential opposer during the pendency of the petition to the Commissioner will be held by the Board for appropriate action after determination of the petition. In order to avoid the need for filing repeated requests for further extensions of time to oppose during the pendency of the petition, the potential opposer may simply file, prior to the expiration of the extension which is the subject of the petition, or prior to the expiration of a subsequent extension, a request for a further extension of time to oppose until a specified time, such as 30 days, after the Board's action following determination of the petition.

If a petition from the granting of a request for an extension of time to oppose is granted, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected by the Board as untimely.

OLD EDITION

212 Amendment of Application During or After Extension

212.01 Jurisdiction to Consider Amendment

If a request for an extension of time to oppose is filed, the Board obtains the file of the application and generally retains physical possession thereof until all Board proceedings relating to the application have ended, that is, until the opposition period has expired without any opposition having been filed, or until all Board inter partes proceedings involving the application have been finally determined. However, the Board has no jurisdiction over the application unless and until the application becomes involved in a Board inter partes proceeding. In the absence of an inter partes proceeding, the Board has jurisdiction only over matters relating to the requested extension(s) of time to oppose.

During the time between the publication of a mark in the Official Gazette for opposition, and the printing of a certificate of registration (in an application under Section 1(a) or 44 of the Act, 15 U.S.C. §1051(a) or 1126) or notice of allowance (in an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)), the Examining Attorney may approve an amendment to the application under certain conditions, provided that the application is not involved in an inter partes proceeding before the Board. See 37 CFR §2.84; In re MCI Communications

Corp., 21 USPQ2d 1534 (Comm'r 1991); and TMEP §§1504.01, 1504.03, and 1505 et seq.

Thus, if, in an application which is the subject of a request for an extension of time to oppose, an amendment or other paper (such as, a request for republication, a request for reconsideration of a refusal to approve an amendment, etc.) relating to the application is filed by the applicant, and the application is not involved in any Board inter partes proceeding, it is the Examining Attorney who must determine the propriety of the amendment or other paper. See 37 CFR §2.84, and In re MCI Communications Corp., 21 USPQ2d 1534 (Comm'r 1991).

However, the Board does determine the propriety of a request filed by an attorney or other authorized representative to withdraw as applicant's representative, in an application which is the subject of a request for an extension of time to oppose. The Board has jurisdiction to consider the request to withdraw as representative in such a case, because applicant's representative of record acts in applicant's behalf in matters relating to the requested extension(s) of time to oppose.

OLD EDITION

212.02 Conditions for Examining Attorney Approval of Amendment

During the time between the publication of a mark in the Official Gazette for opposition, and the printing of a certificate of registration (in an application under Section 1(a) or 44 of the Act, 15 U.S.C. §1051(a) or 1126) or notice of allowance (in an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)), an application not involved in an inter partes proceeding before the Board may be amended upon request by the applicant, provided that the amendment does not necessitate issuance of a refusal or requirement by the Examining Attorney. If a refusal or requirement by the Examining Attorney would be needed, the amendment cannot be made unless applicant (1) successfully petitions the Commissioner to restore jurisdiction over the application to the Examining Attorney for consideration of the amendment and further examination, and (2) is able to satisfy any requirement or overcome any refusal asserted in any Office action issued after the restoration of jurisdiction. See 37 CFR §2.84(b) and TMEP §§1504.01 and 1505 et seq.

Examples of the types of amendments which may be made under the conditions described above include acceptable amendments to the identification of goods, to the drawing, to add a disclaimer, and (in the case of an application under Section 1(a) of the Act, 15 U.S.C. §1051(a), or an application under Section 1(b) of the Act, 15 U.S.C. §1051(b) in which an acceptable amendment to allege use has been filed) to convert an application for an unrestricted registration to one for concurrent registration.

An applicant which files an amendment to its application during an extension of time to oppose need not have potential opposer's consent thereto.

212.03 Form of Amendment

An amendment or other paper relating to an application which is the subject of a request for an extension of time to oppose should be in the normal form for an amendment or other paper relating to an application, except that it should be directed to the attention of the Trademark Trial and Appeal Board (i.e., BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513), because the application file will be in the physical possession of the Board.

OLD EDITION

212.04 Action by Board--Upon Receipt of Amendment

When an amendment relating to an application which is the subject of a request for an extension of time to oppose is filed in the PTO, it is forwarded within the PTO to the physical location of the application. Normally, the file of such an application will be located at the offices of the Board. After the amendment has been placed in the application file, a Board administrative staff member will prepare a letter acknowledging receipt of the amendment, forwarding the application file to the Examining Attorney for consideration of the amendment, and explaining the effect the filing of the amendment has on the extension of time to oppose. See, for example, In re MCI Communications Corp., 21 USPQ2d 1534 (Comm'r 1991).

For example, if an extension of time to oppose is running when the letter is prepared, the letter will acknowledge receipt of the amendment; note that the

amendment requires consideration by the Examining Attorney; state that potential opposer has been granted an extension of time to oppose until a specified date; suspend the running of potential opposer's extension of time to oppose; forward the application to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, proceedings with respect to the potential opposition will be resumed, and further appropriate action will be taken. See In re MCI Communications Corp., 21 USPQ2d 1534 (Comm'r 1991). If the amendment is filed during an extension of time to oppose, and the Board's letter will not be ready for mailing prior to the date set for the expiration of the extension, the letter will include a statement that the filing of the amendment prior to the date set for the expiration of the extension served to suspend the running of the extension.

The reason for the suspension of the running of the extension period, in the example above, is that the potential opposer is entitled to know, before it files an opposition, whether or not the amendment has been approved. However, the suspension is solely for the benefit of the potential opposer, that is, to preserve potential opposer's time for opposing until potential opposer has been notified of the disposition of the amendment and has had adequate time thereafter to file an opposition. If, notwithstanding the Board's letter suspending the running of the extension, an opposition is filed prior to the expiration of the extension as originally set, the opposition will not be rejected by the Board as having been filed during the suspension; rather, potential opposer will be deemed to have waived the suspension of the running of its extension, and the opposition will be deemed timely. If the amendment is approved, and opposer does not wish to oppose the application as amended, opposer may request that the opposition not be instituted (or, if already instituted, that the institution be vacated), and that the opposition fee be refunded.

If an amendment is filed after the expiration of potential opposer's extension of time to oppose, and no opposition or request for a further extension of time to oppose has been timely filed, the Board's letter will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's extension of time to oppose has expired, and that no opposition or request for a further extension of time to oppose has been timely filed; forward the application to the Examining Attorney

OLD EDITION

for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 et seq.), and need not return the application to the Board after consideration of the amendment.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is appropriate for granting, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; grant the request; suspend the running of the extension period; forward the application to the Examining Attorney for consideration of the amendment; instruct the Examining Attorney to act on the amendment (either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file), and then return the application to the Board; and indicate that after the application has been returned to the Board, proceedings with respect to the potential opposition will be resumed, and further appropriate action will be taken.

If an amendment is filed prior to action by the Board on a request for an extension of time to oppose, and the request is not appropriate for granting, the letter will acknowledge receipt of the request and the amendment; note that the amendment requires consideration by the Examining Attorney; deny the request; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 et seq.), and need not return the application to the Board after consideration of the amendment.

If an amendment is filed after a request for an extension of time to oppose has been denied by the Board, but before the Board has forwarded the application to issue, the letter will acknowledge receipt of the amendment; note that the amendment requires consideration by the Examining Attorney; indicate that potential opposer's request for an extension of time to oppose has been denied; forward the application to the Examining Attorney for consideration of the amendment; and state that the Examining Attorney may treat the amendment in the same manner as any amendment after publication (TMEP §§1504.01 and 1505 et seq.), and need not return the application to the Board after consideration of the amendment.

OLD EDITION

When the Board's letter is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy each of the amendment and letter is mailed to the potential opposer. The application is then forwarded to the Examining Attorney for consideration of the amendment.

212.05 Action by Board--After Consideration of Amendment

When an amendment in an application which is the subject of an extension of time to oppose is forwarded to the Examining Attorney for consideration, the Examining Attorney acts on the amendment, either by approving it for entry or by telephoning the applicant, explaining why the amendment cannot be approved, and placing a record of the telephone call in the file. See In re MCI Communications Corp., 21 USPQ2d 1534 (Comm'r 1991). The Examining Attorney then returns the application to the Board (unless the time for opposing expired prior to the filing of the amendment).

After the application has been returned to the Board, a Board administrative staff member will prepare a letter indicating whether or not the amendment was approved, resuming proceedings with respect to the potential opposition, and taking further appropriate action relating thereto.

For example, sometimes a potential opposer, in a request for an extension of time to oppose or in a separate paper, states that it has agreed not to oppose if applicant's application is amended in a certain manner. If the amendment submitted by applicant conforms to the agreement, and is approved by the Examining Attorney, the Board's resumption letter will indicate that the amendment has been approved; that potential opposer has agreed not to oppose if the amendment is approved; and that the application is accordingly being forwarded to issue. If the amendment was not approved, the letter will so state, and the Board will reset potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; the suspension period is deemed to have commenced with the filing of the amendment; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

If there is no statement by potential opposer that it will not oppose if the amendment submitted by applicant is approved, the Board's resumption letter will state whether the amendment was approved, and the Board will reset

OLD EDITION

potential opposer's time to oppose (in the manner indicated in the preceding paragraph).

Sometimes an Examining Attorney considering an amendment to an application which is the subject of an extension of time to oppose, does not approve the amendment submitted by the applicant, but instead makes a different amendment by Examiner's Amendment (see TMEP §1111). In such a case, the Board, in its resumption letter, will so state; specify the amendment made by Examiner's Amendment; resume proceedings with respect to the potential opposition; and take further apropriate action relating thereto.

When the Board's resumption letter is ready for mailing, one copy is placed in the file of the subject application, one copy is mailed to the applicant, and one copy is mailed to the potential opposer.

OLD EDITION

212.06 Amendment During Opposition

If an amendment is filed in an application which is the subject of an opposition, the Board has jurisdiction over the application and will determine the propriety of the amendment. Once an opposition has commenced, the application which is the subject of the opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. See 37 CFR §2.133, and TBMP §514.

213 Effect of Restoration of Jurisdiction

If the Examining Attorney wishes to refuse registration or make a requirement in an application which is the subject of a request for an extension of time to oppose, the Examining Attorney must request the Commissioner to restore jurisdiction over the application to the Examining Attorney for that purpose. See 37 CFR §2.84(a) and TMEP §§1504.01 and 1504.02. If the application is also the subject of an opposition, the Examining Attorney's request for jurisdiction must be directed to the Board. See 37 CFR §2.130 and TMEP §1504.02.

When a request for jurisdiction is granted in an application for which there is an unexpired extension of time to oppose, the application is no longer subject to the

filing of a new opposition, and the restoration of jurisdiction serves to stay the running of the extension period. After the Board learns of the restoration of jurisdiction, a Board administrative staff member will prepare a letter advising potential opposer and applicant thereof and taking further appropriate action. Examples of three such letters are described below.

If the restoration of jurisdiction occurred during the running of an extension of time to oppose, and the Board's letter will be ready for mailing prior to the date set for the expiration of the extension, the letter will inform potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; that the application is no longer subject to the filing of a new opposition; that the running of the extension is suspended pending determination by the Examining Attorney of the registrability of the mark; and that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset.

One copy of the Board's letter will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the letter and of the Examining Attorney's Office action will be mailed to the potential opposer. Before the application is sent to the Examining Attorney, the administrative staff member will attach to the front of the file a note reading: "EXAMINER NOTE: IF THIS APPLICATION IS ULTIMATELY APPROVED, APPLICATION FILE MUST BE RETURNED TO TTAB FOR ACTION WITH RESPECT TO EXTENSION OF TIME TO OPPOSE." If the Examining Attorney does subsequently approve the application, and the mark is not republished, the Board administrative staff member will prepare a letter so advising potential opposer and applicant, and resetting potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; the suspension period is deemed to have commenced with the restoration of jurisdiction; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period). If the mark is republished, potential opposer's time for opposing will recommence on the date of republication.

If the restoration of jurisdiction occurred during the running of an extension of time to oppose, and the Board's letter notifying potential opposer and applicant of the restoration of jurisdiction will not be ready for mailing prior to the date set for the expiration of the extension, the letter will include a statement that the

DEPOSITION

restoration of jurisdiction prior to the date set for the expiration of the extension served to suspend the running of the extension.

If the restoration of jurisdiction occurred prior to the expiration of the extension sought in a well-taken request for an extension of time to oppose, and the extension request has not yet been determined when the Board's letter is being prepared, the Board, in its letter, will inform potential opposer and applicant that jurisdiction over the application has been restored to the Examining Attorney; state that the application is no longer subject to the filing of a new opposition; grant the extension request; suspend the running of the extension pending determination by the Examining Attorney of the registrability of the mark; and indicate that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset.

214 Effect of Republication

The Examining Attorney may determine that the mark in an application which is the subject of a request for an extension of time to oppose must be republished. This may happen, for example, when the mark was originally published in the wrong class; when the goods or services, although properly identified in the application itself, were published incorrectly; when a disclaimer was mistakenly included, or not included, in the original publication; or when the application has been amended after publication (but before the filing of an opposition), and the amendment is of such nature as to require republication (see TMEP §1505.01).

If a mark is republished by order of the Examining Attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. If the change reflected in the republication is one which might have an effect upon the opposition, the Board will notify opposer and applicant, in writing, of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition not instituted.

OLD EDITION

However, once the Board learns that a mark which is the subject of a request for an extension of time to oppose has been or will be republished by order of the Examining Attorney, no further extension of the original opposition period will be granted; rather, a potential opposer's time for opposing will recommence with the republication of applicant's mark. Thus, if there is a pending request for an extension of time to oppose, a Board administrative staff member will prepare a letter notifying potential opposer and applicant of the republication and taking appropriate action with respect to the extension request. Normally, the extension request will be deemed moot. However, if the extension request was filed within thirty days after the date of republication, it may be treated as a request for an extension of the new opposition period.

If there has been an error in the first publication, or the application has been amended thereafter, republication is often necessary in order to give potential opposers fair notice of the registration sought by applicant. Sometimes, however, a mark which has been published correctly, and has not been amended thereafter, is republished not because there is any need for republication, but by inadvertence. When there is no need for republication, and a mark is republished solely by mistake (as, for example, when an application has survived an opposition, and is ready to go to issue, but is inadvertently sent to publication rather than to issue), the application may not properly be subjected to another opposition period.

Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response to the republication. An opposition filed in response to the inadvertent republication will be returned to the opposer, and the opposition fee will be refunded. The remedy of a would-be opposer or potential opposer in such a case lies in the filing of a petition for cancellation, under Section 14 of the Act, 15 U.S.C. §1064, after applicant's registration has been issued.

OLD EDITION

215 Effect of Letter of Protest

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by

supporting evidence. See TMEP §1116; In re BPJ Enterprises Ltd., 7 USPQ2d 1375 (Comm'r 1988); and In re Pohn, 3 USPQ2d 1700 (Comm'r 1987). The Director will determine whether the letter of protest should be "granted," that is, whether the information should be given to the Examining Attorney for consideration. See TMEP §1116. For information concerning the standard applied by the Director in determining whether a letter of protest should be granted, see "Changes in Practice Concerning Letters of Protest," 1172 TMOG 93 (March 28, 1995).

A letter of protest may be filed either before or after publication of the subject mark for opposition. However, a letter of protest filed after publication ordinarily must be filed within thirty days after publication in order to be considered timely. See In re BPJ Enterprises Ltd., 7 USPQ2d 1375 (Comm'r 1988); In re Pohn, 3 USPQ2d 1700 (Comm'r 1987); and TMEP §1116.02(a). Moreover, even if the Director decides to grant a post-publication letter of protest, the submitted information cannot be considered by the Examining Attorney unless the Commissioner, upon written request by the Director, concurs in the decision to grant the letter of protest and restores jurisdiction over the application to the Examining Attorney. See TMEP §1116.02. If the application is the subject of an opposition, the request for jurisdiction should be directed to the Board. See 37 CFR §2.130 and TMEP §1504.02.

The filing of a letter of protest after publication does not serve to stay the time for filing an opposition to the subject mark. See TMEP §1116. If a party which files a letter of protest after publication wishes to preserve its right to oppose in the event that the letter of protest is denied, it must file a timely request for an extension of time to oppose. Cf. In re BPJ Enterprises Ltd., 7 USPQ2d 1375 (Comm'r 1988).

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that potential opposer filed a letter of protest (not yet determined by the Director) with respect to the subject mark within thirty days after publication, the Board will grant the extension request, if otherwise appropriate, and then suspend the running of the extension pending determination of the letter of protest.

The Board will not suspend the running of an extension of time to oppose pending the determination of a letter of protest if the letter of protest was filed by a third party, or was filed more than thirty days after publication of the subject

OLD EDITION

mark, or if the filing of the letter of protest is not brought to the attention of the Board.

If a potential opposer indicates, in a first or a subsequent request for an extension of time to oppose, that potential opposer filed a letter of protest (not yet determined by the Director) with respect to the subject mark more than thirty days after publication, the Board will consider such filing to be good cause for extensions of time to oppose aggregating up to 120 days from the date of publication of the mark, but will not consider the filing to constitute extraordinary circumstances justifying an extension of time beyond 120 days from publication. The filing by a third party of a letter of protest (not yet determined by the Director), with respect to a mark which is the subject of a request for an extension of time to oppose, will not be considered by the Board to constitute good cause for the granting of an extension to the potential opposer.

Following determination of a letter of protest filed with respect to an application which is the subject of a request for an extension of time to oppose, the Board will take further appropriate action. Two examples are described below.

Often, when the application comes to the Board for further appropriate action, the letter of protest has been granted; jurisdiction over the application has been restored to the Examining Attorney; the Examining Attorney has issued an Office action asserting a refusal or a requirement; and an extension of time to oppose is running, or the running of the extension has been suspended pending determination of the letter of protest. In such a case, a Board administrative staff member will prepare a letter notifying potential opposer and applicant that the letter of protest has been granted; that jurisdiction over the application has been restored to the Examining Attorney; that an Office action has been issued; that the application is no longer subject to the filing of a new opposition; that the running of the extension is suspended pending determination by the Examining Attorney of the registrability of applicant's mark; and that if the application is subsequently approved by the Examining Attorney, and the mark is not republished, potential opposer's time for filing an opposition will be reset. One copy of the Board's letter will be placed in the file of the subject application, one copy will be mailed to the applicant, and one copy each of the letter and of the Examining Attorney's Office action will be mailed to the potential opposer. If the Examining Attorney does subsequently approve the application, and the mark is not republished, a Board administrative staff member will prepare a letter so advising potential opposer and applicant, and resetting potential opposer's time to oppose (potential opposer is usually allowed thirty days for the purpose; and the

OLD EDITION

running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

If the running of the extension of time to oppose has been suspended pending the determination of a letter of protest, and the letter of protest is denied, the Board's letter will so advise potential opposer and applicant, and will reset potential opposer's time to oppose (again, potential opposer is usually allowed thirty days for the purpose; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period).

216 Inadvertently Issued Registration

Sometimes a registration is issued, mistakenly, from an application which, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. Such a registration is called an "inadvertently issued" registration.

The Board is without authority, within the context of either an extension of time to oppose, or an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Commissioner who has such authority, and the Commissioner exercises this authority with caution. See In re Trademark Registration of Mc Lachlan Touch Inc., 6 USPQ2d 1395 (Comm'r 1987).

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application which is the subject of an unexpired extension of time to oppose, or a timely opposition, the Board will forward the registration file to the Commissioner for such action as the Commissioner deems appropriate. The Commissioner, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

If the Commissioner cancels, and restores to application status, a registration which issued inadvertently during an extension of time to oppose, the Board will reset potential opposer's time to oppose. In such cases, the running of potential opposer's extension of time to oppose is deemed to have been suspended by the inadvertent issuance of the registration, because a potential opposer cannot file an

OLD EDITION

opposition to an issued registration. When potential opposer's time to oppose is reset, potential opposer normally will be allowed thirty days for the purpose; and the running of the 120-day period of 37 CFR §2.102(c) is considered to have been tolled for the length of the suspension, if the suspension began during the 120-day period. See In re Siemens Aktiengesellschaft, 34 USPQ2d 1862 (Comm'r 1995). Potential opposer and applicant will be informed of the inadvertent issuance of the registration; its cancellation by the Commissioner; and the resetting of potential opposer's time to oppose, in a letter prepared by a Board administrative staff member.

If a registration issued inadvertently during an extension of time to oppose is not cancelled by the Commissioner, and restored to application status, any opposition which may have been filed by the potential opposer will be returned; any submitted opposition fee will be refunded; and potential opposer may have remedy by way of a petition to cancel the registration.

If a registration issues inadvertently during a timely opposition, the Commissioner normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

OLD EDITION

217 Relinquishment of Extension

If a potential opposer whose request for an extension of time to oppose is pending, or whose granted extension has not yet expired, files a letter notifying the Board that it will not oppose, the Board will immediately forward the application which was the subject of the request, or extension, to issue.

If a potential opposer which has requested or obtained an extension of time to oppose thereafter agrees unconditionally, in writing, not to oppose, applicant may submit a copy of the agreement to the Board, with an appropriate cover letter bearing proof of service upon potential opposer, and the Board will immediately forward the subject application to issue. Cf. TBMP §211.05.

218 Abandonment of Application

If an applicant files an express abandonment of an application which is the subject of a pending request for an extension of time to oppose, or of a granted extension, the application stands abandoned and any pending request for an extension of time to oppose is moot. An application which has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer, and the opposition fee will be refunded. See Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992), and In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§307.11 and 602.01.

The express abandonment of an application which is not the subject of an inter partes proceeding before the Board (e.g., an opposition, interference, or concurrent use proceeding) is without prejudice to the applicant; it is not necessary that applicant obtain a potential opposer's consent thereto. See 37 CFR §2.68.

In contrast, after the commencement of an opposition, interference, or concurrent use proceeding, if applicant files an express abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. See 37 CFR §2.135. However, if an applicant files an abandonment after the commencement of an opposition, interference, or concurrent use proceeding, but before applicant has been notified thereof by the Board, applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgement shall be entered against applicant. See In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§307.11 and 602.01.

An applicant which wishes to expressly abandon its application may do so by filing in the PTO a written statement of abandonment or withdrawal of the application, signed by the applicant or by the applicant's attorney or other authorized representative. See 37 CFR §2.68.

When an applicant files an express abandonment of an application which is the subject of a pending request for an extension of time to oppose, or of a granted

OLD EDITION

extension, a Board administrative staff member will prepare a letter acknowledging receipt of the abandonment, and notifying potential opposer that the application is no longer subject to the filing of a new opposition.

219 Amendment to Allege Use; Statement of Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. §1051(c), filed in an intent-to-use application (i.e., an application under Section 1(b) of the Act, 15 U.S.C. §1051(b)) after approval for publication is late-filed. See 37 CFR §2.76(a); "Waiver of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993); and In re Sovran Financial Corp., 25 USPQ2d 1537 (Comm'r 1992). Thus, an amendment to allege use filed during an extension of time to oppose, or during an opposition, is late-filed.

A statement of use under Section 1(d) of the Act, 15 U.S.C. §1051(d), is premature if it is filed in an intent-to-use application prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. §1063(b)(2). See Section 1(d)(1) of the Act, 15 U.S.C. §1051(d)(1), and 37 CFR §2.88(a). A notice of allowance is issued in an intent-to-use application (for which no amendment to allege use has been timely filed and accepted) only after the time for opposing has expired, and all oppositions filed have been dismissed. See Section 13(b)(2) of the Act, 15 U.S.C. §1063(b)(2), and 37 CFR §2.81(b). Thus, a statement of use filed during an extension of time to oppose, or during an opposition, is premature.

Any late-filed amendment to allege use, or premature statement of use, will be returned to the applicant, and any fee submitted therewith will be refunded. See 37 CFR §§2.76(a) and 2.88(a).

If an intent-to-use application has already been published, and is the subject of an extension of time to oppose, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board will suspend the running of any granted extension and return the application to the Trademark Examining Attorney for appropriate action with respect to the amendment to allege use. The Examining Attorney, in turn, will process the amendment to allege use in the same manner (described in TMEP §1105.05(a)(i)(A)) as any other timely filed amendment to allege use which is not associated with the application file until after publication. In the

OLD EDITION

event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the application should be returned by the Examining Attorney to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the extension of time to oppose. See TMEP §1105.05(a)(i)(A). If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

If an intent-to-use application has already been published, and is the subject of an opposition, when a timely filed amendment to allege use (i.e., an amendment to allege use filed prior to approval for publication) is associated with the application, the Board normally will suspend the opposition and return the application to the Trademark Examining Attorney for appropriate action (as described in TMEP §1105.05(a)(i)(A)) with respect to the amendment to allege use. In the event that the amendment to allege use is ultimately withdrawn by the applicant, or approved by the Examining Attorney, the application should be returned by the Examining Attorney to the Board (prior to any scheduled republication of applicant's mark) for further appropriate action with respect to the opposition. See TMEP §1105.05(a)(i)(A). If the application is abandoned while it is before the Examining Attorney, the Board should be notified.

Sometimes a notice of allowance is issued, mistakenly, in an intent-to-use application which, at the time of such issuance, is the subject of an unexpired extension of time to oppose, or a timely opposition. If a notice of allowance is inadvertently issued in an intent-to-use application which is the subject of an unexpired extension of time to oppose, or a timely opposition, and a statement of use is filed, the notice of allowance will be cancelled (by the Intent To Use Division of the Office of Trademark Services) as inadvertently issued, the statement of use will be returned, and the fee submitted therewith will be refunded. If the inadvertently issued notice of allowance has already been cancelled when the Board receives the statement of use, the Board itself will return the statement of use and refund the fee submitted therewith. If the inadvertently issued notice of allowance has not already been cancelled when the Board receives the statement of use, the Intent To Use Division will return the statement of use, and refund the fee, when it cancels the notice of allowance.

OLD EDITION

CHAPTER 300 PLEADINGS

301 Commencement of Proceeding

302 Mark on Supplemental Register Not Subject to Opposition

303 Who May Oppose or Petition to Cancel

304 Joint Opposers or Petitioners

305 Proceeding Against Multiple Class Application or Registration

306 Consolidated and Combined Complaints

307 Time for Filing Opposition

308 Time for Filing Petition to Cancel

309 Fee for Filing Opposition

310 Fee for Filing Petition to Cancel

311 Scope of Opposition and Petition to Cancel

312 Form of Opposition and Petition to Cancel

313 Exhibits to Pleadings

314 FRCP 11 Applicable

315 Notification of Proceeding

316 Time for Filing Answer

317 Default

318 Form of Answer

319 Counterclaims

OLD EDITION

320 Reply to Answer Should Not be Filed

321 Unpleaded Matters

322 Amendment of Pleadings

323 Motions Relating to Pleadings

324 Amendment to Allege Use; Statement of Use

OLD EDITION

301 Commencement of Proceeding

37 CFR §2.101(a) An opposition proceeding is commenced by the filing of an opposition in the Patent and Trademark Office.

37 CFR §2.111(a) A cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the Patent and Trademark Office.

37 CFR §2.116(b) The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

37 CFR §2.116(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

An opposition proceeding is commenced by the timely filing of a notice of opposition in the PTO. See 37 CFR §2.101(a). See also Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988). Cf. FRCP 3. Similarly, a cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the PTO. See 37 CFR §2.111(a).

The notice of opposition, or the petition for cancellation, and the answer thereto correspond to the complaint and answer in a court proceeding. See 37 CFR §2.116(c). The opposer in an opposition proceeding, or the petitioner in a cancellation proceeding, is in the position of plaintiff, and the applicant in an opposition proceeding, or the respondent in a cancellation proceeding, is in the position of defendant. See 37 CFR §2.116(b). See also Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

An interference proceeding commences when the Board mails a notice of interference to each of the parties to the proceeding, as described in 37 CFR §2.93. Similarly, a concurrent use proceeding commences when the Board mails

OLD EDITION

a notice of the proceeding to each of the parties thereto, as described in 37 CFR §§2.99(c) and 2.99(d)(1). For further information concerning interference and concurrent use proceedings, see TBMP chapters 1000 and 1100, respectively.

302 Mark on Supplemental Register Not Subject to Opposition

Although the mark in an application for registration on the Principal Register is published for, and subject to, opposition, the mark in an application for registration on the Supplemental Register is not. See Sections 12(a), 13(a), and 24 of the Act, 15 U.S.C. §§1062(a), 1063(a), and 1092. See also TBMP §205.

Accordingly, the Board must reject any opposition filed with respect to the mark in an application for registration on the Supplemental Register. The opposition papers will be returned to the person who filed them, and any opposition fee submitted will be refunded. The remedy of the would-be opposer lies in the filing of a petition to cancel the registration of the mark, once the registration has issued. See Section 24 of the Act, 15 U.S.C. §1092.

303 Who May Oppose or Petition to Cancel

303.01 In General

15 U.S.C. §1063(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. ...

15 U.S.C. §1064 A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....

15 U.S.C. §1092 Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official

OLD EDITION

Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. ...

15 U.S.C. §1127 In the construction of this Act, unless the contrary is plainly apparent from the context-

* * *

Person; Juristic Person. The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

* * *

37 CFR §2.2(b) Entity as used in this part includes both natural and juristic persons.

37 CFR §2.101(b) Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. ...

37 CFR §2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...

OLD EDITION

303.02 Meaning of the Term "Person"

The term "person," as used in the Act, includes both natural and juristic persons. See Section 45 of the Act, 15 U.S.C. §1127. Cf. 37 CFR §2.2(b). A juristic person is a "firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." See Section 45 of the Act, 15 U.S.C. §1127. See also Opryland USA Inc. v. The Great American Music Show Inc.,

970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992) [a "person" may be a corporation or other entity]; Morehouse Manufacturing Corp. v. J. Strickland and Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969) [commercial corporation, being a "person" within the meaning of Section 45 of the Act, can base opposition on Section 2(a) of the Act, 15 U.S.C. §1052(a)]; Aruba v. Excelsior Inc., 5 USPQ2d 1685 (TTAB 1987) [Commonwealth of Aruba is a "person" within the meaning of Sections 13 and 45 of the Act]; U.S. Navy v. United States Manufacturing Co., 2 USPQ2d 1254 (TTAB 1987) [U.S. Navy is a juristic person within the meaning of Section 45 of the Act]; The Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB 1986) [Alabama Board of Trustees, a corporate body, may be considered either a "person" or an "institution" within the meaning of Section 2(a) of the Act]; Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752 (TTAB 1985) [corporations as well as individuals are "persons" for purposes of Section 2(a) of the Act]; and In re Mohawk Air Services Inc., 196 USPQ 851 (TTAB 1977) [a government agency is a juristic person and as such may file an application for registration, an opposition, or a petition for cancellation].

If an operating division of a corporation is not itself incorporated or is not otherwise a legal entity which can sue and be sued, it does not have legal standing to own a mark or to file an application for registration, an opposition, or a petition for cancellation. See In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986), and TMEP §1201.02(d). In such a case, the application, opposition, or petition for cancellation should be filed in the name of the corporation of which the division is a part. If an opposition, or a petition for cancellation, is filed in the name of a division, and there is no indication that the division is incorporated, the Board will make written inquiry as to whether the division is incorporated or is otherwise a legal entity which can sue and be sued. If the opposer, or petitioner, responds in the negative, the opposition, or petition for cancellation, will go forward in the name of the corporation of which the division is a part. Cf. In re Cambridge Digital Systems, supra, and TMEP §1201.02(d).

OLD EDITION

303.03 Meaning of the Term "Damage"

The term "damage," as used in Sections 13 and 14 of the Act, 15 U.S.C. §§1063 and 1064, relates only to a party's standing to file an opposition or a petition to cancel, respectively. A party may establish its standing to oppose or to petition

to cancel by showing that it has a "real interest" in the case, that is, a personal interest in the outcome of the proceeding beyond that of the general public. There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. See Books on Tape Inc. v. Booktape Corp., 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987); Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1987), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); Rosso & Mastracco, Inc. v. Giant Food Inc., 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992); Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991); Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990); Ipco Corp. v. Blessings Corp., 5 USPQ2d 1974 (TTAB 1988); Aruba v. Excelsior Inc., 5 USPQ2d 1685 (TTAB 1987); Bankamerica Corp. v. Invest America, 5 USPQ2d 1076 (TTAB 1987); BRT Holdings Inc. v. Homeway, Inc., 4 USPQ2d 1952 (TTAB 1987); American Speech-Language-Hearing Ass'n v. National Hearing Aid Society, 224 USPQ 798 (TTAB 1984); and Davco Inc. v. Chicago Rawhide Mfg. Co., 224 USPQ 245 (TTAB 1984).

OLD EDITION

303.04 Federal Trade Commission

The proviso at the end of Section 14 of the Act, 15 U.S.C. §1064, specifically states that the Federal Trade Commission may apply to cancel, on the grounds specified in paragraphs (3) and (5) of the section, any mark registered on the Principal Register established by the Act. See also Formica Corp. v. Lefkowitz, 590 F.2d 915, 200 USPQ 641 (CCPA 1979), and Federal Trade Commission v. Formica Corp., 200 USPQ 182 (TTAB 1978). For a listing of the grounds for cancellation specified in paragraphs (3) and (5) of Section 14 of the Act, see TBMP §308.01.

303.05 Opposition Filed During Extension of Time to Oppose

37 CFR §2.102(b) The written request to extend the time for filing an opposition must identify the potential opposer with reasonable certainty. Any opposition filed during an extension of time should be in the name of the person to whom the extension was granted, but an opposition may be accepted if the person in whose name the extension was requested was misidentified through mistake or if the opposition is filed in the name of a person in privity with the person who requested and was granted the extension of time.

303.05(a) General Rule

An extension of time to oppose is a personal privilege which inures only to the benefit of the party to which it was granted and those in privity with that party. For this reason, an opposition filed during an extension of time to oppose ordinarily must be filed in the name of the party to which the extension was granted. See 37 CFR §2.102(b); TMEP §1503.04; SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); and In re Cooper, 209 USPQ 670 (Comm'r 1980). Cf. TBMP §206.02.

303.05(b) Opposition Filed by Privy

An opposition filed during an extension of time to oppose, by a party other than the party to which the extension was granted, will not be rejected on that ground if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension. See 37 CFR §2.102(b); TMEP §1503.04; SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); and In re Cooper, 209 USPQ 670 (Comm'r 1980). Cf. TBMP §206.02.

The "showing" should be in the form of a recitation of the facts upon which the claim of privity is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy. If the opposition is filed both in the name of the party granted the previous extension and in the name of one or more differing parties, an explanation will be requested as to each differing party, and the opposition will not be accepted as to any differing party which fails to make a satisfactory showing of privity.

For information concerning the meaning of the term "privity," see TBMP §206.02.

OLD EDITION

303.05(c) Misidentification

If the name of the opposer, in an opposition filed during an extension of time to oppose, differs from the name of the party to which the extension was granted, the opposition will not be rejected on that ground if it is shown to the satisfaction of the Board that the party in whose name the extension was requested was misidentified through mistake. See 37 CFR §2.102(b), and Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993). The phrase "misidentification by mistake," as used in 37 CFR §2.102(b), means a mistake in the form of the opposer's name or its entity type, not the naming of a different existing legal entity that is not in privity with the party that should have been named. See Cass Logistics Inc. v. McKesson Corp., supra. See also TMEP §1503.04. Cf. Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505 (TTAB 1974); Davidson v. Instantype, Inc., 165 USPQ 269 (TTAB 1970); Pyco, Inc. v. Pico Corp., 165 USPQ 221 (TTAB 1969); Raker Paint Factory v. United Lacquer Mfg. Corp., 141 USPQ 407 (TTAB 1964); and TBMP §512.04. Cf. also TMEP §§802.06 and 802.07; In re Tong Yang Cement Corp., 19 USPQ2d 1689 (TTAB 1991); In re Atlanta Blue Print Co., 19 USPQ2d 1078 (Comm'r 1990); In re Techsonic Industries, Inc., 216 USPQ 619 (TTAB 1982); Argo & Co. v. Springer, 198 USPQ 626 (TTAB 1978); In re Eucryl, Ltd., 193 USPQ 377 (TTAB 1976); Argo & Co. v. Springer, 189 USPQ 581 (TTAB 1976); and U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc., 183 USPQ 613 (Comm'r 1974).

The "showing" submitted in support of a claim of misidentification by mistake should be in the form of a recitation of the facts upon which the claim of misidentification by mistake is based, and must be submitted either with the opposition, or during the time allowed by the Board in its letter requesting an explanation of the discrepancy.

304 Joint Opposers or Petitioners

An opposition, or a petition for cancellation, may be filed by two or more parties jointly. However, the required fee must be submitted for each party joined as opposer, or petitioner, for each class in the application for which registration is opposed, or for each class in the registration for which cancellation is sought.

OLD EDITION

See 37 CFR §§2.101(d)(1) and 2.111(c)(1); SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); and TBMP §§309 and 310.

When parties file jointly, the notice of opposition, or petition for cancellation, must name each party joined as plaintiff. In addition, the notice of opposition, or petition for cancellation, should include allegations concerning the standing of each party plaintiff, and the ground or grounds for opposition or cancellation. If the case is ultimately determined on the merits, rather than by default, withdrawal, stipulation, etc., any joint plaintiff whose standing has not been proved cannot prevail therein, even though a ground for opposition or cancellation has been proved. See Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986).

On the other hand, the fact that two or more parties may have an interest in a mark to be pleaded in a notice of opposition, or a petition for cancellation, does not mean that each such party must be joined as opposer, or petitioner. Joint filing is elective, not mandatory. See Avia Group International Inc. v. Faraut, 25 USPQ2d 1625 (TTAB 1992).

OLD EDITION

305 Proceeding Against Multiple Class Application or Registration

When an opposition is filed with respect to an application which contains goods and/or services in multiple classes (see 37 CFR §2.86(b)), or a petition for cancellation is filed with respect to a registration which contains goods and/or services in multiple classes, the class or classes opposed, or sought to be cancelled, should be specified in the plaintiff's pleading. In addition, the required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled. See 37 CFR §§2.101(d) and 2.111(c), and TBMP §§309 and 310.

306 Consolidated and Combined Complaints

37 CFR §2.104(b) Oppositions to different applications owned by the same party may be joined in a consolidated opposition when appropriate, but the required fee must be included for each party joined as opposer for each class in which registration is opposed in each application against which the opposition is filed.

37 CFR §2.112(b) Petitions to cancel different registrations owned by the same party may be joined in a consolidated petition when appropriate, but the required fee must be included for each party joined as petitioner for each class sought to be cancelled in each registration against which the petition to cancel is filed.

When appropriate, a party may oppose, in a single (i.e., "consolidated") notice of opposition, different applications owned by the same defendant. However, the required fee must be submitted for each party joined as opposer, for each class in which registration is opposed, in each application against which the opposition is filed. See 37 CFR §2.104(b). When such a pleading is filed, the Board sets up a single opposition file, identified by a single opposition proceeding number, but bearing on its front, in the place where the number of the opposed application is written, the number of each application opposed in the consolidated notice of opposition.

Similarly, when appropriate, a party may seek to cancel, in a single ("consolidated") petition for cancellation, different registrations owned by the same defendant. Again, the required fee must be submitted for each party joined as petitioner, for each class sought to be cancelled, in each registration against which the petition for cancellation is filed. See 37 CFR §2.112(b). When such a pleading is filed, the Board sets up a single cancellation file, identified by a single cancellation proceeding number, but bearing on its front the number of each registration sought to be cancelled in the consolidated petition to cancel.

In addition, a party may file, when appropriate, a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, provided that each subject application and registration is owned by the same defendant. See Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993). However, the required fee must be submitted for each party joined as plaintiff, for each class sought to be opposed or cancelled, in each application or registration against which the pleading is filed. Cf. 37 CFR §§2.104(b) and 2.112(b). When such a pleading (referred to as a "combined" opposition and petition to cancel) is filed, the Board sets up both an opposition and a cancellation proceeding file, each with its own identifying number, and each marked "Combined with _____" followed by the number of the other proceeding. The opposition is treated as the "parent" case, and both proceeding numbers are placed on all papers relating to the combined proceedings. Cf. TBMP §511.

OLD EDITION

A consolidated notice of opposition, or petition to cancel, or a combined notice of opposition and petition to cancel, is appropriate if the plaintiff's claims against each of the defendant's subject applications, and/or registrations, involve common (i.e., similar) questions of law or fact. See Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993). Cf. FRCP 42(a); TBMP §511; World Hockey Ass'n v. Tudor Metal Products Corp., 185 USPQ 246 (TTAB 1975); and Izod, Ltd. v. La Chemise Lacoste, 178 USPQ 440 (TTAB 1973). Cf. also Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444, 1445 (TTAB 1987), and Federated Department Stores, Inc. v. Gold Circle Insurance Co., 226 USPQ 262, 263 (TTAB 1985).

307 Time for Filing Opposition

307.01 In General

15 U.S.C. §1062(a) Upon the filing of an application for registration and payment of the prescribed fee, the Commissioner shall refer the application to the examiner in charge of the registration of marks who shall cause an examination to be made and, if on such examination it shall appear that the applicant is entitled to registration, or would be entitled to registration upon the acceptance of the statement of use required by section 1(d) of this Act, the Commissioner shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....

15 U.S.C. §1063(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 12 of this Act of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. ...

OLD EDITION

37 CFR §2.101(c) The opposition must be filed within thirty days after publication (§2.80) of the application being opposed or within an extension of time (§2.102) for filing an opposition.

An opposition to the registration of a mark upon the Principal Register must be filed prior to the expiration of the thirty-day period after publication of the mark in the Official Gazette for opposition, or within an extension of time to oppose granted to the opposer or its privy. See Section 13(a) of the Act, 15 U.S.C. §1063(a); 37 CFR §§2.102(b) and (c); SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); and In re Cooper, 209 USPQ 670 (Comm'r 1980). Cf. TBMP chapter 200.

The certificate of mailing by first-class mail procedure described in 37 CFR §1.8 and the certificate of "Express Mail" procedure described in 37 CFR §1.10 are both available for the filing of a notice of opposition; the certificate of transmission procedure described in 37 CFR §1.8 is not. See 37 CFR §§1.8(a) and 1.10(a).

OLD EDITION

307.02 Date of Publication of Mark

Normally, the date of publication of a mark is the cover date of the issue of the Official Gazette in which the mark is published, pursuant to Section 12(a) of the Act, 15 U.S.C. §1062(a), for purposes of opposition.

However, when an issue of the Official Gazette is mailed late (see TBMP §202.03), the date of publication of the marks published therein for opposition is considered by the Commissioner to be the date on which the Official Gazette was mailed, and the thirty-day opposition period is considered by the Commissioner to run from the Official Gazette mailing date, rather than from its cover date. Applicants and potential opposers are notified of the late mailing, and of the consequent change in both the publication date and the opposition period expiration date, by a Commissioner's Notice published in a subsequent issue of the Official Gazette. Cf. In re BPJ Enterprises Ltd., 7 USPQ2d 1375, at fn.1 (Comm'r 1988).

307.03 Premature Opposition

Section 13 of the Act, 15 U.S.C. §1063(a), requires that an opposition to the registration of a mark upon the Principal Register be filed within a specified time after the publication of the mark in the Official Gazette.

Thus, any opposition filed prior to the publication, in the Official Register, of the mark sought to be opposed is premature, and will be rejected by the Board, even if the mark has been published by the time of the Board's action. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded. Cf. TBMP §§119.03 and 202.04.

307.04 Late Opposition

Because the timeliness requirements of Section 13(a) of the Act, 15 U.S.C. §1063(a), for the filing of an opposition are statutory, they cannot be waived by stipulation of the parties, nor can they be waived by the Commissioner upon petition. See In re Cooper, 209 USPQ 670 (Comm'r 1980).

Accordingly, an opposition filed after the expiration of the would-be opposer's time for opposing must be rejected by the Board as late. No proceeding will be instituted; rather, the opposition papers will be returned, and any submitted opposition fee will be refunded. The would-be opposer's remedy lies in the filing of a petition for cancellation, pursuant to Section 14 of the Act, 15 U.S.C. §1064, when and if a registration is issued.

OLD EDITION

307.05 Effect of Suspension of Extension Time

The Board sometimes suspends the running of an extension of time to oppose pending consideration by the Examining Attorney of an amendment to the applicant's subject application (see TBMP §212.04), or pending determination of a letter of protest filed by the potential opposer, with respect to applicant's subject application, during the thirty days after publication for opposition (see TBMP §215).

However, the suspension of the running of the extension in these situations is solely for the benefit of the potential opposer, that is, to preserve potential

opposer's time for opposing until potential opposer has been notified of the disposition of the amendment, or letter of protest, and has had adequate time thereafter to file an opposition. See TBMP §212.04.

If, notwithstanding the Board's letter suspending the running of the extension, an opposition is filed prior to the expiration of the extension as originally set, the opposition will not be rejected by the Board as having been filed during the suspension. Rather, opposer will be deemed to have waived the suspension of the running of its extension, and the opposition will be deemed timely (except that if, prior to the filing of the opposition, the Commissioner restored jurisdiction over the subject application to the Examining Attorney, the opposition cannot be entertained by the Board--see TBMP §§213, 215, 307.06, and 307.07). If, after being informed of the outcome of the request to amend or letter of protest, opposer is no longer interested in opposing, opposer may request that the opposition not be instituted (or, if already instituted, that the institution be vacated), and that the opposition fee be refunded. See TBMP §212.04.

OLD EDITION

307.06 Effect of Restoration of Jurisdiction

When an Examining Attorney's request for jurisdiction is granted by the Commissioner during the thirty days after publication of the involved mark for opposition, or during an extension of time to oppose the involved application, the application is no longer subject to the filing of a new opposition, and the restoration of jurisdiction serves to stay the running of the potential opposer's extension of time for opposing.

Any opposition filed after the restoration of jurisdiction will be rejected by the Board. No proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded. See TBMP §213. However, in those cases where (1) jurisdiction is restored during the thirty days after publication of the mark for opposition, and (2) the Examining Attorney subsequently approves the application, the mark will be republished in order to afford potential opposers a full opposition period. In those cases where (1) jurisdiction is restored during an extension of time to oppose, (2) the Examining Attorney subsequently approves the application, and (3) the mark is not republished, the Board will reset potential opposer's time for filing an opposition. See TBMP §213.

Any opposition filed prior to the restoration of jurisdiction will be accepted by the Board, and the Board will suspend proceedings in the opposition pending completion of the ex parte examination. See 37 CFR §2.130.

307.07 Effect of Letter of Protest

The filing of a letter of protest (see TMEP §1116; In re BPJ Enterprises Ltd., 7 USPQ2d 1375 (Comm'r 1988); and In re Pohn, 3 USPQ2d 1700 (Comm'r 1987)) does not serve to stay the time for filing an opposition to the subject mark. See TBMP §215. If a letter of protest is filed after publication, and a potential opposer wishes to preserve its time to oppose pending determination of the letter of protest, it must obtain an extension (or extensions, as necessary) of its time to oppose. For information concerning the handling of requests for extension of time to oppose when there is a pending letter of protest, see TBMP §215.

An opposition may be filed while a letter of protest is pending. However, if a letter of protest is granted, and jurisdiction over the application is restored to the Examining Attorney, no opposition may be filed thereafter; the application is no longer subject to the filing of a new opposition. See TBMP §307.06. If an opposition is filed after restoration of jurisdiction, no proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded.

307.08 Effect of Petition to the Commissioner

If an applicant or potential opposer is dissatisfied with an action of the Board relating to a request for an extension of time to oppose, it may file a petition to the Commissioner for review of the action in question. See 37 CFR §2.146 and TBMP §211.02. However, the filing of a petition from the denial, or from the granting, of a request for an extension of time to oppose does not relieve the potential opposer of the responsibility of filing an opposition, or a request for a further extension of time to oppose, prior to the expiration of the extension which is the subject of the petition. See TBMP §211.02. Cf. 37 CFR §§2.89(g) and 2.146(g).

OLD EDITION

Any opposition, or request for a further extension of time to oppose, filed by the involved potential opposer during the pendency of the petition to the Commissioner, will be held by the Board for appropriate action after determination of the petition. If a petition from the granting of a request for an extension of time to oppose is granted, any opposition or request for further extension of time to oppose filed during or after the extension period in question will be rejected by the Board as untimely. See TBMP §211.02. No proceeding will be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded.

307.09 Effect of Republication

If a mark is republished by order of the Examining Attorney, any opposition filed during the original thirty-day opposition period, or within a granted extension thereof, is considered by the Board to be timely. See TBMP §214. If the change reflected in the republication is one which might have an effect upon the opposition, the Board will notify opposer and applicant, in writing, of the republication, and of the reason therefor; explain that the opposition will be determined on the basis of applicant's correct (or amended) mark, goods or services, disclaimer status, etc.; and allow opposer time to indicate whether it wishes to proceed with the opposition on that basis, or to have its opposition fee refunded, and the opposition not instituted.

However, once the Board learns that a mark which is the subject of a request for an extension of time to oppose has been or will be republished by order of the Examining Attorney, no further extension of the original opposition period will be granted; rather, a potential opposer's time for opposing will recommence with the republication of applicant's mark.

When a mark is republished solely by mistake, the application may not properly be subjected to another opposition period. Accordingly, when it comes to the attention of the Board that an application has been republished by mistake, the Board will not entertain any opposition or request for an extension of time to oppose filed in response to the republication. An opposition filed in response to the inadvertent republication will be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. See TBMP §214.

OLD EDITION

307.10 Effect of Inadvertent Issuance of Registration

Sometimes a registration is issued, inadvertently, from an application which, at the time of such issuance, is the subject of a timely opposition, or an unexpired extension of time to oppose. See TBMP §216.

The Board is without authority, within the context of an opposition proceeding, to cancel an inadvertently issued registration and restore it to application status. Rather, it is the Commissioner who has such authority, and the Commissioner exercises this authority with caution. See In re Trademark Registration of Mc Lachlan Touch Inc., 6 USPQ2d 1395 (Comm'r 1987).

Accordingly, when it comes to the attention of the Board that a registration has issued inadvertently from an application which is the subject of a timely opposition, the Board will forward the registration file to the Commissioner for such action as the Commissioner deems appropriate. The Commissioner, in turn, may either cancel the registration as inadvertently issued, and restore it to application status, or decline to do so.

When a registration issues inadvertently during a timely opposition, the Commissioner normally will cancel the registration as inadvertently issued, and restore it to application status. However, if the opposition has already been finally determined in applicant's favor when the inadvertent issuance is discovered, applicant may either keep the registration, or request that it be cancelled as inadvertently issued, restored to application status, and then reissued.

For information concerning the inadvertent issuance of a registration during an unexpired extension of time to oppose, see TBMP §216.

307.11 Effect of Abandonment of Application

An application which has been abandoned is no longer subject to the filing of a new opposition. Any opposition filed on or after the filing date of the abandonment will be returned by the Board to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. See Societe des

OLD EDITION

Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992), and In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§218 and 602.01.

If it comes to the attention of the Board, after the filing of an opposition, that the opposed application was abandoned, prior to its publication for opposition, for failure of the applicant to respond to an Office action issued by the Trademark Examining Attorney, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to revive under 37 CFR §2.66, and the petition is granted. If a prior abandonment for failure to timely respond comes to the attention of the Board at a time reasonably contemporaneous with the filing of the opposition, and the application is not revived, the opposition will not be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded. If the prior abandonment comes to the attention of the Board at a later stage in the opposition, and the application is not revived, the opposition will be dismissed without prejudice. See Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992).

After the commencement of an opposition, if applicant files an express abandonment of its application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. See 37 CFR §2.135. However, if an applicant files an abandonment after the commencement of an opposition, but before applicant has been notified thereof by the Board, applicant will be given an opportunity to obtain the written consent of every adverse party, or to withdraw the abandonment and litigate the proceeding, failing which judgment will be entered against applicant. See In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§218 and 602.01.

If an opposition and an unconsented abandonment of the opposed application are filed on the same day, the abandonment (unless specifically made with prejudice) is without prejudice to applicant; the opposition will be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. See In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§218 and 307.11.

For further information concerning abandonment of an opposed application during the opposition, see TBMP §602.01.

OLD EDITION

308 Time for Filing Petition to Cancel

15 U.S.C. §1064 A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this Act.

(2) Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 of subsection (a), (b), or (c) of section 2 for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act.

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the cetification mark for purposes other than to certify, or (D)

OLD EDITION

discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required.

15 U.S.C. §1092 Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. The Commissioner shall refer such application to the Trademark Trial and Appeal Board which shall give notice thereof to the registrant. If it is found after a hearing before the Board that the registrant is not entitled to registration, or that the mark has been abandoned, the registration shall be cancelled by the Commissioner. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

37 CFR §2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's attorney or other authorized representative. The petition may be filed at any time in the case of registrations on the Supplemental Register or under the Act of 1920, or registrations under the Act of 1881 or the Act of 1905 which have not been published under section 12(c) of the Act, or on any ground specified in section 14(c) or (e) of the Act. In all other cases the petition and the required fee must be filed within five years from the date of registration of the mark under the Act or from the date of publication under section 12(c) of the Act.

OLD EDITION

308.01 Petition That May Be Filed At Any Time After Registration

A petition to cancel a registration may be filed at any time in the case of a registration issued on the Supplemental Register under the Act of 1946, 15 U.S.C. §1051 et seq., or under the Act of 1920, or a registration issued under the

Act of 1881 or the Act of 1905 which has not been published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c). See Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, and 37 CFR §2.111(b).

In addition, a petition to cancel any registration may be filed at any time on any ground specified in Section 14(3) or 14(5) of the Act, 15 U.S.C. §1064(3) or 1064(5). See Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, and 37 CFR §2.111(b). See also Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990), and Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990).

308.02 Petition That Must Be Filed Within Certain Time

308.02(a) In General

A petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in Sections 14(3) or 14(5) of the Act, must be filed within five years from the date of the registration of the mark. Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c). See Sections 14(1) and 14(2) of the Act, 15 U.S.C. §§1064(1) and 1064(2), and 37 CFR §2.111(b).

Although a petition to cancel filed after the expiration of the five-year period, in the case of such a Principal Register registration, must recite one of the grounds specified in Section 14(3) or 14(5) of the Act, a petition to cancel filed prior to the expiration of the five-year period may be based upon any ground which could have prevented registration initially. See Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); International Mobile Machines Corp. v. International Telephone and Telegraph Corp., 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); International Order of Job's Daughters v. Lindeburg and Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); and Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

OLD EDITION

The grounds for cancellation which are thus available in these cases for a petition filed within the five-year period, but not thereafter, include, for example (this list is exemplary, not exhaustive):

(1) Section 2(d) of the Act, 15 U.S.C. §1052(d) (i.e., that respondent's mark so resembles a mark registered in the PTO, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the respondent, to cause confusion, or to cause mistake, or to deceive). See Opryland USA Inc. v. The Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Person's Co. v. Christman, supra; Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990); and Liberty Trouser Co. v. Liberty & Co., 222 USPQ 357 (TTAB 1983).

(2) The grounds specified in Section 2(e) of the Act, 15 U.S.C. §1052(e) (i.e., that respondent's mark, when used on or in connection with the goods or services of the respondent, is merely descriptive or deceptively misdescriptive of them, or is primarily geographically descriptive of them, except as indications of regional origin may be registrable under Section 4 of the Act, 15 U.S.C. §1054, or is primarily geographically deceptively misdescriptive of them; and that respondent's mark is primarily merely a surname). See Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Allied Mills, Inc. v. Kal Kan Foods, Inc., 203 USPQ 390 (TTAB 1979); and Food Specialty Co. v. Carnation Co., 170 USPQ 522 (TTAB 1971).

(3) That respondent's design does not function as a trademark, but rather is an essentially functional configuration. See Shakespeare Co. v. Silstar Corp. of America Inc., 9 F.3d 1091, 28 USPQ2d 1765 (4th Cir. 1993), and International Order of Job's Daughters v. Lindeburg and Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984).

(4) That there was no bona fide use of respondent's mark in commerce prior to the filing of the application for its registration. See International Mobile Machines Corp. v. International Telephone and Telegraph Corp., 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); Pennwalt Corp. v. Sentry Chemical Co., 219 USPQ 542 (TTAB 1983); and Bonaventure Associates v. Westin Hotel Co., 218 USPQ 537 (TTAB 1983).

OLD EDITION

(5) That respondent's mark is a mere background design which does not function as a mark separate and apart from the words displayed thereon. See General Foods Corp. v. Ito Yokado Co., Ltd., 219 USPQ 822 (TTAB 1983).

(6) That respondent is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark. See Treadwell's Drifters Inc. v. Marshak, 18 USPQ2d 1318 (TTAB 1990), and Kemin Industries, Inc. v. Watkins Products, Inc., 192 USPQ 327 (TTAB 1976).

(7) That respondent's mark, consisting of a particular color combination applied to its goods, is ornamental and has not become distinctive as an indication of the source of respondent's goods. See Kassnar Imports v. Plastilite Corp., 180 USPQ 156 (TTAB 1973), aff'd, 508 F.2d 824, 184 USPQ 348 (CCPA 1975).

The five-year period specified in Section 14(1) (i.e., "Within five years from the date of the registration of the mark under this Act") includes the fifth anniversary date of the registration. See Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990). Cf. TMEP §§1603.03 and 1605.01. Similarly, the five-year period specified in Section 14(2) ("Within five years from the date of publication under section 12(c) hereof of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905"), includes the fifth anniversary date of the publication under Section 12(c). Cf. Strang Corp. v. Stouffer Corp., supra, and TMEP §§1603.03 and 1605.01.

The certificate of mailing by "Express Mail" procedure described in 37 CFR §1.10 is available for the filing of a petition to cancel, but the certificate of mailing or transmission procedure described in 37 CFR §1.8 is not. See 37 CFR §§1.8(a) and 1.10(a).

OLD EDITION

308.02(b) Sec. 14 Limitation Is Independent of Sec. 15 Affidavit

The Section 14 limitation, after expiration of the five-year period, of the grounds upon which the specified types of Principal Register registrations may be attacked, "is not dependent on the filing of a declaration under Section 15 which provides incontestable rights of use to a limited extent (15 U.S.C. §1065)." (emphasis in original) See Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990). See also Western Worldwide

Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990), and Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990).

308.02(c) Factors Affecting the Five-Year Period

308.02(c)(1) Reliance on Registration By Plaintiff

Section 14 of the Act, 15 U.S.C. §1064, limits, after a five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 et seq., or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. The five-year period runs from the date of the registration of the mark, for a registration issued on the Principal Register under the Act of 1946; and from the date of publication under Section 12(c) of the Act, for registrations issued on the Principal Register under the specified prior acts and published under Section 12(c) of the Act of 1946. See Section 14 of the Act.

However, if an opposer relies upon such a Principal Register registration of its pleaded mark, and the five-year period has not yet expired when the opposition is filed, the limitation does not apply to any counterclaim filed therein for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the opposition tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds upon which a counterclaim may be based. See Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); Arman's Systems, Inc. v. Armand's Subway, Inc., 215 USPQ 1048 (TTAB 1982); UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861 (TTAB 1980); Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan, 165 USPQ 597 (TTAB 1970); and Sunbeam Corp. v. Duro Metal Products Co., 106 USPQ 385 (Comm'r 1955). See also J. Thomas McCarthy, Trademarks and Unfair Competition, §20:17(C), at pages 1064-1065 (2d ed. 1984).

Similarly, the limitation would not apply to a counterclaim to cancel such a Principal Register registration relied upon by the petitioner in a cancellation proceeding, if the five-year period had not yet expired with respect to the registration at the time of the filing of the petition to cancel.

OLD EDITION

308.02(c)(2) Amendment of Registration

Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 et seq., or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. See Section 14 of the Act.

Ordinarily, the five-year period runs from the date of the registration of the mark, for a registration issued on the Principal Register under the Act of 1946; and from the date of publication under Section 12(c) of the Act, for registrations issued on the Principal Register under the specified prior acts and published under Section 12(c) of the Act of 1946. See Section 14 of the Act, 15 U.S.C. §1064.

However, when such a Principal Register registration has been amended, the registration is subject to attack under Section 14 of the Act, to the extent that the amendment of the registration has in any way enlarged registrant's rights, as though the registration had issued on the date of the amendment. That is, even though the Section 14 five-year period following issuance of the registration, or publication under Section 12(c), may have expired, if a petition to cancel the registration is filed within the five years following the amendment of the registration, the petition is not limited to Section 14(3) or 14(5) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the five years after the amendment, "the modified registration may be challenged in a cancellation proceeding as long as petitioner states grounds" (not limited to Section 14(3) or 14(5) grounds) "for the cancellation indicating how he believes he is or will be damaged by the modified registration." See Stanspec Co. v. American Chain & Cable Company, Inc., 531 F.2d 563, 189 USPQ 420, 423 (CCPA 1976). See also Continental Gummi-Werke AG v. Continental Seal Corp., 222 USPQ 822 (TTAB 1984).

OLD EDITION

308.03 Premature Petition to Cancel

Sections 14 and 24 of the Act, 15 U.S.C. §§1064 and 1092, provide for the filing of a petition to cancel "a registration of a mark." Until a registration actually issues, there is no registration.

Thus, if a petition to cancel a registration is filed prior to the issuance of the registration, it is premature, and will be rejected by the Board, even if the registration has issued by the time of the Board's action. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. Petitioner's remedy lies in the filing of a new petition to cancel after the registration has issued.

308.04 Late Petition to Cancel

A petition to cancel a registration issued on the Principal Register under the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of the registration of the mark. Similarly, a petition to cancel a registration issued on the Principal Register under the Act of 1881 or the Act of 1905, and published under the provisions of Section 12(c) of the Act of 1946, on a ground not specified in Section 14(3) or 14(5) of the Act, must be filed within five years from the date of publication under Section 12(c). See Section 14 of the Act, 15 U.S.C. §1064, and 37 CFR §2.111(b).

If a petition to cancel one of these Principal Register registrations is filed after the expiration of the five-year period, and does not plead one or more of the grounds specified in Section 14(3) or 14(5) of the Act, the petition is late, and will be rejected by the Board. No proceeding will be instituted; rather, the petition papers will be returned, and any submitted petition fee will be refunded. However, the rejection of the petition is without prejudice to petitioner's right to file, at any time thereafter, a new petition to cancel the registration, and to plead therein one or more of the grounds specified in Section 14(3) or 14(5).

OLD EDITION

309 Fee for Filing Opposition

309.01 In General

15 U.S.C. §1063(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office....

37 CFR §2.101(d)(1) The opposition must be accompanied by the required fee for each party joined as opposer for each class in the application for which registration is opposed (see §2.6(1)). If no fee, or a fee insufficient to pay for one person to oppose the registration of a mark in at least one class, is submitted within thirty days after publication of the mark to be opposed or within an extension of time for filing an opposition, the opposition will not be refused if the required fee(s) is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

(2) If the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for an opposition against all of the classes in the application, and the particular class or classes against which the opposition is filed are not specified, the Office will issue a written notice allowing opposer until a set time in which to submit the required fee(s) or to specify the class or classes opposed. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the opposition will be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which the fees submitted are sufficient to pay the fee due for each class.

(3) If persons are joined as party opposers, and the fees submitted are sufficient to pay for one person to oppose registration in at least one class but are insufficient for each named party opposer, the Office will issue a written notice allowing the named party opposers until a set time in which to submit the required fee(s) or to specify the opposer(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party opposer and additional parties will be deemed to be party opposers to the extent that the fees submitted are sufficient to pay the fee due for each party opposer. If persons are joined as party opposers against the registration of a mark in more than one class, the fees submitted are insufficient, and no specification of opposers and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named opposer against as many of the classes in the application as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the opposition against the classes in the application in ascending order.

The rules governing opposition fees are specified in 37 CFR §§2.101(d)(1)-(d)(3). The amount of the required fee is specified in 37 CFR §2.6(a)(17). For information concerning how to pay fees, see 37 CFR §§1.22-1.25, and TBMP

OLD EDITION

§118. For information concerning fee refunds, see 37 CFR §1.26, and TBMP §119.

309.02 Insufficient Fee

The required fee for filing an opposition should be submitted with the opposition. However, if no fee, or an insufficient fee, is submitted within thirty days after publication of the mark to be opposed, or within an extension of time to oppose, the defect may be cured as specified in 37 CFR §§2.101(d)(1)-(d)(3).

310 Fee for Filing Petition to Cancel

310.01 In General

15 U.S.C. §1064 A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905....

15 U.S.C. §1092 Marks for the supplemental register shall not be published for or be subject to opposition, but shall be published on registration in the Official Gazette of the Patent and Trademark Office. Whenever any person believes that he is or will be damaged by the registration of a mark on this register he may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Commissioner to cancel such registration. ...

37 CFR §2.111(c)(1) The petition must be accompanied by the required fee for each class in the registration for which cancellation is sought (see §§2.6(1) and 2.85(e)). If the fees submitted are insufficient for a cancellation against all of the classes in the registration, and the particular class or classes against which the cancellation is filed are not specified, the Office will issue a written notice allowing petitioner until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the class or classes sought to be cancelled. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the cancellation will

OLD EDITION

be presumed to be against the class or classes in ascending order, beginning with the lowest numbered class, and including the number of classes in the registration for which the fees submitted are sufficient to pay the fee due for each class.

(2) If persons are joined as party petitioners, each must submit a fee for each class for which cancellation is sought. If the fees submitted are insufficient for each named party petitioner, the Office will issue a written notice allowing the named party petitioners until a set time in which to submit the required fee(s) (provided that the five-year period, if applicable, has not expired) or to specify the petitioner(s) to which the submitted fees apply. If the required fee(s) is not submitted, or the specification made, within the time set in the notice, the first named party will be presumed to be the party petitioner and additional parties will be deemed to be party petitioners to the extent that the fees submitted are sufficient to pay the fee due for each party petitioner. If persons are joined as party petitioners against a registration sought to be cancelled in more than one class, the fees submitted are insufficient, and no specification of parties and classes is made within the time set in the written notice issued by the Office, the fees submitted will be applied first on behalf of the first-named petitioner against as many of the classes in the registration as the submitted fees are sufficient to pay, and any excess will be applied on behalf of the second-named party to the petition against the classes in the registration in ascending order.

(3) The filing date of the petition is the date of receipt in the Patent and Trademark Office of the petition together with the required fee. If the amount of the fee filed with the petition is sufficient to pay for at least one person to petition to cancel one class of goods or services but is less than the required amount because multiple party petitioners and/or multiple classes in the registration for which cancellation is sought are involved, and the required additional amount of the fee is filed within the time limit set in the notification of the defect by the Office, the filing date of the petition with respect to the additional party petitioners and/or classes is the date of receipt in the Patent and Trademark Office of the additional fees.

The rules governing cancellation fees are specified in 37 CFR §§2.111(c)(1)-(c)(3). The amount of the required fee is specified in 37 CFR §2.6(a)(16). The required fee for a petition to cancel must be submitted with the petition; the effective filing date of a petition to cancel (and, hence, the date of commencement of the cancellation proceeding) is the date of receipt in the PTO of both the petition to cancel and the required fee. See 37 CFR §§2.111(a),

OLD EDITION

2.111(c)(1), and 2.111(c)(3); Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); and TBMP §310.04.

For information concerning how to pay fees, see 37 CFR §§1.22-1.25, and TBMP §118. For information concerning fee refunds, see 37 CFR §1.26, and TBMP §119.

310.02 Fee for Counterclaim

A counterclaim for cancellation of a plaintiff's registration is the legal equivalent of a separate petition to cancel. The required filing fee must be paid when a petition to cancel takes the form of a counterclaim, just as it must be paid when a petition to cancel takes the form of a separate proceeding. See 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii); Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); Sunway Fruit Products, Inc. v. Productos Caseros, S. A., 130 USPQ 33 (Comm'r 1960); Jet-Pak, Inc. v. United States Plywood Corp., 125 USPQ 491 (Comm'r 1960); Jet-Pak, Inc. v. United States Plywood Corp., 124 USPQ 385 (TTAB 1960); and McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959).

OLD EDITION

310.03 Petition Filed by Federal Trade Commission

There is no fee for a petition filed by the Federal Trade Commission to cancel a registration on the Principal Register. See Section 14 of the Act, 15 U.S.C. §1064. Cf. TBMP §303.04.

310.04 Insufficient Fee

The required fee for a petition to cancel must be submitted with the petition. See 37 CFR §2.111(c)(1). The filing date of a petition to cancel is the date of receipt in the PTO of the petition and the required fee. See 37 CFR §2.111(c)(3), and Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450,

149 USPQ 518 (CCPA 1966). Moreover, Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which a Principal Register registration issued under the Act of 1946, 15 U.S.C. §1051 et seq., or issued under certain prior acts and published under Section 12(c) of the Act of 1946, 15 U.S.C. §1062(c), may be cancelled. See Section 14 of the Act, and TBMP §308.02(a). If a petition to cancel such a registration is submitted to the PTO prior to the expiration of the five-year period, but the required fee is not submitted until after the expiration thereof, the filing date of the petition is the date of receipt in the PTO of the required fee, and the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after expiration of the five-year period. See Section 14 of the Act; Williamson-Dickie Manufacturing Co. v. Mann Overall Company, supra; and TBMP §308.04.

Except to the extent that the five-year period of Section 14 is applicable in a particular case, there is no time limit for the filing of a petition to cancel an issued registration. Thus, if no fee, or an insufficient fee, is submitted with a petition to cancel, the defect may be cured as specified in 37 CFR §§2.111(c)(1)-(c)(3), provided that the five-year period, if applicable, has not expired, or, if expired, that the petition recites a ground permitted after the expiration of the five-year period. The petition will not be rejected (except to the extent that it is barred by the five-year limit) if the required fee is submitted to the PTO within the time limit set in the Board's written notification of the defect.

The responsibility for filing proper documents and fees rests with the party filing them. Although the Board makes every effort to notify plaintiffs of insufficiencies in fees before the expiration of any applicable statutory deadline, so that the insufficiencies may be corrected prior to the deadline, the Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time. Cf. In re Holland America Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984), and In re Application Papers Filed November 12, 1965, 152 USPQ 194 (Comm'r 1966).

311 Scope of Opposition and Petition to Cancel

15 U.S.C. 1068 In such proceedings the Commissioner may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or

OLD EDITION

may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings....

37 CFR §2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. ...

37 CFR §2.133(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.

37 CFR §2.99(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.

37 CFR §2.133(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.

The Board is an administrative tribunal which is empowered to determine only the right to register; it may not determine the right to use, or broader questions of infringement or unfair competition. See TBMP §102.01. Thus, a plaintiff in a proceeding before the Board can attack only the defendant's right to register.

In an opposition, the registration sought by an applicant may be opposed in whole, or in part. In the latter case, the opposer may oppose registration only, for example, as to some of the goods or services listed in the application, or only in the absence of a particular restriction (described in sufficient detail to give the applicant fair notice thereof) to the goods or services. See Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §2.133(b); Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 34 USPQ2d 1266 (TTAB 1994), and Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985). Cf. 37 CFR §2.111(b).

OLD EDITION

Similarly, a petitioner may seek to cancel a registration in whole, or in part. In the latter case, the petitioner may seek to cancel the registration only, for example, as to some of the goods or services listed therein, or only to the extent of restricting the goods or services in a particular manner (described in sufficient detail to give the respondent fair notice thereof). See Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §§2.111(b) and 2.133(b); and Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 34 USPQ2d 1266 (TTAB 1994).

However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. See 37 CFR §§2.99(h) and 2.133(c), and Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990).

As in the case of any other claim, a claim for partial opposition, or partial cancellation, ordinarily should be asserted prior to trial in order to give the defendant fair notice thereof; any claim which is not pleaded in the complaint, as originally filed or as amended (or deemed amended) pursuant to FRCP 15(a) or 15(b), will not be entertained by the Board. See Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 34 USPQ2d 1266 (TTAB 1994), and Reflange v. R-Con International, 17 USPQ2d 1125 (TTAB 1990). See also TBMP §§312.03, 321, and 507.

OLD EDITION

312 Form of Opposition and Petition to Cancel

312.01 In General

37 CFR §2.101(b) Any entity which believes that it would be damaged by the registration of a mark on the Principal Register may oppose the same by filing an opposition, which should be addressed to the Trademark Trial and Appeal Board. The opposition need not be verified, and may be signed by the opposer or the opposer's attorney or other authorized representative.

37 CFR §2.111(b) Any entity which believes that it is or will be damaged by a registration may file a petition, which should be addressed to the Trademark Trial and Appeal Board, to cancel the registration in whole or in part. The petition need not be verified, and may be signed by the petitioner or the petitioner's

37 CFR §2.116(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

37 CFR §2.119(e) Every paper filed in an inter partes proceeding, and every request for an extension of time to file an opposition, must be signed by the party filing it, or by the party's attorney or other authorized representative, but an unsigned paper will not be refused consideration if a signed copy is submitted to the Patent and Trademark Office within the time limit set in the notification of this defect by the Office.

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding. See 37 CFR §2.116(c). For purposes of simplicity, the term "complaint" is often used hereafter to refer to a notice of opposition or a petition to cancel.

The complaint should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application or registration which is the subject of the complaint, the name of the proceeding (i.e., "ABC Corporation v. XYZ Company"), the wording "Opposition No. _____" or "Cancellation No. _____" (the Board will insert, in the blank space, the number assigned to the proceeding), and a title describing the nature of the paper (i.e., "Notice of Opposition" or "Petition to Cancel"). The complaint should also include plaintiff's name, entity type (i.e., individual, partnership, corporation, association, etc.), and business address; the names of the partners, if the plaintiff is a partnership, or the state or country of incorporation, if the plaintiff is a corporation; a pleading of the substance (i.e., standing and grounds) of the complaint; a signature; and a description of the capacity in which the signing individual signs.

In addition, a petition to cancel should indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. See 37 CFR §2.112(a). Petitioner may comply with this requirement simply by furnishing the Board with whatever information it has concerning the name and address of the current owner of the registration; a special investigation made solely for purposes of complying with the rule is not necessary. The purpose of the requirement is to provide the Board with whatever information petitioner may have concerning the name and address of the current owner of the registration, so that the Board can notify that party of the filing of the petition. Cf. TBMP

OLD EDITION

§§315.01 and 315.02. If petitioner has no information concerning the name and address of the current owner of the registration, petitioner may simply use the name and address of registrant stated on the registration certificate.

The complaint need not be verified, and it may be signed by the plaintiff or by the plaintiff's attorney or other authorized representative. See 37 CFR §§2.101(b) and 2.111(b), and TBMP §106.02. If a plaintiff signing for itself is a partnership, the signature must be made by a partner. If a plaintiff signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the plaintiff who has authority to sign for the plaintiff and whose title is given. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as plaintiff, if plaintiff is an individual; as counsel for plaintiff; as a partner of plaintiff, if plaintiff is a partnership; as an officer of plaintiff identified by title, if plaintiff is a corporation; etc.).

Although a complaint must be signed, an unsigned complaint will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the Board's letter notifying plaintiff of this defect. See 37 CFR §2.119(e) and TBMP §106.02. However, Section 14 of the Act, 15 U.S.C. §1064, limits, after a specified five-year period, the grounds upon which certain Principal Register registrations may be cancelled. See Section 14 of the Act; 37 CFR §2.111(b); and TBMP §308.02(a). If an unsigned petition to cancel such a registration is filed prior to the expiration of the five-year period, but a signed copy thereof is not filed until after the expiration of the period, the petition can be entertained by the Board only to the extent that it pleads a ground for cancellation permitted after the expiration of the five-year period. Cf. Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); Texas Instruments Inc. v. Conklin Instrument Corp., 161 USPQ 740 (TTAB 1969); TBMP section 310.04; and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 329 (1985). Although the Board makes every effort to notify petitioners of unsigned complaints before the expiration of any applicable statutory deadline, so that the informality may be corrected prior to the deadline, the Board has no obligation to do so, and cannot assume the burden of discovering filing errors within any specified time. Cf. In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); In re L.R. Sport Inc., 25 USPQ2d 1533 (Comm'r 1992); and In re Application Papers Filed November 12, 1965, 152 USPQ 194 (Comm'r 1966).

OLD EDITION

The complaint, and any exhibits thereto, must be filed in duplicate. See 37 CFR §§2.104(a) and 2.112(a). The complaint need not be served by the plaintiff upon the defendent. . Rather, the duplicate copy of the complaint, and any exhibits thereto, will be forwarded to the defendant by the Board itself. See 37 CFR §§2.105, 2.113, and 2.119(a).

While a complaint must be filed "in duplicate," there is no requirement that one of the duplicates filed be the original. The duplicates may consist either of the original and one copy, or of two copies. However, all copies must be legible, and on good quality paper. See TBMP §106.03.

The Board prefers that complaints be submitted in typewritten or printed form, double spaced. A complaint may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. See TBMP §106.03.

OLD EDITION

312.02 Suggested Formats for Complaints

The PTO has no printed form for use in filing a notice of opposition or petition for cancellation. However, as an aid to litigants, the PTO has prepared suggested formats for these complaints. A complaint need not follow the suggested format, as long as it includes the necessary information.

312.02(a) Suggested Format for Notice of Opposition

The suggested format for a notice of opposition is shown below:

Format for Notice of Opposition

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No.....
Filed.....
For the mark.....

Published in the Official Gazette
on.....
(Date)

.....
(Name of opposer)
v.
.....
(Name of applicant)

Opposition No. .....
(To be inserted by Patent & Trademark Office)

NOTICE OF OPPOSITION

(State opposer's name, address, and entity information)(1)

.....
(Name of individual as opposer, and business trade name, if any)
.....
(Business address)
OR.....
(Name of partnership as opposer)
.....
(Names of partners)
.....
(Business address of partnership)
OR.....
(Name of corporation as opposer)
.....
(State or country of incorporation)
.....
(Business address of corporation)

The above-identified opposer believes that it/he/she will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.(2)

The grounds for opposition are as follows:(3)

By.....
(Signature)(4)

OLD EDITION

.....
(Identification of person signing)(5)

FOOTNOTES

(1) If opposer is an individual, state the opposer's name, business trade name, if any, and business address. If opposer is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If opposer is a corporation, state the name of the corporation, the state (or country, if opposer is a foreign corporation) of incorporation, and the business address of the corporation. If opposer is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

(2) The required fee must be submitted for each party joined as opposer for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.

(3) Set forth a short and plain statement here showing why the opposer believes it/he/she would be damaged by the registration of the opposed mark, and state the grounds for opposing.

(4) The opposition need not be verified, and may be signed by the opposer or by the opposer's attorney or other authorized representative. If an opposer signing for itself is a partnership, the signature must be made by a partner; if an opposer signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for opposer, opposer (if opposer is an individual), partner of opposer (if opposer is a partnership), officer of opposer identified by title (if opposer is a corporation), etc.

OLD EDITION

REPRESENTATION INFORMATION

If the opposer is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the opposer wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

312.02(b) Suggested Format for Petition to Cancel

The suggested format for a petition to cancel is shown below:

Format for Petition to Cancel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration
No.....
For the mark.....
Date
registered.....

.....
(Name of petitioner)
v.
.....
(Name of registrant)

Cancellation No. .....
(To be inserted by Patent & Trademark Office)

PETITION TO CANCEL

(State petitioner's name, address, and entity information)(1)

.....
(Name of individual as petitioner, and business trade name, if any)
.....
(Business address)
OR.....
(Name of partnership as petitioner)
.....
(Names of partners)
.....
(Business address of partnership)
OR.....
(Name of corporation as petitioner)
.....
(State or country of incorporation)

OLD EDITION

.....
(Business address of corporation)

To the best of petitioner's knowledge, the name and address of the current owner of the registration are.....
.....

The above-identified petitioner believes that it/he/she will be damaged by the above-identified registration, and hereby petitions to cancel the same.(2)

The grounds for cancellation are as follows:(3)

By.....
(Signature)(4)
.....
(Identification of person signing)(5)

OLD EDITION

FOOTNOTES

(1) If petitioner is an individual, state the petitioner's name, business trade name, if any, and business address. If petitioner is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If petitioner is a corporation, state the name of the corporation, the state (or country, if petitioner is a foreign corporation) of incorporation, and the business address of the corporation. If petitioner is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

(2) The required fee must be submitted for each party joined as petitioner for each class sought to be cancelled, and if cancellation is sought for fewer than the total number of classes in the registration, the classes sought to be cancelled should be specified.

(3) Set forth a short and plain statement here showing why the petitioner believes it/he/she would be damaged by the registration, and state the grounds for cancellation.

(4) The petition need not be verified, and may be signed by the petitioner or by the petitioner's attorney or other authorized representative. If a petitioner signing for itself is a partnership, the signature must be made by a partner; if a petitioner signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for petitioner, petitioner (if petitioner is an individual), partner of petitioner (if petitioner is a partnership), officer of petitioner identified by title (if petitioner is a corporation), etc.

REPRESENTATION INFORMATION

If the petitioner is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the petitioner wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

OLD EDITION

312.03 Pleading Substance of Complaint

37 CFR §2.104(a) The opposition must set forth a short and plain statement showing why the opposer believes it would be damaged by the registration of the opposed mark and state the grounds for opposition. ...

37 CFR §2.112(a) The petition to cancel must set forth a short and plain statement showing why the petitioner believes it is or will be damaged by the registration, state the grounds for cancellation, and indicate, to the best of petitioner's knowledge, the name and address of the current owner of the registration. ...

A notice of opposition must include (1) a short and plain statement of the reason(s) why opposer believes it would be damaged by the registration of the opposed mark (i.e., opposer's standing to maintain the proceeding (see TBMP §303.03)), and (2) a short and plain statement of one or more grounds for opposition. See 37 CFR §2.104(a); Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752 (TTAB 1985); and Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 (TTAB 1985). Cf. FRCP 8(a). The grounds upon which an application for registration of a mark may be opposed include (but are not limited to) all of the grounds listed in TBMP §§308.01 and 308.02(a) as grounds for cancellation. For a further discussion of the grounds for opposition, see J. Thomas McCarthy, Trademarks and Unfair Competition, §§20.03-20.07 (3rd ed. 1994).

Similarly, a petition to cancel must include (1) a short and plain statement of the reason(s) why petitioner believes it is or will be damaged by the registration sought to be cancelled (i.e., petitioner's standing to maintain the proceeding (see TBMP §303.03)), and (2) a short and plain statement of one or more grounds for cancellation. See 37 CFR §2.112(a); Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984); Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); and American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992). Cf. FRCP 8(a). For a discussion of the grounds upon which the registration of a mark may be cancelled, see TBMP §§308.01 and 308.02(a). See also J. Thomas McCarthy, Trademarks and Unfair Competition, §§20.14-20.15 (3rd ed. 1994).

The elements of a claim should be stated simply, concisely, and directly. See FRCP 8(e)(1). However, the pleading should include enough detail to give the defendant fair notice of the basis for each claim. See McDonnell Douglas Corp. v. National Data Corp., 228 USPQ 45 (TTAB 1985). See also Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988), and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

All averments should be made in numbered paragraphs, the contents of each of which should be limited as far as practicable to a statement of a single set of circumstances. See FRCP 10(b), and Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc., 180 USPQ 794 (TTAB 1974). Each claim founded upon a separate transaction or occurrence should be stated in a separate count whenever a separation would facilitate the clear presentation of the matters pleaded. See FRCP 10(b). A paragraph may be referred to by number in all succeeding paragraphs, and statements in the complaint may be adopted by reference in a different part of the complaint. See FRCP 10(b) and (c).

A plaintiff may state as many separate claims as it has, regardless of consistency; a plaintiff may also set forth two or more statements of a claim alternately or hypothetically, either in one count or in separate counts. See FRCP 8(e)(2); PacTel Teletrac v. T.A.B. Systems, 32 USPQ2d 1668 (TTAB 1994); Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987); Home Juice Co. v. Runglin Cos., 231 USPQ 897 (TTAB 1986); Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975); John T. Clark Co. v. Colgate-Palmolive Co.,

OLD EDITION

176 USPQ 93 (TTAB 1972); Rimmel, Ltd. v. Romel Cosmetics, Inc., 172 USPQ 186 (TTAB 1971); and Revco, D.S., Inc. v. Armour-Dial, Inc., 170 USPQ 48 (TTAB 1971).

A plaintiff may plead likelihood of confusion hypothetically by asserting, for example, that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then plaintiff will be damaged by the registration of defendant's mark (i.e., has standing to maintain the proceeding--see TBMP §303.03). See Revco, D.S., Inc. v. Armour-Dial, Inc., supra. Of course, in order to state a claim upon which relief can be granted, a hypothetical pleading of likelihood of confusion must be coupled with a pleading of one or more grounds for oppostion or cancellation, such as, that defendant's mark has been abandoned; that plaintiff has priority of use (here, the hypothetical pleading of likelihood of confusion serves both as a pleading of plaintiff's standing and as part of the pleading of a ground under Section 2(d) of the Act, 15 U.S.C. §1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Section 2(d) might assert, for example, that if, as the Trademark Examining Attorney (or the defendant) contends, plaintiff's mark so resembles defendant's mark as to be likely, when applied to the goods and/or services of the plaintiff, to cause confusion, then the registration sought by defendant should be refused (or defendant's registration should be cancelled) because plaintiff has priority of use.

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is (are) also insufficient. See FRCP 8(e)(2).

Evidentiary matters (such as, for example, lists of publications or articles in which a term sought to be registered by an applicant is alleged to be used descriptively) should not be pleaded in a complaint. They are matters for proof, not for pleading. See McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959).

In inter partes proceedings before the Board, as in civil cases before the United States district courts, all pleadings are so construed as to do substantial justice. See 37 CFR §2.116(a); FRCP 8(f); and Scotch Whiskey Ass'n v. United States Distilled Products Co., 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991).

OLD EDITION

313 Exhibits to Pleadings

37 CFR §2.122(c) Exhibits to pleadings. Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.

37 CFR §2.122(d) Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...

A plaintiff or defendant may attach exhibits to its pleading if it so desires. However, with one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. See 37 CFR §2.122(c); Republic Steel Co. v. M.P.H. Manufacturing Corp., 312 F.2d 940, 136 USPQ 447 (CCPA 1963); Home Juice Co. v. Runglin Companies Inc., 231 USPQ 897 (TTAB 1986); Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 (TTAB 1985); Syosset Laboratories, Inc. v. TI Pharmaceuticals, 216 USPQ 330 (TTAB 1982); Cities Service Co. v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978); A-1-A Corp. v. The Gillette Co., 199 USPQ 118 (TTAB 1978); and Permatex Co. v. California Tube Products, Inc., 175 USPQ 764 (TTAB 1972).

The one exception to the foregoing rule is a current status and title copy, prepared by the Patent and Trademark Office, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part of the record without any further action by plaintiff. See 37 CFR §§2.122(c) and 2.122(d)(1), and TBMP §703.02(a).

314 FRCP 11 Applicable

OLD EDITION

Rule 11 of the Federal Rules of Civil Procedure provides, in part, as follows:

> (b) Representations to Court.
> By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances,--
>
> > (1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;
> > (2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
> > (3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
> > (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.
>
> (c) Sanctions.
> If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the attorneys, law firms, or parties that have violated subdivision (b) or are responsible for the violation.

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. See TBMP §529.01, and authorities cited therein.

For information concerning the imposition of FRCP 11 sanctions by the Board, see TBMP §529.01.

OLD EDITION

315 Notification of Proceeding

315.01 In General

37 CFR §2.105 Notification of opposition proceeding[s].
When an opposition in proper form has been filed and the correct fee(s) have been submitted, a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the application involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the opposer, if any, or to the opposer. The duplicate copy of the opposition and exhibits shall be forwarded with a copy of the notification to the attorney or other authorized representative of the applicant, if any, or to the applicant.

37 CFR §2.113 Notification of cancellation proceeding.
When a petition for cancellation has been filed in proper form (see §§2.111 and 2.112), a notification shall be prepared by the Trademark Trial and Appeal Board, which shall identify the title and number of the proceeding and the registration or registrations involved and shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed. A copy of the notification shall be forwarded to the attorney or other authorized representative of the petitioner, if any, or to the petitioner. The duplicate copy of the petition for cancellation and exhibits shall be forwarded with a copy of the notification to the respondent (see §2.118), who shall be the party shown by the records of the Patent and Trademark Office to be the current owner of the registration or registrations sought to be cancelled, except that the Board, in its discretion, may join or substitute as respondent a party who makes a showing of a current ownership interest in such registration or registrations. When the party identified by the petitioner, pursuant to §2.112(a), as the current owner of the registration or registrations is not the record owner thereof, a courtesy copy of the petition for cancellation shall be forwarded with a copy of the notification to the alleged current owner, which may file a motion to be joined or substituted as respondent. If the petition is found to be defective as to form, the party filing the petition shall be so advised and allowed a reasonable time for correcting the informality.

OLD EDITION

When a timely opposition in proper form has been filed, and the required fee has been submitted, the Board obtains the file of the opposed application and sets up an opposition proceeding file (see TBMP §120.01). See 37 CFR §2.105. The defendant in the opposition is the party shown by the records of the PTO to be the current owner of the opposed application, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the application. See TBMP §512. Cf. 37 CFR §2.113.

When a timely petition to cancel in proper form, together with the required fee, has been filed (see §§2.111(a) and 2.113), the Board obtains the file of the registration sought to be cancelled and checks the assignment records of the PTO to determine whether there is any recorded assignment of the registration, and, if so, the identity of the assignee. After the title search has been completed, the cancellation proceeding file is set up. See TBMP §120.01. The defendant in the cancellation proceeding is the party shown by the records of the PTO to be the current owner of the registration sought to be cancelled, except that the Board, in its discretion, may join or substitute as defendant a party which makes a showing of a current ownership interest in the registration. See 37 CFR §2.113, and Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976). Cf. TBMP §512.

Next, the Board prepares a letter wherein it, inter alia, notifies the defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. The notification letter includes the identification information described in 37 CFR §2.105, for an opposition, or in 37 CFR §2.113, for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice; and specifies the due date for the filing of defendant's answer to the complaint.

One copy of the notification letter is mailed to the attorney or other authorized representative of the plaintiff, or, if the plaintiff is representing itself, to the plaintiff itself. In an opposition, a second copy of the letter is mailed, together with a copy of the notice of opposition and any exhibits thereto, to the attorney or other authorized representative of the applicant, or, if the applicant is representing itself, to the applicant itself. See 37 CFR §2.105, and Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993). In a cancellation, a second copy of the notification letter is mailed, together with a copy of the petition to cancel and any exhibits thereto, to the respondent itself (even if there

OLD EDITION

is an attorney or other authorized representative of record in the registration). See 37 CFR §2.113.

The reason why the complaint and notification letter are sent to the defendant's attorney or other authorized representative, if any, in an opposition, but are always sent to the defendant itself in a cancellation, is that any appearance or power of attorney (or designation of other authorized representative) of record in an application file at the time of the commencement of an opposition is considered to be effective for purposes of the proceeding, whereas any representation which may be of record in a registration file at the time of the commencement of a cancellation is not considered to be effective for purposes of the proceeding. Typically, a power of attorney in an application appoints the named attorney "to prosecute this application to register, to transact all business in the Patent and Trademark Office in connection therewith, and to receive the certificate of registration." That is, the power extends only up to the issuance and receipt of a registration. As a practical matter, the representation in an application file usually is, of necessity, current and active, whereas often the attorney or other authorized representative of record in a registration has not taken any action on behalf of the registrant for some years, no longer represents registrant, does not know where registrant is currently located, is no longer in practice, etc. However, if the Board is unable to locate the registrant for purposes of serving a copy of the complaint and notification letter upon it, and there is of record in the registration an attorney or other authorized representative who has appeared therein on registrant's behalf within the last five years or so, the Board will, if necessary, contact the attorney or other authorized representative and ask for information concerning registrant's current address. See the notice of final rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34891, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 30.

In a cancellation proceeding, if the party identified by the petitioner, pursuant to 37 CFR §2.112(a), as the current owner of the registration sought to be cancelled is not the record owner thereof, the Board will send a courtesy copy of the notification letter, together with a copy of the petition to cancel and any exhibits thereto, to the alleged current owner. If the alleged current owner believes that it is, in fact, the current owner of the registration, and wishes to defend the registration against the petition to cancel, it may file a motion, supported by a showing of its current ownership interest in the registration, to be joined or substituted as respondent. See 37 CFR §2.113 and TBMP §512.

OLD EDITION

315.02 Defendant's Copy of Complaint Returned as Undeliverable

If the applicant in an opposition is not represented by an attorney or other authorized representative, and the applicant's copies of the notice of opposition and notification letter are returned to the Board as undeliverable, the Board will make all reasonable efforts to locate the applicant. However, it is the responsibility of an applicant representing itself to keep the PTO informed of its current address. If the applicant fails to do so, and the Board is unable to locate the applicant, the Board will continue to send correspondence relating to the opposition to applicant's last-known address, and when applicant fails to file an answer to the notice of opposition, the opposition may be decided as in case of default.

If, in a cancellation proceeding, the respondent's copies of the petition to cancel and notification letter are returned to the Board as undeliverable, the Board will send a letter to the petitioner asking the petitioner for information concerning respondent's current address. If the petitioner files a response indicating that the respondent is no longer in business, notice of the filing of the petition to cancel will be published in the Official Gazette, pursuant to 37 CFR §2.118. If the petitioner fails to file a response to the Board's letter, or files a response indicating that it is unable to furnish respondent's current address, the Board will make all reasonable efforts to locate the respondent. See the notice of final rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34891, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 30. If the Board is unable to locate the respondent after reasonable investigation, notice of the filing of the petition to cancel will be published in the Official Gazette. See 37 CFR §2.118.

When notice of the filing of a petition to cancel is published in the Official Gazette, the published notice allows the respondent thirty days from the publication date thereof in which to appear in the cancellation proceeding. If respondent fails to appear within the time allowed, default judgement may be entered against respondent.

For information concerning the procedure followed by the Board in a concurrent use proceeding when a communication sent by the Board to a specified excepted user is returned as undeliverable, see TBMP §1105.

OLD EDITION

316 Time for Filing Answer

316.01 In General

Rules 2.105 and 2.113, 37 CFR §§2.105 and 2.113, provide, in part, that the Board's letter notifying a defendant of the filing of an opposition or petition to cancel "shall designate a time, not less than thirty days from the mailing date of the notification, within which an answer must be filed." A defendant is under no obligation to file an answer to the complaint in an opposition or cancellation proceeding until it receives the Board's notification letter setting the time for filing an answer. See Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993). It is the general practice of the Board to allow the defendant in an opposition or cancellation proceeding 40 days from the mailing date of the notification letter in which to file its answer.

When a timely counterclaim for cancellation is filed, the time for filing an answer thereto is designated in a letter prepared by the Board. Rules 2.106(b)(2)(iii) and 2.114(b)(2)(iii), 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii), provide, in part, that the time allowed will be "not less than thirty days." It is the general practice of the Board to allow the counterclaim defendant 30 days from the mailing date of the Board's letter in which to file an answer to the counterclaim.

OLD EDITION

316.02 Rule 2.119(c) 5-Day Addition Not Applicable to Deadlines Set by Board

Rule 2.119(c), 37 CFR §2.119(c), provides, in part, that "[w]henever a party is required to take some action within a prescribed period after the service of a paper upon the party by another party and the paper is served by first-class mail, "Express Mail" or overnight courier, 5 days shall be added to the prescribed period." This provision, by its very terms, applies only when a party has to take some action within a prescribed period after the service of a paper upon it by another party (and service of the paper was made in one of three specified ways). It does not apply to an action which must be taken by a party within a time set in a communication from the Board.

Thus, when a Board letter notifying a defendant of the filing of an opposition or petition to cancel allows the defendant 40 days from the mailing date of the notification letter in which to file an answer to the complaint, the answer is due on or before the 40th day, not on the 45th day. Similarly, when the Board allows a counterclaim defendant 30 days from the mailing date of the Board's letter in which to file an answer to the counterclaim, the answer is due on or before the 30th day, not on the 35th day.

316.03 Extension of Time to File Answer

The time for filing an answer may be extended or reopened by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See FRCP 6(b), and TBMP §509.

317 Default

317.01 In General

37 CFR §2.106(a) If no answer is filed within the time set, the opposition may be decided as in case of default.

37 CFR §2.114(a) If no answer is filed within the time set, the petition may be decided as in case of default.

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board may issue a notice of default. The notice states that no answer has been filed; enters notice of default under FRCP 55(a); and allows the defendant 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response which does not show good cause, default judgment may be entered against it. See 37 CFR §§2.106(a) and 2.114(a); FRCP 55(a), 55(b) and 55(c); Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990); Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); and Identicon Corp. v. Williams, 195 USPQ 447 (Comm'r 1977). Cf. TBMP §508.

OLD EDITION

The issue of whether default judgment should be entered against a defendant, for failure to file a timely answer to the complaint, may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its late-filed answer be accepted. However the issue is raised, the standard for determining whether default judgment should be entered against the defendant for its failure to file a timely answer to the complaint is the FRCP 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it. See Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990), and Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc., 21 USPQ2d 1556 (TTAB 1991).

When a defendant which has not yet filed an answer to a complaint files a response to a notice of default, or to a motion for default judgment, the answer normally should be submitted with the response. However, in some cases it may not be necessary for the defendant to submit its answer with the response. Examples include cases where the defendant has not received the copies of the complaint and notification letter sent to it by the Board, or where the parties have settled the case or agreed to an extension of the defendant's time to file an answer.

OLD EDITION

317.02 Setting Aside Notice of Default

If a defendant which has failed to file a timely answer to the complaint responds to a notice of default by filing a satisfactory showing of good cause why default judgment should not be entered against it, the Board will set aside the notice of default. See FRCP 55(c). Similarly, if the defendant files such a showing in response to a motion by the plaintiff for default judgment, or in support of its own motion asking that its late-filed answer be accepted, default judgment will not be entered against it.

Good cause why default judgment should not be entered against a defendant, for failure to file a timely answer to the complaint, is usually found when the defendant shows that (1) the delay in filing an answer was not the result of

willful conduct or gross neglect on the part of the defendant, (2) the plaintiff will not be substantially prejudiced by the delay, and (3) the defendant has a meritorious defense to the action.

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. In exercising that discretion, the Board must be mindful of the fact that it is the policy of the law to decide cases on their merits. Accordingly, the Board is very reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant. Nevertheless, entry of default judgment may be necessary in some cases.

See Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990); Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc., 21 USPQ2d 1556 (TTAB 1991); Thrifty Corp. v. Bomax Enterprises, 228 USPQ 62 (TTAB 1985); Amaturo Group, Inc. v. Greater Media, Inc., 201 USPQ 617 (Comm'r 1978); and Identicon Corp. v. Williams, 195 USPQ 447 (Comm'r 1977). See also Grinnell Corp. v. Grinnell Concrete Pavingstones Inc., 14 USPQ2d 2065 (TTAB 1990). Cf. Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Unicut Corp. v. Unicut, Inc., 222 USPQ 341 (TTAB 1984); Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982); and Regent Baby Products Corp. v. Dundee Mills, Inc., 199 USPQ 571 (TTAB 1978).

OLD EDITION

317.03 Setting Aside Default Judgment

The standard for setting aside default judgment is stricter than the standard for setting aside a notice of default.

A notice of default may be set aside upon a showing of good cause. See FRCP 55(c). However, once default judgment has actually been entered against a defendant pursuant to FRCP 55(b), the judgment may be set aside only in accordance with FRCP 60(b), which governs motions for relief from final judgment. See FRCP 55(c), and 6 Moore's Federal Practice, §55.10 (2d ed. 1985). See also Waifersong Ltd. Inc. v. Classic Music Vending, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992). For information concerning motions under FRCP 60(b) for relief from final judgment, see TBMP §545.

The factors considered in determining a motion to set aside notice of default are also considered in determining a motion for relief from a default judgment entered pursuant to FRCP 55. Compare, for example, Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990), and Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc., 21 USPQ2d 1556 (TTAB 1991) (both of which involved the question whether default judgment should be entered against defendant), with Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991), and Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) (both of which involved the question whether defendant should be granted relief from a default judgment). See also Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d §2692 (1983), at pages 470-471, and Waifersong Ltd. Inc. v. Classic Music Vending, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992).

However, the showing submitted by the defendant is likely to be viewed with less leniency when defendant seeks relief from default judgment than when defendant seeks to show cause why default judgment should not be entered against it. See Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d §2692 (1983), at pages 471-472, and Waifersong Ltd. Inc. v. Classic Music Vending, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992).

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under FRCP 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under FRCP 60(b) for relief from other types of judgments. Compare, for example, Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991), and Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) with Syosset Laboratories, Inc. v. TI Pharmaceuticals, 216 USPQ 330 (TTAB 1982); Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976); and Williams v. Five Platters, Inc., 181 USPQ 409 (TTAB 1974), aff'd, 510 F.2d 963, 184 USPQ 744 (CCPA 1975). See also Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d §2693 (1983), at pages 480-485.

OLD EDITION

318 Form of Answer

318.01 In General

An answer to a notice of opposition or petition to cancel corresponds to an answer to a complaint in a court proceeding. See 37 CFR §2.116(c).

An answer should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by the name (e.g., "ABC Corporation v. XYZ Company") of the proceeding, the proceeding number (e.g., "Opposition No. 56,789" or Cancellation No. 12,345"), and a title describing the nature of the paper (e.g., "ANSWER," "ANSWER AND COUNTERCLAIM," etc.).

An answer need not be verified, but it must be signed. The signature may be made by the defendant or by the defendant's attorney or other authorized representative. See 37 CFR §2.119(e), and TBMP §106.02. If a defendant signing for itself is an individual, the signature must be made by the individual. If a defendant signing for itself is a partnership, the signature must be made by a partner. If a defendant signing for itself is a corporation or association, the signature must be made by an individual who is an officer of defendant and who is authorized to represent it. The signature should be accompanied by a description of the capacity in which the signing individual signs (i.e., as defendant, if defendant is an individual; as counsel for defendant; as a partner of defendant, if defendant is a partnership; as an officer of defendant identified by title, if defendant is a corporation; etc.).

Although an answer must be signed, an unsigned answer will not be refused consideration if a signed copy is submitted to the PTO within the time limit set in the Board's letter notifying the defendant of this defect. See 37 CFR §2.119(e), and TBMP §106.02.

The Board prefers that answers be submitted in typewritten or printed form, double spaced. An answer may be submitted on either legal or letter-sized paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. See TBMP §106.03.

One copy of the answer, and any exhibits thereto, must be filed in the PTO. Another copy of the answer, with any exhibits thereto, should be served by the defendant upon the plaintiff, and the answer should bear proof (e.g., a certificate of service, consisting of a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which

OLD EDITION

service was made) that such service has been made. See 37 CFR §2.119(a), and TBMP §113.

318.02 Pleading Substance of Answer

37 CFR §2.106(b)(1) An answer shall state in short and plain terms the applicant's defenses to each claim asserted and shall admit or deny the averments upon which the opposer relies. If the applicant is without knowledge or information sufficient to form a belief as to the truth of an averment, applicant shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the opposition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original notice of opposition or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

37 CFR §2.114(b)(1) An answer shall state in short and plain terms the respondent's defenses to each claim asserted and shall admit or deny the averments upon which the petitioner relies. If the respondent is without

OLD EDITION

knowledge or information sufficient to form a belief as to the truth of an averment, respondent shall so state and this will have the effect of a denial. Denials may take any of the forms specified in Rule 8(b) of the Federal Rules of Civil Procedure. An answer may contain any defense, including the affirmative defenses of unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. When pleading special matters, the Federal Rules of Civil Procedure shall be followed. A reply to an affirmative defense need not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(2) of this section shall govern. A pleaded registration is a registration identified by number and date of issuance in an original petition for cancellation or in any amendment thereto made under Rule 15, Federal Rules of Civil Procedure.

(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by a petitioner will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

37 CFR §2.133(d) A plaintiff's pleaded registration will not be restricted in the absence of a counterclaim to cancel the registration in whole or in part, except that a counterclaim need not be filed if the registration is the subject of another proceeding between the same parties or anyone in privity therewith.

OLD EDITION

318.02(a) Admissions and Denials

In its answer, a defendant should admit or deny each of the allegations contained in the complaint. If the defendant is without knowledge or information sufficient to form a belief as to the truth of an allegation, it should so state, and this statement will have the effect of a denial. See 37 CFR §§2.106(b)(1) and

2.114(b)(1); FRCP 8(b); Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); and Thrifty Corp. v. Bomax Enterprises, 228 USPQ 62 (TTAB 1985).

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in FRCP 8(b). See 37 CFR §§2.106(b)(1) and 2.114(b)(1). Thus, if a defendant intends in good faith to deny only a part or a qualification of an allegation, the defendant should admit so much of the allegation as is true and material and should deny only the remainder. If a defendant intends in good faith to controvert all of the allegations contained in a complaint, the defendant may do so by general denial, subject to the obligations set forth in FRCP 11 (for a discussion of FRCP 11 in relation to pleadings, see TBMP §314). If a defendant does not intend in good faith to controvert all of the allegations contained in a complaint, the defendant may make its denials as specific denials of designated allegations or paragraphs, or may generally deny all the allegations except those designated allegations or paragraphs which are expressly admitted.

In the absence of a general denial of some or all of the allegations in a complaint, admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

If any allegation in a complaint is not denied in the defendant's answer thereto, the allegation may be deemed admitted. See FRCP 8(d).

OLD EDITION

318.02(b) Defenses

An answer should include a short and plain statement of any defenses which the defendant may have to the claim or claims asserted by the plaintiff. See 37 CFR §§2.106(b)(1) and 2.114(b)(1), and FRCP 8(b). These defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior judgment, or any other matter constituting an avoidance or affirmative defense. See 37 CFR §§2.106(b)(1) and 2.114(b)(1). They may also include a pleading that defendant is at least entitled to a registration with a particular restriction (described in the pleading in sufficient detail to give plaintiff fair notice of the basis for the defense); except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding. Cf. 37 CFR §§2.133(b) and 2.133(c); Brunswick Corp. v. British Seagull Ltd.,

F.2d , 32 USPQ2d 1120 (Fed. Cir. 1994); Personnel Data Systems Inc. v. Parameter Driven Software Inc., 20 USPQ2d 1863 (TTAB 1991); and Flow Technology Inc. v. Picciano, 18 USPQ2d 1970 (TTAB 1991). See also Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990). Cf. TBMP §514. When one of the special matters listed in FRCP 9 (including, inter alia, capacity, fraud, and judgment) is pleaded, the provisions of FRCP 9 governing the pleading of that special matter should be followed. See 37 CFR §§2.106(b)(1) and 2.114(b)(1).

A defense which attacks the validity of a registration pleaded by a plaintiff will not be entertained unless the defendant timely files a counterclaim or a separate petition to cancel the registration. See 37 CFR §§2.106(b) and 2.114(b); Food Specialty Co. v. Standard Products Co., 406 F.2d 1397, 161 USQP 46 (CCPA 1969); Gillette Co. v. "42" Products Ltd., Inc., 396 F.2d 1001, 158 USPQ 101 (CCPA 1968); Contour Chair-Lounge Co. v. Englander Co., 324 F.2d 186, 139 USPQ 285 (CCPA 1963); Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986); Clorox Co. v. State Chemical Manufacturing Co., 197 USPQ 840 (TTAB 1977); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975). See also TBMP §319.

Although Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii), 37 CFR §§2.106(b)(2)(ii) and 2.114(b)(2)(ii), specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim. See Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989). If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter filed therewith should include a reference to the original proceeding.

A defendant's request to restrict a plaintiff's pleaded registration, as, for example, by limiting the goods or services therein, or by deleting some of the goods or services, will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part. See 37 CFR §2.133(d). Geographic restrictions will be considered and determined by the Board only within the context of a concurrent use registration proceeding. See 37 CFR §§2.99(h) and 2.133(c). See also Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990).

When a defense is raised by way of a counterclaim, it should not also be pleaded as an affirmative defense, because the pleading of it as an affirmative defense is

OLD EDITION

unnecessary and redundant. See Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); Continental Gummi-Werke AG v. Continental Seal Corp., 222 USPQ 822 (TTAB 1984); and W. R. Grace & Co. v. Arizona Feeds, 195 USPQ 670 (Comm'r 1977).

The elements of a defense should be stated simply, concisely, and directly. See FRCP 8(e)(1). However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense. Cf. McDonnell Douglas Corp. v. National Data Corp., 228 USPQ 45 (TTAB 1985).

A defendant may state as many separate defenses as it has, regardless of consistency; a defendant may also set forth two or more statements of a defense alternately or hypothetically, either in one count or in separate counts. See FRCP 8(e)(2). Cf. Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987); Home Juice Co. v. Runglin Cos., 231 USPQ 897 (TTAB 1986); Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975); John T. Clark Co. v. Colgate-Palmolive Co., 176 USPQ 93 (TTAB 1972); Rimmel, Ltd. v. Romel Cosmetics, Inc., 172 USPQ 186 (TTAB 1971); and Revco, D.S., Inc. v. Armour-Dial, Inc., 170 USPQ 48 (TTAB 1971).

For example, an applicant whose application for registration has been opposed under Section 2(d) of the Act, 15 U.S.C. §1052(d), on the ground of opposer's alleged prior use of its mark, coupled with an allegation of likelihood of confusion, might deny that there is any likelihood of confusion with respect to its mark and goods as set forth in the application. At the same time, the applicant might plead alternatively that it actually uses its mark only on a specific type (identified in the pleading) of the goods covered by the broad identification in its application; that there is no likelihood of confusion with respect to applicant's actual goods; and that even if the Board ultimately finds that opposer is entitled to judgment with respect to applicant's goods as broadly identified, applicant would be entitled to a registration of its mark with a restricted identification reflecting the actual nature of its goods. Cf. 37 CFR §2.133(b), and TBMP §514.

When two or more statements are made in the alternative, the sufficiency of each is determined independently; the fact that one of them may be insufficient does not mean that the other(s) is(are) also insufficient. See FRCP 8(e)(2).

Evidentiary matters (such as, for example, lists of third-party registrations upon which defendant intends to rely) should not be pleaded in an answer. They are

OLD EDITION

matters for proof, not for pleading. See McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959).

318.02(c) Other Affirmative Pleadings

An answer may include affirmative assertions which, although they may not rise to the level of an affirmative defense, nevertheless state the reasons for, and thus amplify, the defendant's denial of one or more of the allegations in the complaint. These amplifications of denials, whether referred to as "affirmative defenses," "avoidances," "affirmative pleadings," or "arguments," are permitted by the Board because they serve to give the plaintiff fuller notice of the position which the defendant plans to take in defense of its right to registration. See Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987); Maytag Co. v. Luskin's, Inc., 228 USPQ 747 (TTAB 1986); Textron, Inc. v. Gillette Co., 180 USPQ 152 (TTAB 1973); and McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959). Cf. Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988).

319 Counterclaims

319.01 In General

37 CFR §2.106(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by an opposer will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

OLD EDITION

(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

37 CFR §2.114(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

(ii) An attack on the validity of a registration pleaded by a petitioner will not be heard unless a counterclaim or separate petition is filed to seek the cancellation of such registration.

(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

(iv) The times for pleading, discovery, testimony, briefs, or oral argument will be reset or extended when necessary, upon motion by a party, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.

An attack upon the validity of a registration pleaded by a plaintiff cannot be entertained by the Board unless the defendant timely files a counterclaim or a separate petition to cancel the registration. See 37 CFR §§2.106(b)(2)(ii) and 2.114(b)(2)(ii); Food Specialty Co. v. Standard Products Co., 406 F.2d 1397, 161 USPQ 46 (CCPA 1969); Gillette Co. v. "42" Products Ltd., Inc., 396 F.2d 1001, 158 USPQ 101 (CCPA 1968); Contour Chair-Lounge Co. v. Englander Co., 324 F.2d 186, 139 USPQ 285 (CCPA 1963); Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986); Clorox Co. v. State Chemical

OLD EDITION

Manufacturing Co., 197 USPQ 840 (TTAB 1977); and Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975).

Although Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii) specifically permit a defense attacking the validity of a plaintiff's pleaded registration to be raised either as a counterclaim or as a separate petition to cancel, the better practice is to raise the defense as a counterclaim. See Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989). If the defense is raised as a separate petition to cancel, however, the petition itself and any covering letter filed therewith should include a reference to the original proceeding. Further, a defendant which fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. See TBMP §319.04, and cases cited therein.

The only type of counterclaim which may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party. See Pyttronic Industries Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990), and International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983).

A counterclaim may seek to cancel a registration in whole, or in part. In the latter case, the counterclaimant may seek to cancel the registration only, for example, as to some of the goods or services listed therein, or only to the extent of restricting the goods or services in a particular manner (described in sufficient detail to give the respondent fair notice thereof). See Section 18 of the Act, 15 U.S.C. §1068; 37 CFR §§2.111(b) and 2.133(b); and TBMP §311, and cases cited therein. However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. See 37 CFR §§2.99(h) and 2.133(c), and Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990).

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of Rules 2.111 through 2.115, 37 CFR §§2.111 through 2.115, governing petitions to cancel, are applicable to counterclaims. See 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii).

When necessary to enable a party fully to present or meet a counterclaim or separate petition to cancel a registration, the times for pleading, discovery, testimony, briefs and/or oral argument will be reset or extended. A party which

OLD EDITION

believes that such a resetting or extension is necessary should file a motion therefor with the Board. See 37 CFR §§2.106(b)(2)(iv) and 2.114(b)(2)(iv).

319.02 Fee For Counterclaim

37 CFR §§2.106(b)(2)(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

37 CFR §§2.114(b)(2)(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

The required filing fee must be paid when a petition to cancel takes the form of a counterclaim, just as it must be paid when a petition to cancel takes the form of a separate proceeding. See 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii); Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742 (TTAB 1992), summ. judgment granted, in part, 26 USPQ2d 1926 (TTAB 1993); Sunway Fruit Products, Inc. v. Productos Caseros, S. A., 130 USPQ 33 (Comm'r 1960); Jet-Pak, Inc. v. United States Plywood Corp., 125 USPQ 491 (Comm'r 1960); Jet-Pak, Inc. v. United States Plywood Corp., 124 USPQ 385 (TTAB 1960); and McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959). That is, the required fee (see 37 CFR §2.6(l)) must be paid for each party joined as counterclaimant for each class sought to be cancelled in each registration against which the counterclaim is filed. See 37 CFR §§2.111(c) and 2.112(b). Cf. TBMP §310.

OLD EDITION

319.03 Form of Counterclaim

A counterclaim should be generally similar in form to a petition to cancel (for information concerning the form of a petition to cancel, see TBMP §312). However, a counterclaim filed as part of the counterclaimant's answer to the adverse party's complaint necessarily differs somewhat in format from a separate petition to cancel.

Moreover, a plaintiff filing a separate petition to cancel must file the petition (and any exhibits thereto) in duplicate, and need not serve a copy thereof upon the defendant(s). See 37 CFR §§2.112(a) and 2.119(a), and TBMP §312.01. A counterclaimant, on the other hand, need file only one copy of its counterclaim (and any exhibits thereto) with the Board, but must serve a copy thereof (with any exhibits thereto) upon every other party to the proceeding, and must make proof of such service before the counterclaim will be considered by the Board. See 37 CFR §2.119(a).

The pleading of the substance of a counterclaim may also differ somewhat from the pleading of the substance of a separate petition to cancel. For example, a counterclaimant need not plead its standing to assert a counterclaim to cancel a registration pleaded by the plaintiff in its complaint. The counterclaimant's standing in such a case is inherent in its position as defendant to the complaint. See Aries Systems Corp. v. World Book Inc., 26 USPQ2d 1926 (TTAB 1993); Alberto-Culver Co. v. F.D.C. Wholesale Corp., 16 USPQ2d 1597 (TTAB 1990); Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 USPQ2d 1879 (TTAB 1990); Bankamerica Corp. v. Invest America, 5 USPQ2d 1076 (TTAB 1987); M. Aron Corp. v. Remington Products, Inc., 222 USPQ 93 (TTAB 1984); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); and General Mills, Inc. v. Nature's Way Products, Inc., 202 USPQ 840 (TTAB 1979). Cf. Domino's Pizza Inc. v. Little Caesar Enterprises Inc., 7 USPQ2d 1359 (TTAB 1988), and Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857 (TTAB 1986).

In some instances, the grounds for cancellation available in the case of a counterclaim differ from those available in the case of a petition to cancel which is not in the nature of a counterclaim. Section 14 of the Act, 15 U.S.C. §1064, limits, after a five-year period, the grounds upon which most Principal Register registrations may be cancelled. If the plaintiff in a proceeding before the Board relies upon such a registration, and the five-year period has not yet expired when the plaintiff's complaint is filed, the limitation does not apply to a counterclaim filed by the defendant therein for cancellation of that registration. This is so even if the five-year period has expired by the time the counterclaim is filed. In such cases, the filing of the plaintiff's complaint tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds upon which a counterclaim may be based. See Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966); Arman's Systems, Inc. v. Armand's Subway, Inc., 215 USPQ 1048 (TTAB 1982); UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861 (TTAB 1980); Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of

OLD EDITION

Japan, 165 USPQ 597 (TTAB 1970); Sunbeam Corp. v. Duro Metal Products Co., 106 USPQ 385 (Comm'r 1955); and TBMP §308.02(c)(1). See also J. Thomas McCarthy, Trademarks and Unfair Competition, §20:17[3] (3rd ed. 1994).

319.04 Compulsory Counterclaims

37 CFR §2.106(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the opposition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

37 CFR §2.114(b)(2)(i) A defense attacking the validity of any one or more of the registrations pleaded in the petition shall be a compulsory counterclaim if grounds for such counterclaim exist at the time when the answer is filed. If grounds for a counterclaim are known to respondent when the answer to the petition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the cancellation proceeding, the counterclaim shall be pleaded promptly after the grounds therefor are learned. A counterclaim need not be filed if it is the subject of another proceeding between the same parties or anyone in privity therewith.

See Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989); Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992), summ. judgment granted, 24 USPQ2d 1376 (TTAB 1992); See's Candy Shops Inc. v. Campbell Soup Co., 12 USPQ2d 1395 (TTAB 1989); TBC Corp. v. Grand Prix Ltd., 12 USPQ2d 1311 (TTAB 1989); Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1355 (TTAB 1989); S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987); Consolidated Foods Corp. v. Big Red, Inc., 231 USPQ 744 (TTAB 1986); and M. Aron Corp. v. Remington Products, Inc., 222 USPQ 93 (TTAB 1984). See also FRCP 15(a); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB

OLD EDITION

1975); Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

A defendant which fails to timely plead a compulsory counterclaim cannot avoid the effect of its failure by thereafter asserting the counterclaim grounds in a separate petition to cancel. In such a case, the separate petition will be dismissed, upon motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted. See Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989), and Consolidated Foods Corp. v. Big Red, Inc., 231 USPQ 744 (TTAB 1986).

If a defendant confronted with a motion for summary judgment knows of grounds for a counterclaim which might serve to defeat the motion, the counterclaim should be asserted in response to the motion, even if no answer to the complaint has yet been filed. See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992), summ. judgment granted, 24 USPQ2d 1376 (TTAB 1992).

A plaintiff which fails to plead a registration, and later seeks to rely thereon, will not be heard to contend, if defendant then moves to amend its answer to assert a counterclaim to cancel the registration, or then files a separate petition to cancel the registration, that the counterclaim or separate petition is untimely because it was not pleaded when defendant filed its answer. A plaintiff may not, by failing to plead a registration upon which it intends to rely, deprive a defendant of its right to petition to cancel the registration, either by counterclaim or by separate petition, at such time as opposer seeks to rely upon the registration. Even if grounds for cancellation of a plaintiff's unpleaded registration are known to the defendant when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the registration is pleaded by the plaintiff. See 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i), and M. Aron Corp. v. Remington Products, Inc., 222 USPQ 93 (TTAB 1984). See also Notice of Final Rulemaking published in the Federal Register of January 22, 1981 at 46 FR 6940.

319.05 Permissive Counterclaims

OLD EDITION

A party may counterclaim to cancel a registration which is owned, but not pleaded, by an adverse party. A counterclaim to cancel a registration owned, but not pleaded, by an adverse party is a permissive counterclaim. See FRCP 13(b). Cf. 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i).

319.06 Answer to Counterclaim

37 CFR §2.106(b)(2)(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

37 CFR §2.114(b)(2)(iii) The provisions of §§2.111 through 2.115, inclusive, shall be applicable to counterclaims. A time, not less than thirty days, will be designated within which an answer to the counterclaim must be filed.

37 CFR §2.114(a) If no answer is filed within the time set, the petition may be decided as in case of default.

When a counterclaim (together with the required cancellation fee) is filed, the Board prepares a letter acknowledging receipt thereof and allowing the plaintiff (defendant to the counterclaim) until a set time, not less than 30 days, in which to file an answer to the counterclaim. See 37 CFR §§2.106(b)(2)(iii) and 2.114(b)(2)(iii). In practice, the time allowed by the Board is usually 30 days. A copy of the letter is sent to each party to the proceeding, or to each party's attorney or other authorized representative.

If no answer to the counterclaim is filed during the time allowed therefor, the counterclaim may be decided as in case of default. See 37 CFR §§2.114(a) and 2.114(b)(2)(iii). For information concerning default, see TBMP §317.

An answer to a counterclaim should be in the same form as an answer to a complaint. For information concerning the proper form for an answer to a complaint, see TBMP §318.

An answer to a counterclaim, like any other answer, may include a counterclaim for cancellation of a registration owned by the counterclaimant. A defense attacking the validity of any registration pleaded in the counterclaim is a compulsory counterclaim if grounds for such counterclaim exist at the time when

OLD EDITION

the plaintiff's answer to the defendant's counterclaim is filed. If grounds for a counterclaim are known to the plaintiff when the plaintiff's answer to the defendant's counterclaim is filed, the counterclaim must be pleaded with or as part of the plaintiff's answer. If, during the course of the proceeding, the plaintiff learns, through discovery or otherwise, that grounds for a counterclaim exist, the counterclaim should be pleaded promptly after the grounds therefor are learned. Cf. 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i), and TBMP §319.04.

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim. Cf. FRCP 13(b), and TBMP §319.05.

For information concerning the fee for a counterclaim, see 37 CFR §2.6(a)(16) and TBMP §310. For information concerning the form for a counterclaim, see TBMP §319.03.

OLD EDITION

320 Reply to Answer Should Not be Filed

Although Rules 2.106(b) and 2.114(b) require that an answer to a counterclaim be filed, within the time designated therefor by the Board, they specifically provide that a reply to an affirmative defense need not be filed. See 37 CFR §§2.106(b)(1) and (2)(iii), and 2.114(b)(1) and (2)(iii). Similarly, FRCP 7(a) provides that there shall be a complaint and an answer and a reply to a counterclaim denominated as such; that certain other specified pleadings, not relevant to Board proceedings (and not including a reply to an answer) shall be allowed; but that "[n]o other pleading shall be allowed, except that the court may order a reply to an answer."

Thus, while a plaintiff must file an answer to a counterclaim, a reply to an answer need not, and should not, be filed.

321 Unpleaded Matters

An unpleaded claim cannot be relied upon by a plaintiff unless the plaintiff's pleading is amended (or deemed amended), pursuant to FRCP 15(a) or (b), to assert the matter. See P.A.B. Produits et Appareils de Beaute v. Satinine Societa

In Nome Collettivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993); Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992); Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990); United States Shoe Corp. v. Kiddie Kobbler Ltd., 231 USPQ 815 (TTAB 1986); Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986); Alliance Manufacturing Co. v. ABH Diversified Products, Inc., 226 USPQ 348 (TTAB 1985); Long John Silver's, Inc. v. Lou Scharf Inc., 213 USPQ 263 (TTAB 1982); Standard Brands Inc. v. Peters, 191 USPQ 168 (TTAB 1975); Dap, Inc. v. Litton Industries, Inc., 185 USPQ 177 (TTAB 1975); and CCI Corp. v. Continental Communications, Inc., 184 USPQ 445 (TTAB 1974).

Similarly, except as provided in FRCP 12(b) and (h)(2) (which allow a defendant to raise certain specified defenses by motion), an unpleaded defense cannot be relied upon by the defendant unless the defendant's pleading is amended (or deemed amended), pursuant to FRCP 15(a) or 15(b), to assert the matter. See FRCP 8(b), 8(c), and 12(b); Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991); U.S. Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984); Trans Union Corp. v. Trans Leasing International, Inc., 200 USPQ 748 (TTAB 1978); United States Mineral Products Co. v. GAF Corp., 197 USPQ 301 (TTAB 1977); Copperweld Corp. v. Astralloy-Vulcan Corp., 196 USPQ 585 (TTAB 1977); Hershey Foods Corp. v. Cerreta, 195 USPQ 246 (TTAB 1977); and Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975).

If, after the filing of its pleading, a party learns, through discovery or otherwise, of information which would serve as the basis for an additional claim (in the case of a plaintiff), or defense or counterclaim (in the case of a defendant), the party should move promptly to amend its pleading to assert the additional matter. See FRCP 15(a); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Trans Union Corp. v. Trans Leasing International, Inc., 200 USPQ 748 (TTAB 1978); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975); and Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974). See also 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i).

OLD EDITION

A party may not obtain summary judgment on an unpleaded issue, nor may a party defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. However, a party which seeks to obtain, or to defend against, summary judgment on the basis of an unpleaded issue may move to amend its pleading to assert the issue. See TBMP §528.07, and cases cited therein.

322 Amendment of Pleadings

37 CFR §2.107 Amendment of pleadings in an opposition proceeding. Pleadings in an opposition proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

37 CFR §2.115 Amendment of pleadings in a cancellation proceeding. Pleadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court.

Pleadings in inter partes proceedings before the Board may be amended in the same manner and to the same extent as pleadings in a civil action before a United States district court. See 37 CFR §§2.107 and 2.115. For further information concerning the amendment of pleadings, see FRCP 15, and TBMP §507. See also Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

OLD EDITION

323 Motions Relating to Pleadings

In opposition and cancellation proceedings, there is a wide range of motions relating to pleadings, including motions to dismiss, for a more definite statement, to strike, for judgment on the pleadings, to amend pleadings, etc. For information concerning these motions, see TBMP chapter 500.

324 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application which is the subject of the opposition, see TBMP §219.

OLD EDITION

CHAPTER 400 DISCOVERY

401 In General

402 Scope of Discovery

403 Timing of Discovery

404 Discovery Depositions

405 Discovery Deposition Objections

406 Interrogatories

407 Responses to Interrogatories

408 Requests for Production of Documents and Things

409 Responses to Requests for Production

410 Requests for Admission

411 Responses to Requests for Admission

412 Duties to Cooperate, Search Records, Supplement

413 Filing Discovery Requests and Responses With Board

414 Motions Attacking Requests for Discovery

415 Remedy for Failure to Provide Discovery

416 Protective Orders

417 Telephone and Pre-trial Conferences

418 Discovery Sanctions

419 Discovery Guidelines

OLD EDITION

401 In General

Through the use of the various discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in inter partes proceedings before the Board, a party may ascertain the facts underlying its adversary's case. Discovery of these facts may lead to a settlement of the case; simplify the issues; or reveal a basis for a motion for summary judgment, an additional claim (in the case of a plaintiff), or an additional defense or counterclaim (in the case of a defendant). At the very least, discovery enables the discovering party to better prepare for trial. For a discussion of the purposes served by discovery, see Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979). See also Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978).

The conduct of discovery in Board inter partes proceedings is governed by 37 CFR §2.120. Discovery before the Board under 37 CFR §2.120 is similar in many respects to discovery before the Federal district courts under the Federal Rules of Civil Procedure. In fact, the discovery provisions of the Federal Rules of Civil Procedure are applicable in Board inter partes proceedings, except as otherwise provided in 37 CFR §2.120 and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). The differences that do exist between the two discovery systems are due primarily to the administrative nature of Board proceedings. See Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor upon those which do not. See: TBMP section 412.01.

OLD EDITION

402 Scope of Discovery

402.01 In General

The general scope of the discovery which may be obtained in inter partes proceedings before the Board is governed by FRCP 26(b)(1), which provides, in part, as follows:

> Parties may obtain discovery regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action, whether it relates to the claim or defense of the party seeking discovery or to the claim or defense of any other party, including the existence, description, nature, custody, condition and location of any books, documents, or other tangible things and the identity and location of persons having knowledge of any discoverable matter. The information sought need not be admissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence.

See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); and Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975).

A request for discovery is not necessarily objectionable merely because it requires a party or a witness to give an opinion or contention that relates to fact or the application of law to fact. See FRCP 33(c) and 36(a); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and Gould Inc. v. Sanyo Electric Co., 179 USPQ 313 (TTAB 1973).

A party may take discovery not only as to matters specifically raised in the pleadings (see Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975), and Mack Trucks, Inc. v. Monroe Auto Equipment Co., 181 USPQ 286 (TTAB 1974)), but also as to any matter which might serve as the basis for an additional claim, defense, or counterclaim. See J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975); and Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974). The taking of discovery cannot, under any circumstances, be construed as an attack upon any registration. See Johnson & Johnson v. Rexall Drug Co., supra, and Neville Chemical Co. v. Lubrizol Corp., supra.

OLD EDITION

A party may not, by limiting its own discovery and/or presentation of evidence on the case, thereby restrict another party's discovery in any way. See Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975).

402.02 Limitations on Right to Discovery

The right to discovery is not unlimited. Even if the discovery sought by a party is relevant, it will be limited, or not permitted, where, inter alia, it is unreasonably cumulative or duplicative; or is obtainable from some other source that is more convenient, less burdensome, or less expensive; or "where no need is shown, or compliance would be unduly burdensome, or where harm to the person from whom discovery is sought outweighs the need of the person seeking discovery of the information." Micro Motion Inc. v. Kane Steel Co., 894 F.2d 1318, 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990), and FRCP 26(b)(2). See also Haworth Inc. v. Herman Miller Inc., 998 F.2d 975, 27 USPQ2d 1469 (Fed. Cir. 1993), and Katz v. Batavia Marine & Sporting Supplies Inc., 984 F.2d 422, 25 USPQ2d 1547 (Fed. Cir. 1993).

For example, in those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. See British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); Van Dyk Research Corp. v. Xerox Corp., 181 USPQ 346 (TTAB 1974); and Mack Trucks, Inc. v. Monroe Auto Equipment Co., 181 USPQ 286 (TTAB 1974).

Nor will a party be permitted to obtain, through a motion to compel, discovery broader in scope than that actually sought in the discovery request(s) to which the motion pertains. See Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980).

OFFICIAL EDITION

The Board may refuse to permit the discovery of confidential commercial information, or may allow discovery thereof only under an appropriate protective order. See, for example FRCP 26(c); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975); Miller & Fink Corp. v. Servicemaster Hospital Corp., 184 USPQ 495 (TTAB 1975); and Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974).

Similarly, information protected by the attorney-client privilege is not discoverable unless the privilege has been waived; and documents and things prepared in anticipation of litigation or for trial by or for another party, or by or for that other party's representative, are discoverable only upon a showing that the party seeking discovery has substantial need of the materials in the preparation of its case and that it is unable, without undue hardship, to obtain the substantial equivalent of the materials by other means. See, for example FRCP 26(b)(3); Goodyear Tire & Rubber Co. v. Tyrco Industries, 186 USPQ 207 (TTAB 1975); Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975); Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc., 185 USPQ 432 (TTAB 1975); Amerace Corp. v. USM Corp., 183 USPQ 506 (TTAB 1974); and Goodyear Tire & Rubber Co. v. Uniroyal, Inc., 183 USPQ 372 (TTAB 1974).

In addition, because the signature of a party or its attorney to a request for discovery constitutes, under the provisions of FRCP 26(g), a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. See Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990); Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986); Medtronic, Inc. v. Pacesetter Systems, Inc., 222USPQ 80 (TTAB 1984); Tektronix, Inc. v. Tek Associates, Inc., 183 USPQ 623 (TTAB 1974); and Gastown Inc. of Delaware v. Gas City, Ltd., 180 USPQ 477 (TTAB 1974). See also TBMP §412.01. A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is

OLD EDITION

proper when propounded by one party but improper when propounded by another. See Miss America Pageant v. Petite Productions, Inc., supra.

403 Timing of Discovery

403.01 In General

The discovery devices, namely, discovery depositions, interrogatories, requests for production of documents and things, and requests for admission, are available for use only during the discovery period. See Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978), and Rhone-Poulenc Industries v. Gulf Oil Corp., 198 UPSQ 372 (TTAB 1978). A party has no obligation to respond to an untimely request for discovery.

When a defendant's answer to a complaint is received by the Board, the Board prepares and sends out to the parties a trial order, wherein the Board acknowledges receipt of the answer; specifies the closing date for the taking of discovery; and assigns each party's time for taking testimony. See 37 CFR §§2.120(a) and 2.121(a)(1). The date set for the close of discovery normally is 90 days after the mailing date of the trial order.

The opening of the discovery period hinges upon the commencement of the proceeding, and service of the complaint upon the defendant by the Board; it is not contingent upon joinder of issues. See Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990); Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975); "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); and Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34892, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 31.

403.02 Time for Service of Discovery Requests

Interrogatories, requests for production of documents and things, and requests for admission may be served upon the plaintiff after the proceeding commences, and

OLD EDITION

upon the defendant with or after service of the complaint by the Board. See "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34892, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 31; and Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993).

Discovery depositions generally may be taken by any party after commencement of the proceeding. However, the Board's permission must be obtained under the following circumstances:

(1) If a plaintiff seeks to take a deposition prior to the expiration of 30 days after service of the complaint by the Board upon any defendant, except that permission is not required if the defendant has itself served a notice of taking deposition or otherwise sought discovery, or if the plaintiff's notice (i) states that the proposed deponent is about to go out of the United States, or is bound on a voyage to sea, and will be unavailable for examination unless his or her deposition is taken before expiration of the 30-day period, and (ii) sets forth facts to support the statement; or

(2) If the person to be examined is confined in prison; or

(3) If, without written stipulation of the parties, (i) a proposed deposition would result in more than ten depositions being taken by the plaintiffs, or by the defendants, or (ii) the person to be examined already has been deposed in the case.

OLD EDITION

See FRCP 30(a); "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993); and Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975).

An opposition or cancellation proceeding commences when the complaint, i.e., the notice of opposition or petition to cancel, is filed. See 37 CFR §§2.101(a) and 2.111(a). In an interference or concurrent use proceeding, there is no "complaint," as such; rather, the notice of institution and accompanying materials take the place of a complaint, and the proceeding commences when the Board mails the notice to each party. See 37 CFR §§2.93, 2.99(c), and 2.99(d)(1), and TBMP §§1003 and 1105.

Interrogatories, requests for production of documents and things, and requests for admission may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. See Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978); Atwood Vacuum Machine Co. v. Automation Industries, Inc., 181 USPQ 606 (TTAB 1974); AMP Inc. v. Raychem Corp., 179 USPQ 857 (TTAB 1973); and Deere & Co. v. Deerfield Products Corp., 176 USPQ 422 (TTAB 1973). However, discovery depositions must be not only noticed but also taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). See Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978), and Rhone-Poulenc Industries v. Gulf Oil Corp., supra.

OLD EDITION

403.03 Time for Service of Discovery Responses

Responses to interrogatories, requests for production of documents and things, and requests for admission must be served within 30 days after the date of service of the request for discovery; except that a defendant may serve responses either within 30 days after service of a discovery request, or within 45 days after service of the complaint upon it by the Board, whichever is later. See FRCP 33(b)(3), 34(b), and 36(a), and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). If service of the request for discovery is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the request. See 37 CFR §2.119(c), and TBMP §113.05. See also Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987).

Discovery in proceedings before the Board is not governed by any concept of priority of discovery or deposition. That is, a party which is the first to serve a request for discovery does not thereby gain a right to receive a response to its request before it must respond to its adversary's subsequently served request for discovery, and this is so even if its adversary fails to respond, or respond completely, to the first party's request for discovery. Rather, a party is under an obligation to respond to an adversary's request for discovery during the time allowed therefor under the applicable rules, irrespective of the sequence of requests for discovery, or of an adversary's failure to respond to a pending

request for discovery. See FRCP 26(d); Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990); and Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986).

A party which fails to respond to a request for discovery during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); and Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975).

OLD EDITION

403.04 Extensions

37 CFR §2.121(a)(1) ... Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

The closing date of the discovery period may be extended by stipulation of the parties approved by the Board, or upon motion (pursuant to FRCP 6(b)) granted by the Board, or by order of the Board. An extension of the closing date for discovery will result in a corresponding extension of the testimony periods without action by any party. See 37 CFR §2.121(a)(1). For information concerning stipulations to extend, see TBMP §501.03. For information concerning motions to extend, see TBMP §509.

Mere delay in initiating discovery does not constitute good cause for an extension of the discovery period. See Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987), and Janet E. Rice, TIPS FROM THE TTAB: The Timing of Discovery, 68 Trademark Rep. 581 (1978). See also American

Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992). Thus, a party which waits until the waning days of the discovery period to serve interrogatories, requests for production of documents and things, and/or requests for admission will not be heard to complain, when it receives responses thereto after the close of the discovery period, that it needs an extension of the discovery period in order to take "follow-up" discovery.

At the same time, a party which receives discovery requests early in the discovery period may not, by delaying its response thereto, or by responding improperly so that its adversary is forced to file a motion to compel discovery, rob its adversary of the opportunity to take "follow-up" discovery. Such a delay or improper response constitutes good cause for an extension of the discovery period. Therefore, the Board will, at the request of the propounding party, extend the discovery period (at least for the propounding party) so as to restore that amount of time which would have remained in the discovery period had the discovery responses been made in a timely and proper fashion. See Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990), and Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975).

The time for responding to a request for discovery may be extended or reopened by stipulation of the parties, or upon motion (pursuant to FRCP 6(b)) granted by the Board, or by order of the Board. However, an extension of a party's time to respond to an outstanding request for discovery will not result in an automatic corresponding extension of the discovery and/or testimony periods; such periods will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a).

A stipulation to extend or reopen only the time for responding to a request for discovery (that is, not to extend or reopen also the closing date for the discovery period and/or testimony periods) does not have to be filed with the Board. However, to avoid any misunderstanding between the parties as to the existence and terms of such a stipulation, it is recommended that the stipulation be reduced to writing, even if it is not filed with the Board.

OLD EDITION

403.05 Need for Early Initiation of Discovery

403.05(a) To Allow Time for "Follow-up" Discovery

If a party wishes to have an opportunity to take "follow-up" discovery after it receives responses to its initial requests for discovery, it must serve its initial requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and serve additional discovery requests prior to the expiration of the discovery period. See TBMP §403.04.

403.05(b) To Allow Time for Summary Judgment Motion

37 CFR §2.127(e)(1) A motion for summary judgment should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Trademark Trial and Appeal Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.

A party which has been served with interrogatories, requests for production of documents and things, and/or requests for admission is allowed 30 days from the date of service in which to respond thereto (or, in the case of a defendant, 30 days from service of the request or 45 days after service of the complaint upon it by the Board, whichever is later), plus an extra 5 days if service of the requests for discovery was made by first-class mail, "Express Mail," or overnight courier. See TBMP §403.03. If requests for discovery are served at the end of the discovery period, responses thereto may not be received until well after the beginning of the plaintiff's main testimony period, which opens 30 days after the closing date of the discovery period.

A summary judgment motion, however, should be filed prior to the commencement of the plaintiff's main testimony period, and may be denied as untimely if it is filed thereafter. See 37 CFR §2.127(e)(1).

Therefore, if a party wishes to have an opportunity to file a motion for summary judgment based upon discovery responses received from its adversary, it must serve its discovery requests early in the discovery period, so that when it receives responses thereto, it will have time to prepare and file the summary judgment motion prior to the commencement of the plaintiff's main testimony period.

403.05(c) To Facilitate Introduction of Produced Documents

OLD EDITION

37 CFR §2.120(j)(3)(ii) A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e).

There are a number of different methods by which documents produced in response to a request for production of documents may be made of record. See, in this regard, TBMP §711. Three of the easiest methods are available for use only if the request for production of documents is served relatively early in the discovery period.

First, if the discovery period has not yet expired, a party which has obtained documents from another party through a request for production of documents may serve upon its opponent a request for admission of the genuineness of the subject documents, which should be attached as exhibits to the request. See FRCP 36(a). Then, during its testimony period, the propounding party may file a notice of reliance, pursuant to 37 CFR §2.120(j)(3)(i), upon the request for admission, the exhibits thereto, and its adversary's response.

Second, if the discovery period has not yet expired, the party which obtained the documents may make them of record by taking a discovery deposition of its adversary, marking the documents as exhibits thereto, and having the witness identify the documents during the deposition.

Third, the request for production of documents may be combined with a notice of the taking of the adversary's discovery deposition; that is, the combined request and notice may ask that the deponent bring the requested documents to his or her deposition. However, a party served with a request for production of documents has 30 days from the date of service of the request in which to respond thereto (or, in the case of a defendant, 30 days from service of the request or 45 days after service of the complaint upon it by the Board, whichever is later), plus an extra 5 days if service of the request was made by first-class mail, "Express Mail," or overnight courier. See TBMP §403.03. Moreover, in proceedings before the Board, a discovery deposition must be both noticed and taken before the end of the discovery period. See TBMP §403.02. Thus, a combined notice of deposition and request for production of documents normally must be served at least 35 days prior to the close of the discovery period.

OLD EDITION

404 Discovery Depositions

404.01 When and By Whom Taken

After commencement of an inter partes proceeding before the Board, discovery depositions generally may be taken by any party. However, the Board's permission must be obtained under the following circumstances:

(1) If a plaintiff seeks to take a deposition prior to the expiration of 30 days after service of the complaint by the Board upon any defendant, except that permission is not required if the defendant has itself served a notice of taking deposition or otherwise sought discovery, or if the plaintiff's notice (i) states that the proposed deponent is about to go out of the United States, or is bound on a voyage to sea, and will be unavailable for examination unless his or her deposition is taken before expiration of the 30-day period, and (ii) sets forth facts to support the statement; or

(2) If the person to be examined is confined in prison; or

(3) If, without written stipulation of the parties, (i) a proposed deposition would result in more than ten depositions being taken by the plaintiffs, or by the defendants, or (ii) the person to be examined already has been deposed in the case.

See FRCP 30(a); "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994); Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993); and Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975).

An opposition or cancellation proceeding commences when the complaint, i.e., the notice of opposition or petition to cancel, is filed. See 37 CFR §§2.101(a) and 2.111(a). In an interference or concurrent use proceeding, there is no "complaint," as such; rather, the notice of institution and accompanying materials take the place of a complaint, and the proceeding commences when the Board mails the notice to each party. See 37 CFR §§2.93, 2.99(c), and 2.99(d)(1), and TBMP §§1003 and 1105.

Discovery depositions must be both noticed and taken prior to the expiration of the discovery period (unless the parties stipulate that the deposition may be taken outside of the period). See Smith International, Inc. v. Olin Corp., 201 USPQ

OLD EDITION

250 (TTAB 1978); Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978); and TBMP §403.02.

404.02 Compared to Testimony Depositions

A discovery deposition, like a testimony deposition, may be taken either upon oral examination or upon written questions. See FRCP 26(a). In fact, the actual taking of a discovery deposition is very similar to the taking of a testimony deposition. Nevertheless, there are substantial differences between the two, stemming from the differences between the discovery and trial stages of a proceeding. Some of the most significant differences are discussed below.

A discovery deposition is a device used by a party to obtain from an adversary information about the adversary's case, or to obtain from a nonparty information which may be helpful to the deposing party's case. The discovery deposition is taken of the adversary or a nonparty, or an official or employee of the adversary or a nonparty. A testimony deposition, on the other hand, is a device used by a party to present evidence in support of its own case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) on behalf of the party. See Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978); and Gary Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980).

The discovery deposition may only be taken during the discovery period, which is ongoing for all parties at the same time. See Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978); Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978); TBMP §403.02. A testimony deposition may only be taken by a party during the party's assigned testimony period; each party has an assigned testimony period, and only the party to which a particular testimony period is assigned may take testimony therein. See 37 CFR §2.121(a)(1).

In a discovery deposition, a party may seek information that would be inadmissible at trial, provided that the information sought appears reasonably calculated to lead to the discovery of admissible evidence. See FRCP 26(b)(1).

OLD EDITION

In a testimony deposition, a party may properly adduce only evidence admissible under the applicable rules of evidence; inadmissibility is a valid ground for objection. See 37 CFR §§2.122(a) and 2.123(k), and TBMP §534.

In both types of depositions, questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. See 37 CFR §2.123(e)(4); FRCP 26(b)(5), 30(c), and 37(a)(2)(B); FRE 501; 4A Moore's Federal Practice, ¶ 30.59 (2d ed. 1984); and Wright & Miller, Federal Practice and Procedure: Civil §2113 (1970). Both types of depositions are taken out of the presence of the Board, and if a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by adjourning the deposition and applying, under 35 U.S.C. 24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. See Ferro Corp. v. SCM Corp., 219 USPQ 346 (TTAB 1983); Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); S. Rudofker's Sons, Inc. v. "42" Products, Ltd., 161 USPQ 499 (TTAB 1969); and Bordenkircher v. Solis Entrialgo y Cia., S. A., 100 USPQ 268, 276-278 (Comm'r 1953). In the case of a discovery deposition, there is also available to the propounding party the simpler and more convenient alternative of completing the deposition and then filing a motion with the Board to compel the witness to answer the unanswered question. See 37 CFR §2.120(e) and Neville Chemical Co. v. Lubrizol Corp., supra. A motion to compel is not available, however, in the case of a testimony deposition taken in a proceeding before the Board, nor is there any other mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. See Ferro Corp. v. SCM Corp., supra; S. Rudofker's Sons, Inc. v. "42" Products, Ltd., supra; and Bordenkircher v. Solis Entrialgo y Cia., S. A., supra. Accordingly, in those cases where the witness in a testimony deposition refuses to answer a particular question; no court action is sought; and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. See TBMP §718.03(d), and authorities cited therein.

A discovery deposition does not form part of the evidentiary record in a case unless a party entitled to offer it into evidence files, during the party's testimony period, the deposition together with a notice of reliance thereon. That is, the

OLD EDITION

offering of a discovery deposition in evidence is voluntary, not mandatory. See, for example, 37 CFR §§2.120(j)(1), (j)(2), and (j)(3)(i); TMBP §709; Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861, 867 (TTAB 1979); and Gary Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Reporter 353 (1980). Every testimony deposition taken must be filed, and, when filed, becomes part of the record; a notice of reliance thereon is not necessary. See generally 37 CFR §2.123, and TBMP §713.12.

For further information concerning differences between discovery and testimony depositions, see Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978); and Gary Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980).

OLD EDITION

404.03 Securing Attendance of Deponent

404.03(a) In General

A discovery deposition may be taken of any person, whether or not the person is a party, and whether or not the person resides in the United States.

404.03(b) Person Residing in the United States

37 CFR §2.120(b) Discovery deposition within the United States.
The deposition of a natural person shall be taken in the Federal judicial district where the person resides or is regularly employed or at any place on which the parties agree by stipulation. ...

The deposition may be taken either orally, or upon written questions in the manner described in 37 CFR §2.124. See FRCP 26(a)(5), 30, and 31. For information on the taking of a deposition upon written questions, see TBMP §714.

404.03(b)(1) Person Residing in United States--Party

If a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, the deposition may be taken upon notice alone. See 37 CFR §2.120(b); FRCP 30(b); Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976); and Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). For information concerning notices of deposition, see TBMP §404.04.

404.03(b)(2) Person Residing in United States--Nonparty

37 CFR §2.120(b) Discovery deposition within the United States.
... The responsibility rests wholly with the party taking discovery to secure the attendance of a proposed deponent other than a party or anyone who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure. (See 35 U.S.C. 24)

If a proposed deponent residing in the United States is not a party, or a person who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, the responsibility rests wholly with the deposing party to secure the attendance of the proposed deponent. See 37 CFR §2.120(b). If the proposed deponent is not willing to appear voluntarily, the deposing party must secure the deponent's attendance by subpoena, pursuant to 35 U.S.C. §24 and FRCP 45. The subpoena must be issued from the United States District Court in the Federal judicial district where the deponent resides or is regularly employed. See Kellogg Co. v. New Generation Foods Inc., 6 USPQ2d 2045 (TTAB 1988); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 383-384 (1985); Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985); and FRCP 30(a)(1) and 45. Cf. Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976); and TBMP §713.06(b).

OLD EDITION

If a person named in a subpoena compelling attendance at a discovery deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States District Court which issued the subpoena; the Board has no jurisdiction over such depositions. See, for example, Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); In re Johnson & Johnson, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973); PRD Electronics Inc. v. Pacific Roller Die Co., 169 USPQ 318 (TTAB 1971); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 383-384 (1985); and Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985).

OLD EDITION

404.03(c)(1) Person Residing in a Foreign Country--Party

37 CFR 2.120(c) Discovery deposition in foreign countries.
(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial

district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

The discovery deposition of a natural person who resides in a foreign country, and who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, may be taken upon notice alone. See 37 CFR §§2.120(c) and 2.124.

However, if the discovery deposition of such a person is taken in a foreign country, it must be taken upon written questions, in the manner described in 37 CFR §2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See 37 CFR §2.120(c)(1). See also Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989); Jonergin Co. v. Jonergin Vermont Inc., 222 USPQ 337 (Comm'r 1983); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 384 (1985); Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449 (1984). Cf. TBMP §713.02. For information on the taking of a deposition upon written questions, see TBMP §714.

The Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. See Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978); Miller v. N. V. Cacao-En Chocoladefabrieken Boon, 142 USPQ 364 (E.D. N.Y. 1964); and Louise E. Fruge, TIPS FROM THE TTAB: Depositions Upon Written Questions, 70 Trademark Rep. 253 (1980). See also Jonergin Co. v. Jonergin Vermont Inc., 222 USPQ 337 (Comm'r 1983).

However, whenever a natural person who is a foreign party, or an officer, director, or managing agent, of a foreign party, or some other person who consents to testify on a foreign party's behalf, is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination upon notice pursuant to 37 CFR §2.120(c)(2). See also Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial

OLD EDITION

and Appeal Board, 75 Trademark Rep. 323 (1985); Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449 (1984). Indeed, this option was available even before the adoption of 37 CFR §2.120(c)(2). See Jonergin Co. v. Jonergin Vermont Inc., 222 USPQ 337 (Comm'r 1983), and Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978). The place, within the United States, where the deposition is to be taken is specified in 37 CFR §2.120(c)(2).

404.03(c)(2) Person Residing in Foreign Country--Nonparty

The discovery deposition of a natural person who resides in a foreign country, and is not a party, or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign country and who is a party, i.e., in the manner described in TBMP §404.03(c)(1). Cf. 37 CFR §§2.120(c) and 2.123(a).

There is no certain procedure for obtaining, in an inter partes proceeding before the Board, the discovery deposition of a natural person who resides in a foreign country, is not a party, or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, and does not agree to appear voluntarily to be deposed. However, a party may be able to obtain the discovery deposition of such a person through the letter rogatory procedure, whereby an unwilling nonparty witness in a foreign country sometimes may be compelled to respond to questions routed through diplomatic channels to an appropriate judicial authority in the foreign country. See, in general, Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). Cf. DBMS Consultants Ltd. v. Computer Associates International, Inc., 18 FR Serv3d 33, 131 FRD 367 (D. Mass. 1990).

The term "Letters rogatory" is defined in Black's Law Dictionary (Fifth Edition 1979) as follows (emphasis in last paragraph added):

> A request by one court of another court in an

OLD EDITION

> independent jurisdiction, that a witness be examined upon interrogatories sent with the request. The medium whereby one country, speaking through one of its courts, requests another country, acting through its own courts and by methods of court procedure peculiar thereto and entirely within the latter's control, to assist the administration of justice in the former country. The Signe, D.C.La., 37 F. Supp. 819, 820.
>
> A formal communication in writing, sent by a court in which an action is pending to a court or judge of a foreign country, requesting that the testimony of a witness resident within the jurisdiction of the latter court may be there formally taken under its direction and transmitted to the first court for use in the pending action. Fed.R.Civil P. 28.
>
> This process was also in use, at an early period, between the several states of the Union. The request rests entirely upon the comity of courts towards each other.

A party which wishes to have the Board issue a letter rogatory should file a written request therefor with the Board. See FRCP 28(b). The party must also submit an original and two copies of the proposed letter rogatory, and an original and two copies of the questions to be propounded to the nonparty witness. If the official language of the foreign country is not English, the propounding party must submit an original and two copies of the letter rogatory and questions in English, and an original and two copies thereof translated into the official language. In addition, the propounding party must serve upon each adverse party a copy of every paper submitted to the Board. See 37 CFR §2.119(a). Cf. 37 CFR §2.124(b)(2).

If the request is granted, each adverse party will be given an opportunity to submit cross questions, a copy of which must also be served upon the propounding party. If an adverse party does submit cross questions, the propounding party, in turn, will be given an opportunity to submit redirect

OLD EDITION

questions, a copy of which must be served upon each adverse party. Cf. 37 CFR §2.124(d)(1). As in the case of the initial questions, an original and two copies of any cross questions and redirect questions must be submitted to the Board; if the official language of the foreign country is not English, an original and two copies of the questions in English, and an original and two copies thereof translated into the official language, must be submitted.

After the original and copies of the letter rogatory, and of all of the questions, have been submitted to the Board, and the letter rogatory has been approved as to form, the letter rogatory will be issued by the Board. The letter rogatory will be signed by the Chairman of the Board; the signature will be authenticated in such a manner at to meet the requirements of the foreign country; and the original and one copy of the letter rogatory and accompanying questions will be forwarded to the United States Department of State with a transmittal letter from the Board (the remaining copy of these papers will be retained in the Board proceeding file). In its transmittal letter, the Board will request, pursuant to 28 U.S.C. §1781 (which authorizes the Department of State to, inter alia, "receive a letter rogatory issued, or request made, by a tribunal in the United States, to transmit it to the foreign or international tribunal, officer, or agency to whom it is addressed, and to receive and return it after execution"), that the Department of State transmit the letter rogatory to the appropriate judicial authority in the foreign country, and, after execution, receive it back and return it to the Board. Thereafter, the Department of State will transmit the letter rogatory, through diplomatic channels, to the appropriate judicial authority in the foreign country.

The party seeking discovery must pay all fees, including authentication, consular, and foreign government fees, charged in connection with the letter rogatory procedure. The Department of State will require the propounding party to make a deposit to cover the consular and foreign government fees. Payment may be made by certified check or money order made payable to the American Embassy/Consulate [insert the name of the appropriate city, i.e., Paris, Bonn, Tokyo, etc.]. Any unused portion of the deposit will be returned to the depositor after completion of the letter rogatory process.

Further information concerning the letter rogatory process may be obtained from the Office of Citizens Consular Services, Department of State, 2201 C Street N.W., Washington, D.C. 20520.

Once the letter rogatory has been received by the appropriate foreign judicial authority, it may or may not be executed. As indicated above, the letter rogatory

OLD EDITION

"rests entirely upon the comity of courts towards each other." Some countries refuse or are reluctant to lend assistance in the taking of a discovery deposition in their country through the letter rogatory procedure, and compliance with the procedural requirements for a letter rogatory does not ensure that the requested deposition will be completed. See NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to FRCP 28(b), and Wright & Miller, Federal Practice and Procedure: Civil 2d §2083 (1970). Before a request for issuance of a letter rogatory is filed with the Board, the requesting party should examine the law and policy of the involved foreign country, and consult with the Office of Citizens Consular Services, Department of State, in order to determine whether the country in question is likely to honor a letter rogatory, particularly a letter rogatory issued by the Board.

Even in those foreign countries which are not reluctant to execute a letter rogatory, the foreign judicial authority may refuse to honor a letter rogatory issued by the Board (an administrative tribunal) rather than by a United States district court. Further, if the foreign country has a "blocking statute" prohibiting its residents from disclosing certain types of information in judicial or administrative proceedings outside of the foreign country, a letter rogatory may not be honored if the foreign judicial authority believes that disclosure of the information requested therein would violate the blocking statute. See Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985).

If a letter rogatory is honored, its probative value may be limited. In executing the letter rogatory, the foreign judicial tribunal will follow its customary procedures for taking testimony. The fact that these procedures may differ from those normally followed in proceedings before the Board does not mean that the deposition must necessarily be excluded. Rather, any such differences are matters to be considered by the Board in determining the probative value of the deposition. See FRCP 28; NOTES OF ADVISORY COMMITTEE ON RULES, Advisory Committee Note of 1963 to FRCP 28(b); 4 Moore's Federal Practice, ¶28.05 (2d ed. 1984); and Wright & Miller, Federal Practice and Procedure: Civil 2d §2083 (1970).

A party considering the filing of a request for issuance of a letter rogatory should bear in mind not only the complexity and uncertain outcome of the procedure, but also its time-consuming nature. The entire process, from the filing of the initial request for issuance of a letter rogatory, to receipt by the Board either of the completed deposition, or of notification that the letter rogatory will not be

OLD EDITION

honored, will consume months, if not years. During the interim, proceedings in the case before the Board most likely will be suspended pending the execution and return to the Board of the letter rogatory. Cf. 37 CFR §2.124(d)(2).

The Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters (commonly known as the "Hague Convention"), opened for signature March 18, 1970, 23 U.S.T. 2555, T.I.A.S. No. 7444, prescribes procedures under which a judicial authority in one member country may request evidence located in another. The Convention offers another possible method by which a party to an inter partes proceeding before the Board may attempt to obtain the discovery deposition of an unwilling nonparty witness residing in a foreign country, if the foreign country is a member of the Convention. See, for example, Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa, 482 U.S. 522 (1987); In re Anschuetz & Co., GmbH, 838 F.2d 1362 (5th Cir. 1988); Wright & Miller, Federal Practice and Procedure: Civil 2d §2005 (1970); and Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). For general information concerning the Hague Convention, see Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991) [NOTE: this case involved the taking of discovery by interrogatories, requests for production of documents, and requests for admissions, rather than by deposition].

The Hague Convention provides for the compulsion of evidence (including the deposition of an unwilling witness) in a member country pursuant to a "letter of request," which is very similar in nature to a letter rogatory. For information concerning the letter of request procedure under the Hague Convention, see Chapter 1 of the Convention. See also Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991). However, the Board has been advised by the Department of State that foreign countries are more likely to lend assistance in the taking of a discovery deposition if the request therefor is made under the more formal letter rogatory procedure. Before filing a motion for issuance of a letter of request, the moving party should consult with the Office of Citizens Consular Services, Department of State, in order to determine whether the foreign country in question is likely to honor a letter of request, particularly a letter of request issued by the Board.

OLD EDITION

404.04 Notice of Deposition

FRCP 30(b) Notice of Examination: General Requirements; ...
(1) A party desiring to take the deposition of any person upon oral examination shall give reasonable notice in writing to every other party to the action. The notice shall state the time and place for taking the deposition and the name and address of each person to be examined, if known, and, if the name is not known, a general description sufficient to identify the person or the particular class or group to which the person belongs. ...

37 CFR §2.124(b)(2) A party desiring to take a discovery deposition upon written questions shall serve notice thereof upon each adverse party and shall file a copy of the notice, but not copies of the questions, with the Board. The notice shall state the name and address, if known, of the person whose deposition is to be taken. If the name of the person is not known, a general description sufficient to identify him or the particular class or group to which he belongs shall be stated in the notice, and the party from whom the discovery deposition is to be taken shall designate one or more persons to be deposed in the same manner as is provided by Rule 30(b)(6) of the Federal Rules of Civil Procedure.

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

In an inter partes proceeding before the Board, the discovery deposition of a natural person who is a party, or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, may be taken upon notice alone.

Prior to the taking of a discovery deposition upon notice alone, the party seeking to take the deposition ("the deposing party") must give reasonable notice in writing to every adverse party. See FRCP 30(b)(1), and 37 CFR §§2.120(c), 2.124(b)(2), and 2.124(c). Cf. 37 CFR §2.123(c); FRCP 31(a)(3); and TBMP §713.05. The elements to be included in the notice are specified in FRCP 30(b)(1), for a deposition upon oral examination, and in 37 CFR §§2.124(b)(2) and 2.124(c), for a deposition upon written questions. It is strongly recommended that the deposing party contact the party sought to be deposed (or whose officer, director, etc., is sought to be deposed) well in advance of the proposed deposition in order to arrange a mutually convenient time for the deposition. The deposition must be taken prior to the expiration of the discovery

OLD EDITION

period (unless the parties stipulate that the deposition may be taken outside of the period). See TBMP §403.02.

In noticing the deposition of a corporation, partnership, association, governmental agency, or other juristic person, the deposing party may, in lieu of naming a person to be deposed, simply name as the deponent the corporation, partnership, association, governmental agency, or other juristic person, and describe with reasonable particularity the matters on which examination is requested. The named organization must, in turn, designate one or more officers, directors, or managing agents, or other persons who consent to testify on its behalf, and may state, for each person designated, the matters on which he or she will testify. Each designated person must testify not only as to those matters within his or her knowledge, but also as to matters known or reasonably available to the organization. See FRCP 30(b)(6) and 31(a)(3), and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 383 (1985).

The discovery deposition of a person who resides in the United States must be taken in the Federal judicial district where the deponent resides or is regularly employed or at any place on which the parties agree by stipulation. See 37 CFR §2.120(b).

When the discovery deposition of a foreign party, or an officer, director, managing agent, or other person who consents to testify on behalf of a foreign party, is taken in the United States by oral examination pursuant to 37 CFR §2.120(c)(2), the deposition must be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. See 37 CFR §2.120(c)(2).

OLD EDITION

404.05 Taking a Discovery Deposition

The procedure for taking a discovery deposition in an inter partes proceeding before the Board is very similar to that for taking a testimony deposition. See Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991). For information concerning the procedure for taking a testimony deposition, see TBMP §§713 and 714. For a discussion of significant differences between the two types of depositions, see TBMP §404.02.

Upon stipulation of the parties, or upon motion granted by the Board, a deposition may be taken or attended by telephone. See FRCP 30(b)(7), and Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991). A deposition taken by telephone is taken in the Federal judicial district and at the place where the witness is to answer the questions propounded to him or her.

405 Discovery Deposition Objections

405.01 Objections to Notice

Objections to errors and irregularities in a notice of the taking of a discovery deposition must be promptly served, in writing, on the party giving the notice; any such objections which are not promptly served are waived. See FRCP 32(d)(1). Cf. 37 CFR §2.123(j). Cf. also Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991); Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984); Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802, 804 (TTAB 1982); Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), petition to Commissioner denied, 198 USPQ 485 (Comm'r 1977); O.M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976); and Allstate Life Insurance Co. v. Cuna International, Inc., 169 USPQ 313 (TTAB 1971), aff'd without opinion, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973).

OLD EDITION

405.02 Objections as to Disqualification of Officer

An objection to the taking of a discovery deposition because of a disqualification of the officer before whom the deposition is to be taken, is waived unless it is made before the deposition begins, or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence. See FRCP 32(d)(2). Cf. 37 CFR §2.123(j).

405.03 Objections During Deposition

FRCP 32(d)(3)(A) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

(B) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.

Objections to the competency of a witness or to the competency, relevancy, or materiality of discovery deposition testimony "are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time." See FRCP 32(d)(3)(A). Cf. 37 CFR §2.123(k).

In the case of a discovery deposition taken upon oral examination, objections to errors and irregularities occurring at the deposition in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of the parties, and objections to errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonably made at the deposition. See FRCP 32(d)(3)(B). Cf. 37 CFR §2.123(j).

If a party believes that a question propounded at a discovery deposition is improper, it may state its objection thereto. Questions objected to ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. See 37 CFR §2.123(e)(4); FRCP 26(b), 30(c), and 37(a); FRE 501; 4A Moore's Federal Practice, ¶30.59 (2d ed. 1984); and Wright & Miller, Federal Practice and Procedure: Civil §2113 (1970). See also Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861, 866 (TTAB 1979); and Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974).

OLD EDITION

If a witness, having stated an objection to a discovery deposition question, answers the question subject to the objection, and the deposition is subsequently made of record in the proceeding pursuant to the provisions of 37 CFR §§2.120(j)(1), (2), (3)(i), and (4), the propriety of the objection will be considered by the Board at final hearing; that is, the Board will evaluate the testimony in light of the stated objection. See 37 CFR §2.120(j)(3)(i), and Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974).

For information concerning the propounding party's options if a witness not only objects to, but also refuses to answer, a particular question, see TBMP §415.03.

406 Interrogatories

406.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written interrogatories upon any other party. See TBMP §403.01. Interrogatories may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). See TBMP §403.02.

Interrogatories may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. See TBMP §403.02.

OLD EDITION

406.02 Scope

Interrogatories may seek any information which is discoverable under FRCP 26(b)(1). See FRCP 33(c). An interrogatory which is otherwise proper is not necessarily objectionable merely because it requires a party to give an opinion or contention that relates to fact or the application of law to fact. See FRCP 33(b); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d

1671 (TTAB 1988); and Gould Inc. v. Sanyo Electric Co., 179 USPQ 313 (TTAB 1973).

406.03 Limit on Number

406.03(a) Description of Limit

37 CFR §2.120(d)(1) The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties. ...

For information concerning motions for leave to serve additional interrogatories, see TBMP §519.

406.03(b) Application of Limit: Sets of Interrogatories

The numerical limit of 37 CFR §2.120(d)(1) pertains to the total number of interrogatories that one party may serve upon another party over the course of an entire proceeding, not just per set of interrogatories. Thus, if a party to a proceeding before the Board serves, over the course of the proceeding, two or more separate sets of interrogatories directed to the same party, the interrogatories in the separate sets will be added together for purposes of determining whether the numerical limit specified in the rule has been exceeded. See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 UPSQ2d 1466 (TTAB 1990); Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886 and in the Official Gazette of September 12, 1989 at 1106 TMOG 26; and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

Accordingly, a party which is preparing a first set of interrogatories should reserve a portion of its allotted 75 interrogatories (counting subparts) to use for

OLD EDITION

follow-up discovery, unless it is sure that it will not be serving follow-up interrogatories.

406.03(c) Application of Limit: Multiple Marks, Etc.

Rule 2.120(d)(1) does not provide for extra interrogatories in cases where more than one mark is pleaded and/or attacked by the plaintiff (whether in a single proceeding, or in consolidated proceedings), because in such cases, the propounding party may simply request that each interrogatory be answered with respect to each involved mark of the responding party, and the interrogatories will be counted the same as if they pertained to only one mark. Similarly, the rule does not provide for extra interrogatories in cases where there is a counterclaim, because in a proceeding before the Board, the discovery information needed by a party for purposes of litigating the plaintiff's claim usually encompasses the information needed by that party for purposes of litigating a counterclaim. That is, the mere fact that a proceeding involves multiple marks (whether in a single proceeding, or in consolidated proceedings) and/or a counterclaim does not mean that a party is entitled to serve 75 interrogatories, counting subparts, for each mark, or for each proceeding that has been consolidated, or for both the main claim and the counterclaim. Nor does such fact, in and of itself, constitute good cause for a motion for leave to serve additional interrogatories. However, a proceeding with multiple marks and/or a counterclaim may involve unusually numerous or complex issues, and these are factors which will be considered in determining a motion for leave to serve additional interrogatories. See Notice of Final Rulemaking, published in the Federal Register on August 22, 1989 at 54 FR 34886 and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

406.03(d) Application of Limit: Counting Interrogatories

In determining whether the number of interrogatories served by one party upon another exceeds the limit of 37 CFR §2.120(d)(1), the Board will count each subpart within an interrogatory as a separate interrogatory, regardless of whether the subpart is separately designated (i.e., separately numbered or lettered). See

OLD EDITION

Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990); Pyttronic Industries, Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990); Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990); Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990); and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

If an interrogatory includes questions set forth as numbered or lettered subparts, each separately designated subpart will be counted by the Board as a separate interrogatory. The propounding party will, to that extent, be bound by its own numbering system, and will not be heard to complain that an interrogatory, although propounded with separately designated subparts, should nevertheless be counted as a single interrogatory because the interrogatory concerns a single transaction, state of facts, etc., or because the division was made for clarification or convenience. See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990); Pyttronic Industries, Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990); and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

On the other hand, if a propounding party sets forth its interrogatories as 75 or fewer separately designated questions (counting both separately designated interrogatories and separately designated subparts), but the interrogatories actually contain more than 75 questions, the Board will not be bound by the propounding party's numbering or designating system. Rather, the Board will look to the substance of the interrogatories, and count each question as a separate interrogatory. See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990), and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

For example, if two or more questions are combined in a single compound interrogatory, and are not set out as separate subparts, the Board will look to the substance of the interrogatory, and count each question as a separate interrogatory. See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990); Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990); and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

OLD EDITION

If an interrogatory contains both an initial question, and follow-up questions to be answered if the first is answered in the affirmative, the initial question and each follow-up question will be counted as separate interrogatories. See Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990), and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

Similarly, if an interrogatory begins with a broad introductory clause ("Describe fully the facts and circumstances surrounding applicant's first use of the mark XYZ, including:") followed by several subparts ("Applicant's date of first use of the mark on the goods listed in the application," "Applicant's date of first use of the mark on such goods in commerce," etc.), the Board will count the broad introductory clause and each subpart as a separate interrogatory, whether or not the subparts are separately designated. Cf. Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990), and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

If an interrogatory requests information concerning more than one issue, such as information concerning both "sales and advertising figures," or both "adoption and use," the Board will count each issue on which information is sought as a separate interrogatory. In contrast, if an interrogatory requests "all relevant facts and circumstances" concerning a single issue, event, or matter; or asks that a particular piece of information, such as, for example, annual sales figures under a mark, be given for multiple years, and/or for each of the responding party's involved marks, it will be counted as a single interrogatory. See Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990), and Notice of Final Rulemaking, published in the Federal Register on August 22, 1989 at 54 FR 34886 and in the Official Gazette of September 12, 1989 at 1106 TMOG 26.

The introductory instructions or preamble to a set of interrogatories will not be counted by the Board as interrogatories or subparts for purposes of determining whether the limit specified in 37 CFR §2.120(d)(1) has been exceeded. On the other hand, the Board's determination, on a motion to compel, of the adequacy of an interrogatory answer will not be governed by the introductory instructions or preamble; the Board is not bound by the instructions or preamble, and will make its own independent determination of the adequacy of the answer, without regard to the instructions or preamble. See Avia Group International Inc. v. Faraut, 25

OLD EDITION

USPQ2d 1625 (TTAB 1992), and Carla Calcagno, TIPS FROM THE TTAB: Discovery Practice Under Trademark Rule 2.120(d)(1), 80 Trademark Rep. 285 (1990).

406.03(e) Remedy for Excessive Interrogatories

37 CFR §2.120(d)(1) ... If a party upon which interrogatories have been served believes that the number of interrogatories served exceed the limitation specified in this paragraph, and is not willing to waive this basis for objection, the party shall, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. If the inquiring party, in turn, files a motion to compel discovery, the motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of paragraph (e) of this section.

If a party upon which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. See 37 CFR §2.120(d)(1); Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992).

If a general objection on the ground of excessive number is asserted, and the propounding party, in turn, believes that the objection is not well taken, and wishes to obtain an adjudication from the Board as to the sufficiency thereof, the propounding party must file a motion to compel discovery. The motion must be accompanied by a copy of the set(s) of interrogatories which together are said to exceed the limitation, and must otherwise comply with the requirements of Rule 2.120(e), including the requirement that a motion to compel be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other

OLD EDITION

party or its attorney the issues presented in the motion and has been unable to reach agreement. See 37 CFR §§2.120(d)(1) and 2.120(e); Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992). For further information concerning motions to compel discovery, see TBMP §523.

If, upon determining a motion to compel filed in response to a general objection to interrogatories on the ground of excessive number, the Board finds that the interrogatories are excessive in number, and that the propounding party has not previously used up its allotted 75 interrogatories, the Board normally will allow the propounding party an opportunity to serve a revised set of interrogatories not exceeding the numerical limit. The revised set of interrogatories serves as a substitute for the excessive set, and thus is deemed timely if the excessive set was timely. See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990); Pyttronic Industries, Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990); Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990); Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., 16 USPQ2d 1398 (TTAB 1990); Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990); See Rule 2.120(d)(1); Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992). Cf. Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 UPSQ2d 1466 (TTAB 1990). However, if the revised set is not served until after the close of the discovery period, the scope of the revised set may not exceed the scope of the excessive set, that is, the revised set may not seek information not sought in the excessive set. See Jan Bell Marketing, Inc. v. Centennial Jewelers, Inc., 19 USPQ2d 1636 (TTAB 1990); Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990); Notice of Final Rulemaking, supra; and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), supra. In those cases where a party which has propounded

OLD EDITION

interrogatories realizes, upon receipt of a general objection thereto on the ground of excessive number, that the interrogatories are, in fact, excessive in number, it is strongly recommended that the parties voluntarily agree to the service of a revised set of interrogatories, in the manner normally allowed by the Board, instead of bringing their dispute to the Board by motion to compel. See Notice of Final Rulemaking, supra, and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), supra.

407 Responses to Interrogatories

407.01 Time for Service of Responses

Responses to interrogatories must be served within 30 days after the date of service of the interrogatories, except that a defendant may serve responses either within 30 days after service of the interrogatories, or within 45 days after service of the complaint upon it by the Board, whichever is later. See TBMP §403.03. If service of the interrogatories is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the interrogatories. See 37 CFR §2.119(c), and TBMP §§113.05 and 403.03.

A party which fails to respond to interrogatories during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the interrogatories on their merits. See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); and Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975).

407.02 Nature of Responses

OLD EDITION

Ordinarily, a party upon which interrogatories have been served should respond to them by stating, with respect to each interrogatory, either an answer or an objection. If an interrogatory is answered, the answer must be made separately and fully, in writing under oath. If an interrogatory is objected to, the reasons for objection must be stated in lieu of an answer. See FRCP 33(b). If a responding party believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number. See 37 CFR §2.120(d)(1), and TBMP §406.03(e).

The Board prefers that the responding party reproduce each interrogatory immediately preceding the answer or objection thereto. See G. Douglas Hohein, TIPS FROM THE TTAB: Potpourri, 71 Trademark Rep. 163 (1981).

In some cases, the information sought in an interrogatory may be derived or ascertained from the business records of the responding party, or from an examination, audit, or inspection of those business records (including a compilation, abstract, or summary thereof), and the burden of deriving or ascertaining the information is substantially the same for the propounding party as for the responding party. In those cases, the responding party may answer the interrogatory by itself providing, in its written answer to the interrogatory, the information sought. Alternatively, the responding party may answer the interrogatory by specifying the records from which the information may be derived or ascertained, and affording to the propounding party reasonable opportunity to examine, audit, or inspect the records and to make copies, compilations, abstracts, or summaries. If the responding party elects to answer an interrogatory by specifying and producing business records, the specification must be in sufficient detail to permit the propounding party to locate and identify, as readily as can the responding party, the records from which the answer may be ascertained. See FRCP 33(c).

It is generally inappropriate for a party to respond to interrogatories by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those interrogatories which it believes to be proper and stating its objections to those which it believes to be improper. See TBMP §414.

OLD EDITION

407.03 Signature of Responses

Interrogatories must be answered by the party served. If the party served is a corporation, partnership, association, or governmental agency, the interrogatories must be answered by an officer or agent, who must furnish whatever information is available to the party served. See FRCP 33(a) and (b).

The term "agent" includes an attorney, who may answer even though he has no personal knowledge of the facts stated in the answers; the attorney's answers, like an officer's answers, must contain the information available to the party served. See Allstate Insurance Co. v. Healthy America Inc., 9 USPQ2d 1663 (TTAB 1988). However, an attorney who answers interrogatories on behalf of a corporation, partnership, association, or governmental agency may thereafter be exposed to additional discovery and possibly even disqualification. See 37 CFR §10.63, and Allstate Insurance Co. v. Healthy America Inc., supra.

Answers to interrogatories must be signed by the person making them, and objections to interrogatories must be signed by the attorney making them. See FRCP 33(b)(2).

OLD EDITION

408 Requests for Production of Documents and Things

408.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve requests for production of documents and things upon any other party. See FRCP 34(a); Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978); and TBMP §403.01. Requests for production may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). See TBMP §403.02.

Requests for production may be served upon an adversary through the last day of discovery, even though the answers thereto will not be served until after the discovery period has closed. See TBMP §403.02.

If requests for production are combined with a notice of taking a discovery deposition (i.e., if it is requested that the deponent bring designated documents to the deposition), the requests for production must be served at least 35 days prior the the scheduled date of the deposition if service of the requests for production is made by first-class mail, "Express Mail," or overnight courier, and at least 30 days prior to the deposition if service of the requests for production is made by one of the other methods specified in 37 CFR §2.119(b). See FRCP 34(b); 37 CFR §2.119(c); and TBMP §§113.04, 113.05, and 403.03. Further, since a defendant may respond to requests for production either within 30 days after service of the requests (35 days if service of the requests is made by first-class mail, "Express Mail," or overnight courier), or within 45 days after service of the complaint upon it by the Board, whichever is later, a defendant cannot be required to produce documents at a deposition any earlier than 45 days after service of the complaint upon it by the Board.

If a discovery deposition deponent is a nonparty witness residing in the United States (see TBMP §404.03(b)(2)), production of designated documents by the witness at the deposition may be obtained by subpoena. See FRCP 45 and 35 U.S.C. §24. A subpoena in unnecessary, however, if the nonparty witness is willing to produce the documents voluntarily.

OLD EDITION

408.02 Scope

FRCP 34(a) Scope. Any party may serve on any other party a request (1) to produce and permit the party making the request, or someone acting on the requestor's behalf, to inspect and copy, any designated documents (including writings, drawings, graphs, charts, photographs, phonorecords, and other data compilations from which information can be obtained, translated, if necessary, by the respondent through detection devices into reasonably usable form), or to inspect and copy, test, or sample any tangible things which constitute or contain matters within the scope of Rule 26(b) and which are in the possession, custody or control of the party upon whom the request is served; or (2) to permit entry upon designated land or other property in the possession or control of the party upon whom the request is served for the purpose of inspection and measuring,

surveying, photographing, testing, or sampling the property or any designated object or operation thereon, within the scope of Rule 26(b).

The scope of a request for production, in an inter partes proceeding before the Board, is governed by FRCP 34(a), which in turn refers to FRCP 26(b). For a discussion of the scope of discovery permitted under FRCP 26(b), see TBMP §§402.01 and 402.02.

Because proceedings before the Board involve only the right to register trademarks, the request for entry upon land for inspection and other purposes is rarely, if ever, used in Board proceedings.

OLD EDITION

408.03 Elements of Request for Production; Place of Production

FRCP 34(b) Procedure. The request shall set forth, either by individual item or by category, the items to be inspected, and describe each with reasonable particularity. The request shall specify a reasonable time, place, and manner of making the inspection and performing the related acts. ...

37 CFR §2.120(d)(2) The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

A request for production must include the elements specified in FRCP 34(b), as set forth above.

The place of production is governed by 37 CFR §2.120(d)(2). See also Unicut Corp. v. Unicut, Inc., 220 USPQ 1013 (TTAB 1983); Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449, 451 (1984). Upon motion pursuant to 37 CFR §2.120(d)(2), the Board may, for example, order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party, all at the requesting party's expense. See Unicut Corp. v. Unicut, Inc., supra; Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 385

(1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, supra.

409 Responses to Requests for Production

409.01 Time for Service of Responses

Responses to requests for production must be served within 30 days after the date of service of the requests, except that a defendant may serve responses either within 30 days after service of the requests, or within 45 days after service of the complaint upon it by the Board, whichever is later. See TBMP 403.03. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. See 37 CFR §2.119(c) and TBMP §§113.05 and 403.03.

A party which fails to respond to requests for production during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the requests on their merits. See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); and Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975).

OLD EDITION

409.02 Nature of Responses

A response to a request for production of documents and things must state, with respect to each item or category of documents or things requested to be produced, that inspection and related activities will be permitted as requested, unless the request is objected to, in which case the reasons for objection must be stated. If objection is made to only part of an item or category, the part must be specified. See FRCP 34(b).

A party which produces documents for inspection must produce them as they are kept in the usual course of business, or must organize and label them to correspond with the categories in the request. See FRCP 34(b).

It is generally inappropriate for a party to respond to requests for production by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by indicating, with respect to those requests which it believes to be proper, that inspection and related activities will be permitted, and by stating reasons for objection with respect to those requests which it believes to be improper. See TBMP §414.

OLD EDITION

410 Requests for Admission

410.01 When and By Whom Served

During the discovery period in an inter partes proceeding before the Board, any party may serve written requests for admission upon any other party. See FRCP 36(a), and TBMP §403.01. Requests for admission may be served upon the plaintiff after the proceeding commences (i.e., after the notice of opposition or petition to cancel is filed, in an opposition or cancellation, or after the notice of institution is mailed, in an interference or concurrent use proceeding), and upon the defendant with or after service by the Board of the "complaint" (i.e., the notice of opposition or petition for cancellation, in an opposition or cancellation proceeding; and the notice of institution, in an interference or concurrent use proceeding). See TBMP §403.02.

Requests for admission may be served upon an adversary through the last day of discovery, even though the responses thereto will not be served until after the discovery period has closed. See TBMP §403.02.

410.02 Scope and Nature of Requests for Admission

FRCP 36(a) Request for Admission. A party may serve upon any other party a written request for the admission, for purposes of the pending action only, of the truth of any matters within the scope of Rule 26(b)(1) set forth in the request that

relate to statements or opinions of fact or of the application of law to fact, including the genuineness of any documents described in the request. Copies of documents shall be served with the request unless they have been or are otherwise furnished or made available for inspection and copying. ...

Each matter of which an admission is requested shall be separately set forth. ...

The scope and nature of requests for admission, in inter partes proceedings before the Board, are governed by FRCP 36(a), which in turn refers to FRCP 26(b)(1). For a discussion of the scope of discovery permitted under FRCP 26(b)(1), see TBMP §402.01. See also TBMP §402.02.

Requests for admission are particularly useful for determining, prior to trial, which facts are not in dispute, thereby narrowing the matters which must be tried. Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 385 (1985). These requests are also useful as a means of facilitating the introduction into evidence of documents produced by an adversary in response to a request for production of documents. See TBMP §403.05(c).

OLD EDITION

411 Responses to Requests for Admission

411.01 Time for Service of Responses

Responses to requests for admission must be served within 30 days after the date of service of the requests, except that a defendant may serve responses either within 30 days after service of the requests, or within 45 days after service of the complaint upon it, whichever is later. See TBMP §403.03. If service of the requests is made by first-class mail, "Express Mail," or overnight courier, the date of mailing or of delivery to the overnight courier is considered to be the date of service, and five extra days are allowed for responding to the requests. See 37 CFR §2.119(c), and TBMP §§113.05 and 403.03.

If a party upon which requests for admission have been served fails to timely respond thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to FRCP 36(b), and granted by the Board. See FRCP 6(b) and 36(a); Hobie Designs Inc. v. Fred

Hayman Beverly Hills Inc., 14 USPQ2d 2064 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); BankAmerica Corp. v. International Travelers Cheque Co., 205 USPQ 1233 (TTAB 1979); and Questor Corp. v. Dan Robbins & Associates, Inc., 199 USPQ 358 (TTAB 1978), aff'd, Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 202 USPQ 100 (CCPA 1979). Cf. Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); and Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975). For information concerning motions pursuant to FRCP 36(b) to withdraw or amend admissions, see TBMP §525.

OLD EDITION

411.02 Nature of Responses

Responses to requests for admission must be made in writing, and should include an answer or objection to each matter of which an admission is requested. See FRCP 36(a).

The Board prefers that the responding party reproduce each request immediately preceding the answer or objection thereto. See G. Douglas Hohein, TIPS FROM THE TTAB: Potpourri, 71 Trademark Rep. 163 (1981).

An answer must admit the matter of which an admission is requested; deny the matter; or state in detail the reasons why the responding party cannot truthfully admit or deny the matter. "A denial shall fairly meet the substance of the requested admission, and when good faith requires that a party qualify an answer or deny only a part of the matter of which an admission is requested, the party shall specify so much of it as is true and qualify or deny the remainder. An answering party may not give lack of information or knowledge as a reason for failure to admit or deny unless the party states that the party has made reasonable inquiry and that the information known or readily obtainable by the party is insufficient to enable the party to admit or deny." See FRCP 36(a).

If the responding party objects to a request for admission, the reasons for objection must be stated. If a responding party believes that a matter of which an admission has been requested presents a genuine issue for trial, the party may not object to the request on that ground alone. Rather, the party may deny the

matter; alternatively, the party may set forth reasons why it cannot admit or deny the matter. See FRCP 36(a).

It is generally inappropriate for a party to respond to requests for admission by filing a motion attacking them, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by answering those requests which it believes to be proper and stating its reasons for objection to those which it believes to be improper. See TBMP §414.

411.03 Signature of Responses

Answers and objections to requests for admission may be signed either by the responding party, or by its attorney. See FRCP 36(a).

411.04 Effect of Admission

Any matter admitted (either expressly, or for failure to timely respond) under FRCP 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. See FRCP 36(b). See also American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C., 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991). For further information concerning motions to withdraw or amend an admission, see TBMP §525.

An admission made by a party under FRCP 36 is only for the purpose of the pending proceeding. It is not an admission for any other purpose, nor may it be used against that party in any other proceeding. See FRCP 36(b).

412 Duties to Cooperate, Search Records, Supplement

412.01 Duty to Cooperate

The Board expects parties (and their attorneys or other authorized representatives) to cooperate with one another in the discovery process, and looks with extreme disfavor upon those who do not. Each party and its attorney or

OLD EDITION

other authorized representative has a duty not only to make a good faith effort to satisfy the discovery needs of its adversary, but also to make a good faith effort to seek only such discovery as is proper and relevant to the issues in the case. See, for example FRCP 26(g); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986); Unicut Corp. v. Unicut, Inc., 222 USPQ 341 (TTAB 1984); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); C. H. Stuart Inc. v. Carolina Closet, Inc., 213 USPQ 506 (TTAB 1980); C. H. Stuart Inc. v. S. S. Sarna, Inc., 212 USPQ 386 (TTAB 1980); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); Tektronix, Inc. v. Tek Associates, Inc., 183 USPQ 623 (TTAB 1974); and Gastown Inc. of Delaware v. Gas City, Ltd., 180 USPQ 477 (TTAB 1974). Cf. Micro Motion Inc. v. Kane Steel Co., 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990).

It should be noted, in this regard, that under the provisions of FRCP 26(g), the signature of an attorney or party to a discovery request, response, or objection:

> constitutes a certification that to the best of the signer's knowledge, information, and belief, formed after a reasonable inquiry, the request, response, or objection is:
>
> > (A) consistent with [the Federal Rules of Civil Procedure] and warranted by existing law or a good faith argument for the extension, modification or reversal of existing law;
> > (B) not interposed for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation; and
> > (C) not unreasonable or unduly burdensome or expensive, given the needs of the case, the discovery already had in the case, the amount in controversy, and the importance of the issues at stake in the litigation.

See also Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990). Cf. 37 CFR §10.18(a); FRCP 11; and TBMP §106.02. Provision

OLD EDITION

is made, in FRCP 26(g), for the imposition of appropriate sanctions if a certification is made in violation of the rule.

Because the signature of a party or its attorney to a request for discovery constitutes a certification by the party or its attorney that, inter alia, the request is warranted, consistent with the Federal Rules of Civil Procedure, and not unreasonable or unduly burdensome, a party ordinarily will not be heard to contend that a request for discovery is proper when propounded by the party itself but improper when propounded by its adversary. See Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990); Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); Tektronix, Inc. v. Tek Associates, Inc., 183 USPQ 623 (TTAB 1974); and Gastown Inc. of Delaware v. Gas City, Ltd., 180 USPQ 477 (TTAB 1974). A contention of this nature will be entertained only if it is supported by a persuasive showing of reasons why the discovery request is proper when propounded by one party but improper when propounded by another. Miss America Pageant v. Petite Productions, Inc., supra.

OLD EDITION

412.02 Duty to Search Records

A party served with a request for discovery has a duty to thoroughly search its records for all information properly sought in the request, and to provide such information to the requesting party within the time allowed for responding to the request. A responding party which, due to an incomplete search of its records, provides an incomplete response to a discovery request, may not thereafter rely at trial on information from its records which was properly sought in the discovery request but was not included in the response thereto (provided that the requesting party raises the matter by objecting to the evidence in question). See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987).

412.03 Duty to Supplement Discovery Response

FRCP 26(e) Supplementation of ... Responses. A party who has ... responded to a request for discovery with a ... response is under a duty to supplement or

correct the ... response to include information thereafter acquired if ordered by the court or in the following circumstances:

* * *

(2) A party is under a duty seasonably to amend a prior response to an interrogatory, request for production, or request for admission if the party learns that the response is in some material respect incomplete or incorrect and if the additional or corrective information has not otherwise been made known to the other parties during the discovery process or in writing.

The duty to supplement discovery responses in proceedings before the Board is governed by FRCP 26(e)(2). See 37 CFR §2.116(a), and "Effect of December 1, 1993 Amendments to the Federal Rules of Civil Procedure on Trademark Trial and Appeal Board Inter Partes Proceedings," 1159 TMOG 14 (February 1, 1994). Under that rule, a party which has responded to a request for discovery with a response is under a duty to supplement or correct the response to include information thereafter acquired under the particular circumstances specified in paragraph (e)(2). In addition, a duty to supplement responses may be imposed by order of the Board. Cf. P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 USPQ 431 (TTAB 1985); and JSB International, Inc. v. Auto Sound North, Inc., 215 USPQ 60 (TTAB 1982).

OLD EDITION

413 Filing Discovery Requests and Responses With Board

Discovery requests, discovery responses, and materials or depositions obtained through the discovery process, should not be filed with the Board except when submitted:

(1) With a motion relating to discovery [i.e., motion to compel, motion to determine the sufficiency of an answer or objection to a request for admission, motion for leave to serve additional interrogatories, etc.];

(2) In support of or in response to a motion for summary judgment;

(3) Under a notice of reliance during a party's testimony period; or

(4) As exhibits to a testimony deposition.

See 37 CFR §§2.120(j)(6) and (j)(8), and Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34888, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 28. See also Chicago Corp. v. North American Chicago Corp., 16 USPQ2d 1479 (TTAB 1990); Kellogg Co. v. Pack'Em Enterprises, Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Midwest Plastic Fabricators, Inc. v. Underwriters Laboratories, Inc., 5 USPQ2d 1067 (TTAB 1987); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); and G. Douglas Hohein, TIPS FROM THE TTAB: Potpourri, 71 Trademark Rep. 163, 166-167 (1981) (but note that this article was written prior to the rule changes adopted in the Notice of Final Rulemaking cited above, as well as those adopted in the Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13).

In addition, a plaintiff may file discovery requests with its complaint, for later service upon the defendant, by the Board, with defendant's copies of the complaint and notification letter (cf. TBMP §§315.01 and 403.02).

Finally, when a party objects to proffered evidence on the ground that it should have been, but was not, provided in response to a request for discovery, a copy of the pertinent discovery request(s) and response(s) should be submitted in support of the objection.

Discovery papers or materials filed with the Board under circumstances other than those specified above may be returned to the party which filed them. See 37 CFR §2.120(j)(8).

OLD EDITION

414 Motions Attacking Requests for Discovery

The rules governing discovery in proceedings before the Board provide both for the assertion of objections to discovery requests believed to be improper, and a means (namely, the motion to compel, in the case of discovery depositions, interrogatories, and requests for production; and the motion to test the sufficiency of answers or objections, in the case of requests for admission) for testing the sufficiency of those objections. It is generally inappropriate for a party to

respond to a request for discovery by filing a motion attacking it, such as a motion to strike, a motion to suppress, a motion for a protective order, etc. Rather, the party ordinarily should respond by providing the information sought in those portions of the request which it believes to be proper, and stating its objections to those which it believes to be improper. See Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc., 191 USPQ 127 (TTAB 1976); Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 188 USPQ 690 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); Dow Corning Corp. v. Doric Corp., 183 USPQ 126 (TTAB 1974); and Atwood Vacuum Machine Co. v. Automation Industries, Inc., 181 USPQ 606 (TTAB 1974).

Further, if a party upon which interrogatories have been served, in a proceeding before the Board, believes that the number of interrogatories served exceeds the limit specified in 37 CFR §2.120(d)(1), and wishes to object to the interrogatories on this basis, the responding party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, serve a general objection on the ground of their excessive number; a motion for a protective order is not the proper method for raising the objection of excessive number. See 37 CFR §2.120(d)(1); Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; TBMP section 406.03(e); and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992).

Nevertheless, there are some situations in which a party may properly respond to a request for discovery by filing a motion attacking it.

In cases where a request for discovery constitutes clear harassment, or where a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest, the party upon which the request was served may properly respond to it by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. See, for example 37 CFR §2.120(f); FRCP 26(c); and Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976). Alternatively, if the discovery sought is a discovery deposition, and the request therefor constitutes harassment, there is insufficient notice, etc.,

OLD EDITION

the party upon which the request was served may file a motion to quash the notice of deposition. See Kellogg Co. v. New Generation Foods Inc., 6 USPQ2d 2045 (TTAB 1988). For information concerning motions to quash a notice of deposition, see TBMP §521.

415 Remedy for Failure to Provide Discovery

415.01 Interrogatories or Requests for Production

If any party fails to answer any interrogatory, the party seeking discovery may file a motion with the Board for an order to compel an answer. Similarly, if any party fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion for an order to compel production and an opportunity to inspect and copy. See 37 CFR §2.120(e). Cf. FRCP 37(a)(2)(B). For information concerning motions to compel, see TBMP §523.

OLD EDITION

415.02 Requests for Admission

If a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted unless the party is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to FRCP 36(b), and granted by the Board. See TBMP §411.01. For information concerning motions to withdraw or amend admissions, see TBMP §525.

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the answer or objection. See 37 CFR §2.120(h), and FRCP 36(a). If the Board determines that an answer does not comply with the requirements of FRCP 36(a), it may order either that the matter is admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. See FRCP 36(a). For information concerning motions to determine the sufficiency of answers or objections to requests for admission, see TBMP §524.

415.03 Discovery Depositions

If a party fails to designate a person pursuant to FRCP 30(b)(6) or FRCP 31(a)(3), or if a party or such designated person, or an officer, director or managing agent of a party, fails to attend a discovery deposition, or fails to answer any question propounded in a discovery deposition, the party seeking discovery may file a motion with the Board for an order to compel a designation, or attendance at a deposition, or an answer. See 37 CFR §2.120(e). Cf. FRCP 37(a). For information concerning motions to compel, see TBMP §523.

A discovery deposition is taken out of the presence of the Board, and if a witness objects to, and refuses to answer, a particular question, and the propounding party wishes to obtain an immediate ruling on the propriety of the objection, it may do so only by adjourning the deposition and applying, under 35 U.S.C. §24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. See Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974). Cf. Ferro Corp. v. SCM Corp., 219 USPQ 346 (TTAB 1983); S. Rudofker's Sons, Inc. v. "42" Products, Ltd., 161 USPQ 499 (TTAB 1969); and Bordenkircher v. Solis Entrialgo y Cia., S. A., 100 USPQ 268, 276-278 (Comm'r 1953). In the absence of a court order compelling an answer, the propounding party's only alternative, if it wishes to compel an answer, is to complete the deposition and then file a motion to compel with the Board. See 37 CFR §2.120(e), and Neville Chemical Co. v. Lubrizol Corp., supra.

OLD EDITION

416 Protective Orders

416.01 Upon Motion

Upon motion, showing good cause, by a party from which discovery is sought, the Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders described in clauses (1) through (8) of FRCP 26(c). See 37 CFR §2.120(f).

For information concerning motions for a protective order, see TBMP §526. See also TBMP §§120.03, 527.01, and 713.16.

416.02 Upon Stipulation

Subject to the approval of the Board, parties to proceedings before the Board may, and often do, enter into stipulated protective orders, that is, agreements as to specified procedures and restrictions that shall govern the disclosure of any confidential or trade secret information. See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981).

Only confidential or trade secret information should be filed pursuant to a stipulated protective order. Such an order may not be used as a means of circumventing paragraphs (d) and (e) of 37 CFR §2.27, which provide, in essence, that except for matter filed under seal pursuant to a protective order issued by a court or by the Board, the file of a published application or issued registration, and all proceedings relating thereto, are available for public inspection. See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, supra.

OLD EDITION

416.03 In Camera Inspection

In situations where there is a dispute between the parties to a proceeding as to the relevance and/or confidentiality of a document, or portions thereof, sought to be discovered, and the Board cannot determine from the arguments of the parties, upon motion to compel production, whether the document is relevant and/or confidential, the Board may request that a copy of the document be submitted to the Board for an in camera inspection, after which the document will be returned to the party which submitted it. See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981).

416.04 Contents of Protective Order

Typically, a protective order contains provisions such as the following:

(1) A definition of the type of material to be considered confidential or trade secret information.

(2) A description of the manner in which confidential or trade secret information is to be handled.

(3) A requirement that a party claiming confidentiality or trade secret designate the information covered by the claim prior to disclosure of the information to the discovering party.

(4) A provision that a party may not designate information as confidential or trade secret unless the party has a reasonable basis for believing that the information is, in fact, confidential or trade secret in nature.

(5) A provision that information designated by the disclosing party as confidential or trade secret may not include information which, at or prior to disclosure thereof to the discovering party, is known to or independently developed by the discovering party; or is public knowledge or becomes available to the public without violation of the agreement.

(6) A provision that information designated by the disclosing party as confidential or trade secret may not include information which, after the disclosure thereof, is revealed to the public by a person having the unrestricted right to do so.

(7) A provision that information designated by the disclosing party as confidential or trade secret may not include information which is acquired by the discovering party from a third party which lawfully possesses the information and/or owes no duty of nondisclosure to the party providing discovery.

(8) A specification of the persons to whom confidential or trade secret information may be disclosed (i.e., outside counsel; house counsel; counsel's necessary legal and clerical personnel; etc.).

(9) A provision that all persons to whom confidential or trade secret information is disclosed shall be advised of the existence and terms of the protective order.

OLD EDITION

(10) A provision that the discovering party will not disclose or make use of confidential or trade secret information provided to it under the order except for purposes of the proceeding in which the information is provided.

(11) A means for resolving disputes over whether particular matter constitutes confidential or trade secret information.

(12) A provision that if material designated as confidential or trade secret is made of record in the proceeding, it shall be submitted to the Board in a separate sealed envelope or other sealed container bearing the proceeding number and name, an indication of the general nature of the contents of the container, and, in large letters, the designation "CONFIDENTIAL."

(13) A statement that at the end of the proceeding, each party shall return to the disclosing party all confidential information and materials, including all copies, summaries, and abstracts thereof.

See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975).

OLD EDITION

416.05 Signature of Protective Order

Stipulated protective orders may be signed either by the parties thereto, or by their attorneys, or by both. However, once a proceeding before the Board has been finally determined, the Board has no further jurisdiction over the parties thereto. Thus, it may be advisable for both the parties and their attorneys to sign a stipulated protective order, so that it is clear that they are all bound thereby; that they have created a contract which will survive the proceeding; and that there may be a remedy at court for any breach of that contract which occurs after the conclusion of the Board proceeding. See Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552, 1555 (TTAB 1987). See also, with respect to violation of a Board protective order after the conclusion of the Board proceeding Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

416.06 Filing Confidential Materials With Board

In the event that material designated as confidential (including trade secret material) is made of record in the proceeding, it should be submitted to the Board in a separate sealed envelope or other sealed container prominently marked with the word "CONFIDENTIAL." Many attorneys also like to attach to the sealed envelope or other sealed container a statement such as the following:

> FILED UNDER SEAL SUBJECT TO PROTECTIVE ORDER.
> The materials contained in this envelope have been designated confidential, pursuant to a protective order, and are not to be disclosed or revealed except to the Trademark Trial and Appeal Board and counsel for the parties, or by order of a court.

The envelope or other container should also bear information identifying the proceeding in connection with which it is filed (i.e., the proceeding number and name), and an indication of the nature of the contents of the container (i.e., "Applicant's Answers to Opposer's Interrogatories 8 and 19," "Pages 22-26 From the Discovery Deposition of John Doe," "Opposer's Exhibits 3-5 to the Discovery Deposition of John Smith," etc.).

Only the particular discovery responses, exhibits, deposition transcript pages, or pages of a brief which have been designated confidential should be filed under seal pursuant to a protective order. Discovery responses, exhibits, deposition transcript pages, or pages of a brief which are not confidential should not be filed under seal along with the confidential ones.

See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981).

416.07 Handling of Confidential Materials By Board

Confidential materials (including trade secret information) filed under seal subject to a protective order are stored by the Board in a locked file cabinet, and are disclosed only to the Board and to those people specified in the protective

OLD EDITION

order as having the right to access. See Rany L. Simms, TIPS FROM THE TTAB: Stipulated Protective Agreements, 71 Trademark Rep. 653 (1981), and TBMP sections 120.03 and 121.02. For information concerning access to protective order materials during an appeal from the decision of the Board, see TBMP §904. After the proceeding before the Board has been finally determined, all confidential materials are returned to the party which submitted them.

417 Telephone and Pre-Trial Conferences

When appropriate and necessary, a motion relating to discovery may be resolved by telephone conference, or by pre-trial conference at the offices of the Board. In either case, the conference will involve the parties or their attorneys and an Attorney-Advisor, or a Member, or the Board. See 37 CFR §2.120(i). For further information concerning the resolution of motions by telephone and pre-trial conference, see TBMP §502.07.

OLD EDITION

418 Discovery Sanctions

In inter partes proceedings before the Board, a variety of sanctions may be imposed, in appropriate cases, for failure to provide discovery. For information concerning the nature of these sanctions, and when they are available, see TBMP §527.

419 Discovery Guidelines

Listed below are guidelines, with case citations, relating to the discoverability of a variety of matters:

(1) The identification of discovery documents (as opposed to their substance) is not privileged or confidential. See Goodyear Tire & Rubber Co. v. Tyrco Industries, 186 USPQ 207 (TTAB 1975), and Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975).

(2) In those cases where complete compliance with a particular request for discovery would be unduly burdensome, the Board may permit the responding party to comply by providing a representative sampling of the information sought, or some other reduced amount of information which is nevertheless sufficient to meet the propounding party's discovery needs. See, for example British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); Van Dyk Research Corp. v. Xerox Corp., 181 USPQ 346 (TTAB 1974); and Mack Trucks, Inc. v. Monroe Auto Equipment Co., 181 USPQ 286 (TTAB 1974).

(3) The classes of customers for a party's involved goods or services are discoverable. In contrast, the names of customers constitute confidential information, and generally are not discoverable, even under protective order. However, the name of the first customer for a party's involved goods or services sold under its involved mark, and, if there is a question of abandonment, the names of a minimal number of customers for the period in question, may be discoverable under protective order. See Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975); Miller & Fink Corp. v. Servicemaster Hospital Corp., 184 USPQ 495 (TTAB 1975); Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(4) Information concerning a party's selection and adoption of its involved mark is generally discoverable (particularly of a defendant). See Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); Goodyear Tire & Rubber Co. v. Tyrco Industries, 186 USPQ 207 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); and Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974).

OLD EDITION

(5) Information concerning a party's first use of its involved mark is discoverable. See, for example Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976), and Miller & Fink Corp. v. Servicemaster Hospital Corp., 184 USPQ 495 (TTAB 1975). See also Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991).

(6) Search reports are discoverable, but the comments or opinions of attorneys relating thereto are privileged and not discoverable (unless the privilege is waived). See Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980); Goodyear Tire & Rubber Co. v. Tyrco Industries, 186 USPQ 207 (TTAB 1975); Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc., 185 USPQ 432 (TTAB 1975); and Amerace Corp. v. USM Corp., 183 USPQ 506 (TTAB 1974).

(7) A party need not, in advance of trial, specify in detail the evidence it intends to present, or identify the witnesses it intends to call, except that the names of expert witnesses intended to be called are discoverable. See British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989); Polaroid Corp. v. Opto Specs, Ltd., 181 USPQ 542 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(8) A party's plans for expansion may be discoverable under protective order. See Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988).

(9) Information concerning the use and/or registration by third parties of the same or similar marks for the same or closely related goods or services as an involved mark and goods or services is discoverable, but only to the extent that the responding party has actual knowledge thereof (without performing an investigation), and that the information appears to be reasonably calculated to lead to the discovery of admissible evidence. See Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons, 201 USPQ 531 (TTAB 1979).

(10) Information concerning litigation and controversies between a responding party and third parties based on the responding party's involved mark

OLD EDITION

is discoverable. However, the only information which must be provided with respect to a legal proceeding is the names of the parties thereto, the jurisdiction, the proceeding number, the outcome of the proceeding, and the citation of the decision (if published). See American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons, 201 USPQ 531 (TTAB 1979); Interbank Card Ass'n v. United States National Bank of Oregon, 197 USPQ 127 (TTAB 1975); Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); and Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975).

(11) A party need not provide discovery with respect to those of its marks and goods and/or services which are not involved in the proceeding and have no relevance thereto. However, the information that a party sells the same goods or services as the propounding party, even if under a different mark, is relevant to the issue of likelihood of confusion. See TBC Corp. v. Grand Prix Ltd., 16 USPQ2d 1399 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974); Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp., 176 USPQ 493 (TTAB 1973). See also Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977), and Sterling Drug Inc. v. Sebring, 515 F.2d 1128, 185 USPQ 649 (CCPA 1975).

(12) The names and addresses of a party's officers are discoverable. However, if a party has a large number of officers, it need only provide the names and addresses of those officers most knowledgeable of its involved activities. See J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(13) Although information concerning a party's foreign use of its involved mark is usually irrelevant to the issues in a Board proceeding, and thus not discoverable, exceptions may arise where, for example, there is an issue as to whether a party's adoption and use of the mark in the United States was made in bad faith for the purpose of forestalling a foreign user's expansion into the United States, or where the foreign mark is "famous," albeit not used, in the United States. See, for general rule Double J of Broward Inc. v. Skalony Sportswear

OLD EDITION

GmbH, 21 USPQ2d 1609 (TTAB 1991), and Johnson & Johnson v. Salve S.A., 183 USPQ 375 (TTAB 1974). See also Oland's Breweries [1971] Ltd. v. Miller Brewing Co., 189 USPQ 481 (TTAB 1975), aff'd, Miller Brewing Co. v. Oland's Breweries, 548 F.2d 349, 192 USPQ 266 (CCPA 1976). See, re possible exceptions, Article 6 bis of the Paris Convention; Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed.Cir. 1990); Double J of Broward Inc. v. Skalony Sportswear GmbH, supra; Mastic Inc. v. Mastic Corp., 230 USPQ 699 (TTAB 1986); Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A., 228 USPQ 589 (TTAB 1985); Davidoff Extension S.A. v. Davidoff International, Inc., 221 USPQ 465 (S.D. Fla. 1983); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983); All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc., 220 USPQ 1069 (TTAB 1983); Canovas v. Venezia 80 S.R.L., 220 USPQ 660 (TTAB 1983); Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983); and Johnson & Johnson v. Diaz, 339 F. Supp. 60, 172 USPQ 35 (C.D. Cal. 1971).

(14) Generally, the names and addresses of the stockholders of a corporate party are irrelevant, and not discoverable, unless there is a question as to whether that party and another entity are "related companies" within the meaning of Section 5 of the Act, 15 U.S.C. 1055. See Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(15) The locations of those places of business where a party manufactures its involved goods, or conducts its involved services, under its involved mark, are discoverable. See Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975), and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(16) Information relating to the areas of distribution for a party's involved goods or services sold under its involved mark is discoverable. See Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Miller & Fink Corp. v. Servicemaster Hospital Corp., 184 USPQ 495 (TTAB 1975); and Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974).

OLD EDITION

(17) The identity of any advertising agency engaged by a party to advertise and promote the party's involved goods or services under its involved mark is discoverable, as is the identity of the advertising agency employees having the most knowledge of such advertising and promotion. See J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975).

(18) Annual sales and advertising figures, stated in round numbers, for a party's involved goods or services sold under its involved mark are proper matters for discovery; if a responding party considers such information to be confidential, disclosure may be made under protective order. See Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

(19) Information concerning a defendant's actual knowledge of plaintiff's use of the plaintiff's involved mark, including whether defendant has actual knowledge thereof, and, if so, when and under what circumstances it acquired such knowledge, is discoverable. See Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974); and American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974).

OLD EDITION

CHAPTER 500 STIPULATIONS AND MOTIONS

501 Stipulations

502 Motions--In General

503 Motion to Dismiss for Failure to State a Claim

504 Motion for Judgment on the Pleadings

505 Motion for a More Definite Statement

506 Motion to Strike Matter From Pleading

507 Motion to Amend Pleading

508 Motion for Default Judgment for Failure to Answer

509 Motion to Extend Time; Motion to Reopen Time

510 Motion to Suspend; Motion to Resume

511 Motion to Consolidate

512 Motion to Join or Substitute

513 Motion to Withdraw as Representative; Petition to Disqualify

514 Motion to Amend Application or Registration

515 Motion to Remand Application to Examining Attorney

516 Motion to Divide Application

517 Motion to Strike Brief on Motion

518 Motion for Reconsideration of Decision on Motion

519 Motion for Leave to Serve Additional Interrogatories

OLD EDITION

520 Motion to Take Foreign Deposition Orally

521 Motion to Quash Notice of Deposition

522 Motion for Order re Manner or Place of Document Production

523 Motion to Compel Discovery

524 Motion to Test Sufficiency of Response to Admission Request

525 Motion to Withdraw or Amend Admissions

526 Motion for a Protective Order

527 Motion for Discovery Sanctions

528 Motion for Summary Judgment

529 Motion for FRCP 11, or Other Non-Discovery, Sanctions

530 Motion to Offer Discovery Deposition of Self or Nonparty

531 Motion to Use Testimony From Another Proceeding

532 Motion That Deposition Upon Written Questions Be Taken Orally

533 Motion to Strike Notice of Reliance

534 Motion to Strike Trial Testimony Deposition

535 Motion for Judgment for Plaintiff's Failure to Prove Case

536 Motion for Order to Show Cause Under Rule 2.134(b)

537 Motion for Order to Show Cause Under Rule 2.128(a)(3)

538 Motion for Leave to Exceed Page Limit for Brief on Case

539 Motion for Leave to File Amicus Brief

OLD EDITION

540 Motion to Strike Brief on Case

541 Motion for Augmented Panel Hearing

542 Motion to Change Oral Hearing Date; For Additional Time

543 Motion for Leave to Audiotape Oral Hearing

544 Motion for Reconsideration of Final Decision

545 Motion for Relief From Final Judgment

OLD EDITION

501 Stipulations

501.01 In General

Subject to the approval of the Board, parties may stipulate to a wide variety of matters. For example, parties may stipulate to extend or reopen times; that the total number of interrogatories which one party may serve upon another party in a proceeding may exceed the limitation specified in 37 CFR §2.120(d)(1); that the production of documents and things under the provisions of FRCP 34 may be made in a specified place and/or manner (see 37 CFR §2.120(d)(2)); to protective orders (see TBMP §416.02); to the facts in the case of any party (see 37 CFR §2.123(b)); that the testimony of witnesses may be submitted in affidavit form (see 37 CFR §2.123(b)); that a deposition may be taken at a particular place, or in a certain manner (see 37 CFR §2.123(b)); that the proceeding shall be ended in a specified way (see TBMP §605.03]; etc.

OLD EDITION

501.02 Filing Stipulations

Stipulations which require action or consideration by the Board, such as stipulations to extend a defendant's time to file an answer to the complaint, stipulations to extend trial dates, stipulations relating to the form of testimony, stipulations to end a proceeding in a specified way, etc., must be filed with the Board. Some other types of stipulations, such as stipulations to extend a party's time for responding to a request for discovery, do not necessarily have to be filed with the Board. However, even in the case of a stipulation which does not have to be filed, the better practice is to at least reduce the stipulation to writing, in order to avoid any misunderstanding between the parties as to the existence and terms thereof.

501.03 Form of Stipulation

A stipulation may be signed either by the parties or by their attorneys or other authorized representatives.

If parties stipulate to extend or reopen a time or times, the stipulation should specify the closing date for each rescheduled time. For example, if parties

stipulate to extend or reopen a defendant's time to file an answer to the complaint, the stipulation should specify the new due date for the answer. If parties stipulate to extend or reopen testimony periods, or the discovery period and testimony periods, the stipulation should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. See 37 CFR §2.121(d), and Jan Bell Marketing Inc. v. Centennial Jewelers Inc., 19 USPQ2d 1636 (TTAB 1990). Further, any stipulation to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. See 37 CFR §§2.102(d) and 2.121(d), and Jan Bell Marketing Inc. v. Centennial Jewelers Inc., supra.

The resetting, whether by stipulation or otherwise, of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a), and TBMP §403.04.

OLD EDITION

502 Motions--In General

502.01 Available Motions

There is a wide range of motions which may be filed in inter partes proceedings before the Board. Rule 2.116(a), 37 CFR §2.116(a), provides that "except as otherwise provided, and wherever applicable and appropriate, procedure and practice in inter partes proceedings shall be governed by the Federal Rules of Civil Procedure." Thus, most of the motions available under the Federal Rules of Civil Procedure are also available in proceedings before the Board.

However, because the Board is an administrative tribunal, its rules and procedures, and hence the motions available in proceedings before it, necessarily differ in some respects from those prevailing in the Federal district courts. See TBMP §§102.03 and 702.

For example, the Board does not preside at the taking of testimony. Instead, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. See

TBMP §702. Further, for reasons of administrative economy, it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985); Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co., 226 USPQ 718 (TTAB 1985); No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co., 207 USPQ 954 (TTAB 1980); La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976); Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 182 USPQ 572 (Comm'r 1974); Clairol Inc. v. Holland Hall Products, Inc., 161 USPQ 616 (TTAB 1969); and Cities Service Oil Co. v. Perfection American, Inc., 157 USPQ 209 (TTAB 1968). Therefore, the Board entertains only two motions for judgment relating to the sufficiency of trial period evidence, namely, the 37 CFR §§2.132(a) and (b) motions for involuntary dismissal for failure of the plaintiff to take testimony (for information concerning these motions, see TBMP §535). The motion under FRCP 41(b) for involuntary dismissal, and the motion under FRCP 50(a) for a directed verdict, are not available in Board proceedings. See Kasco Corp. v. Southern Saw Service Inc., 27 USPQ2d 1501 (TTAB 1993); Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co., 226 USPQ 718 (TTAB 1985); No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985); Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52 (TTAB 1983), aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984); Cities Service Oil Co. v. Perfection American, Inc., 157 USPQ 209 (TTAB 1968); and Gary D. Krugman, TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods, 73 Trademark Rep. 76 (1983).

Although it would be impractical to try to discuss every motion which might be filed in an inter partes proceeding before the Board, this chapter includes discussions of those motions which most commonly arise in Board proceedings.

502.02 Form of Motions

37 CFR §2.127(a) Every motion shall be made in writing, shall contain a full statement of the grounds, and shall embody or be accompanied by a brief. ...

OLD EDITION

Every motion must conform to the requirements of 37 CFR §2.127(a). In addition, a motion should bear the name and number of the inter partes proceeding in connection with which it is being filed, and a title describing the nature of the motion. See TBMP §106.01. A motion which does not bear the correct proceeding number may never be associated with the file of the proceeding for which it is intended (and hence may never be considered by the Board).

A motion must be signed by the party filing it, or by the party's attorney or other authorized representative. If a motion is unsigned, it will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. See 37 CFR §2.119(e), and TBMP §106.02.

The certificate of mailing by first-class mail procedure provided under 37 CFR §1.8, and the certificate of "Express Mail" procedure provided under 37 CFR §1.10, are both available for the filing of motions. See 37 CFR §§1.8 and 1.10, and TBMP §§110 and 111.

Except as noted below, only one copy of a motion need be filed with the Board. Every motion filed with the Board must be served upon every other party to the proceeding, and proof of such service ordinarily must be made before the motion will be considered by the Board. See 37 CFR §§2.119(a) and 2.119(b), and TBMP §113.

In the case of a consented motion to extend, or reopen, a time or times, the motion should specify the closing date for each rescheduled time. A consented motion to extend, or reopen, testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. Further, any consented motion to extend, or reopen, a time or times should be filed in multiple form, i.e., one copy of the motion for the Board proceeding file, plus as many additional copies as there are parties, so that if the motion is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. See 37 CFR §§2.102(d) and 2.121(d), and TBMP §§501.03 and 509.02. Cf. TBMP §403.03.

An unconsented motion to extend, or reopen, should be filed in single (not multiple) form. If the motion seeks an extension, or a reopening, of a testimony

OLD EDITION

period or periods, or of the discovery period and testimony periods, it is preferable that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

OLD EDITION

502.03 Briefs on Motions

Every motion must embody or be accompanied by a brief. See 37 CFR §2.127(a).

Briefs on motions should not be filed in bound form. See TBMP §106.03.

A brief in response to a motion must be filed within 15 days from the date of service of the motion (20 days if service of the motion was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), unless another time is specified by the Board; or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause; or the time is reopened by stipulation of the parties approved by the Board or by order of the Board on motion showing excusable neglect. See 37 CFR §2.127(a); FRCP 6(b); and TBMP §509.

If a party fails to file a brief in opposition to a motion, the Board, in its discretion, may treat the motion as conceded. See, for example, 37 CFR §2.127(a); Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 USPQ 888 (CCPA 1980); Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990); Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990); Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984); Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., 193 USPQ 313 (TTAB 1976); General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc., 189 USPQ 425 (TTAB 1975); Johnson & Johnson v. American Hospital Supply Corp., 187 USPQ 478 (TTAB 1975);

Gibson Greeting Cards, Inc. v. Associated Crafts, Inc., 182 USPQ 625 (TTAB 1974); and Joy Manufacturing Co. v. Robbins Co., 181 USPQ 408 (TTAB 1974).

There is no provision in the Trademark Rules of Practice for the filing of reply briefs on motions. On the other hand, they are not expressly prohibited. Thus, while the Board generally discourages the filing of reply briefs on motions (see SDT Inc. v. Petterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); Wells Fargo & Co. v. Lundeen & Associates, 20 USPQ2d 1156 (TTAB 1991); Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987)), the Board may, in its discretion, entertain a reply brief if the Board finds that such a brief is warranted under the circumstances of a particular case. For example, the Board may entertain a reply brief if, in the Board's opinion, such a brief is necessary to permit the moving party to respond to new issues raised in, or new materials submitted with, an adversary's brief in opposition to the motion; or the issue to be determined is complex or needs to be further clarified; or certain arguments against the motion should be answered so as to assist the Board in arriving at a just conclusion on the motion. See Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991); DataNational Corp. v. BellSouth Corp., 18 USPQ2d 1862 (TTAB 1991); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989); Avon Products, Inc. v. MarCon, Ltd., 225 USPQ 977 (TTAB 1985); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974); Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974); and Goodyear Tire & Rubber Co. V. Uniroyal, Inc., 183 USPQ 372 (TTAB 1974).

Because the Trademark Rules of Practice do not provide for the filing of reply briefs on motions, no time limit therefor is specified. However, when a reply brief is filed, it should be filed as promptly as possible; otherwise, the motion may be determined by the Board before the reply brief is received. At the very least, a reply brief should be filed within the time allowed for filing other responsive briefs on motions, i.e., within 15 days from the date of service of the paper to which the brief responds (20 days if service of the paper to which the brief responds was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), unless another time is specified by the Board, or the time is extended by stipulation of the parties approved by the Board or by order

OMITTED

of the Board on motion for good cause. See 37 CFR §2.127(a), and Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 229 USPQ 860 (TTAB 1986), rev'd on other grounds, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1987), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988). See also Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991), and M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990).

502.04 Oral Hearings on Motions

An oral hearing is not held on a motion except by order of the Board. See 37 CFR §2.127(a). It is the practice of the Board to deny a request for an oral hearing on a motion unless, in the opinion of the Board, an oral hearing is necessary to clarify the issue or issues to be decided. Ordinarily, arguments on a motion may be adequately presented in the briefs thereon. Thus, the Board rarely grants a request for an oral hearing on a motion. See Scotch Whiskey Ass'n v. United States Distilled Products Co., 18 USPQ2d 1391 (TTAB 1991), rev'd on other grounds, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); TBC Corp. v. Grand Prix Ltd., 12 USPQ2d 1311 (TTAB 1989); Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986); Canovas v. Venezia 80 S.R.L., 220 USPQ 660 (TTAB 1983); Avedis Zildjian Co. v. D. H. Baldwin Co., 180 USPQ 539 (TTAB 1973); Bacardi & Co. v. Ron Castillo, S.A., 178 USPQ 242 (TTAB 1973); Electric Storage Battery Co. v. Mine Safety Appliances Co., 140 USPQ 671 (TTAB 1963); and Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 124 USPQ 343 (TTAB 1960), rev'd on other grounds, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962). Cf. Federal Trade Commission v. Formica Corp., 200 USPQ 182 (TTAB 1978) (request for oral hearing on motion granted).

502.05 Determination of Motions

37 CFR §2.127(c) Interlocutory motions, requests, and other matters not actually or potentially dispositive of a proceeding may be acted upon by a single Member of the Trademark Trial and Appeal Board or by an Attorney-Examiner of the Board to whom authority so to act has been delegated.

OLD EDITION

Interlocutory motions which are not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge (formerly referred to as a Board member), or by a single interlocutory attorney to whom such authority has been delegated. See 37 CFR §2.127(c), and TBMP §102.03. Motions which are actually or potentially dispositive of a proceeding are determined by a panel of at least three Board members. See Section 17 of the Act, 15 U.S.C. §1067. For information concerning the remedies available to a party which is dissatisfied with a decision on a motion, see TBMP §518. See also TBMP §905.

Motions fall into three categories: consented, uncontested, and contested. If the nonmoving party has consented to a motion, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto (unless written consent is required under the provisions of 37 CFR §§2.106(c), 2.114(c), 2.134(a), or 2.135). Ordinarily, a consented motion will be granted by the Board.

If the nonmoving party has not given its consent to a motion, but does not file a brief in opposition thereto during the time allowed therefor, the motion may be granted by the Board as conceded. See 37 CFR §2.127(a), and TBMP §502.03.

If a motion is contested by the nonmoving party, the Board will decide the motion on its merits.

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

OLD EDITION

502.06 Attorneys' Fees, etc., on Motions

The Board does not have authority to hold any person in contempt, or to award attorneys' fees, other expenses, or damages to any party. See generally 37 CFR §§2.120(f); 2.120(g)(1); 2.120(h); and 2.127(f). See also Nabisco Brands Inc. v.

Keebler Co., 28 USPQ2d 1237 (TTAB 1993); Scotch Whiskey Ass'n v. United States Distilled Products Co., 18 USPQ2d 1391 (TTAB 1991), rev'd on other grounds, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984); Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980); and MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979).

502.07 Telephone and Pre-Trial Conferences

502.07(a) Telephone Conferences

37 CFR 2.120(i)(1) Whenever it appears to the Trademark Trial and Appeal Board that a motion filed in an inter partes proceeding is of such nature that its resolution by correspondence is not practical, the Board may, upon its own initiative or upon request made by one or both of the parties, resolve the motion by telephone conference.

Under the circumstances described in 37 CFR §2.120(i)(1), a motion filed with the Board may be resolved by telephone conference call involving the parties or their attorneys and an interlocutory attorney, or an administrative trademark judge, of the Board. See 37 CFR §2.120(i)(1). See also Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991) Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Fort Howard Paper Co. V. C.V. Gambina Inc., 4 USPQ2d 1552, 1553 (TTAB 1987); and Abraham Bogorad, The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board, 66 Trademark Rep. 28, 37 (1976). Immediately after the resolution of a motion by telephone conference, the Board will issue a written order confirming its decision on the motion.

The telephone conference procedure is particularly useful for resolving motions where time is of the essence, such as a motion to quash a notice of deposition. However, the Board will not resolve a motion by telephone conference until a copy of the motion has been received by the Board. A copy of the motion should also have been received by every other party to the proceeding.

OLD EDITION

To expedite matters, the moving party may hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned. Alternatively, if the motion has been filed with the Board by some (acceptable) method other than hand delivery to the interlocutory attorney, but has not yet actually been received by the Board and/or entered in the proceeding file for which it is intended, the moving party may call the interlocutory attorney and request permission to fax a copy of the motion to the Board. See TBMP §107.

502.07(b) Pre-trial Conferences

37 CFR §2.120(i)(2) Whenever it appears to the Trademark Trial and Appeal Board that questions or issues arising during the interlocutory phase of an inter partes proceeding have become so complex that their resolution by correspondence or telephone conference is not practical and that resolution would be likely to be facilitated by a conference in person of the parties or their attorneys with a Member or Attorney-Examiner of the Board, the Board may, upon its own initiative or upon motion made by one or both of the parties, request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a pre-trial conference.

Because the pre-trial conference procedure necessarily involves expense for the parties, it is rarely used by the Board. However, it may be advantageous in cases where numerous complex motions are pending (particularly if there is such hostility between the parties and/or their attorneys that they are unable to work out a resolution of any of their differences). See Abraham Bogorad, The Impact of the Amended Rules Upon Discovery Practice Before the Trademark Trial and Appeal Board, 66 Trademark Rep. 28, 37 (1976).

502.08 FRCP 11 Applicable

For information concerning the applicability of the provisions of FRCP 11 to motions filed in proceedings before the Board, see TBMP §529.01.

OLD EDITION

503 Motion to Dismiss for Failure to State a Claim

503.01 Time for Filing

When the defense of failure to state a claim upon which relief can be granted is raised by means of a motion to dismiss, the motion must be filed before, or concurrently with, the movant's answer. See FRCP 12(b); William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1871 (TTAB 1994); Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990); and Hollowform, Inc. v. Delma Aeh, 180 USPQ 284 (TTAB 1973), aff'd, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975). When the motion is directed to an amended pleading, it must be filed before, or concurrently with, the movant's answer to the amended pleading. See William & Scott Co. v. Earl's Restaurants Ltd., supra.

The filing of a motion to dismiss for failure to state a claim upon which relief can be granted tolls the time for filing an answer. See Hollowform, Inc. v. Delma Aeh, supra. If the motion is filed before the movant's answer, and is denied, the Board will reset the time for filing an answer.

The defense of failure to state a claim upon which relief can be granted may be raised after an answer is filed, provided that it is raised by some means other than a motion to dismiss. For example, the defense may be raised, after an answer is filed, by a motion for judgment on the pleadings, or by a motion for summary judgment. See FRCP 12(h)(2), and Wright & Miller, Federal Practice and Procedure: Civil 2d §1357 (1990). See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990).

OLD EDITION

503.02 Nature of Motion

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of a complaint. See, for example, Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); and Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752 (TTAB 1985). In order to withstand

such a motion, a pleading need only allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought, that is, that (1) the plaintiff has standing to maintain the proceeding, and (2) a valid ground exists for denying the registration sought (in the case of an opposition), or for cancelling the subject registration (in the case of a cancellation proceeding). See Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982); Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990); Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752 (TTAB 1985); Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 (TTAB 1985); and Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S., 222 USPQ 512 (TTAB 1984).

Therefore, a plaintiff served with a motion to dismiss for failure to state a claim upon which relief can be granted need not respond by submitting proofs in support of its pleading. Whether a plaintiff can actually prove its allegations is a matter to be determined not upon motion to dismiss, but rather at final hearing or upon summary judgment, after the parties have had an opportunity to submit evidence in support of their respective positions. See Caron Corp. v. Helena Rubinstein, Inc., 193 USPQ 113 (TTAB 1976); Anheuser-Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975); and Syndicat de la Parfumerie Francaise v. Scaglia, 173 USPQ 383 (TTAB 1972). Cf. Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989).

For purposes of determining a motion to dismiss for failure to state a claim upon which relief can be granted, all of the plaintiff's well pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to the plaintiff. See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Stanspec Co. v. American Chain & Cable Co., 531 F.2d 563, 189 USPQ 420 (CCPA 1976); Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); and No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985). Dismissal for insufficiency is appropriate only if it appears certain that the plaintiff is entitled to no relief under any set of facts which could be proved in support of its claim. See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., supra; Scotch Whiskey Ass'n v. United States Distilled Products Co., 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991); Stanspec Co. v. American Chain & Cable Co., supra; Kelly Services Inc. v. Greene's Temporaries Inc., supra; Space Base Inc. v. Stadis Corp., supra;

OLD EDITION

Stabilisierrungsfonds fur Wein v. Zimmermann-Graeff KG, 199 USPQ 488 (TTAB 1978); and National Ass'n of Blue Shield Plans v. Standard Mattress Co., 176 USPQ 29 (TTAB 1972).

Whenever the sufficiency of any complaint has been challenged by a motion to dismiss, it is the duty of the Board to examine the complaint in its entirety, construing the allegations therein liberally, as required by FRCP 8(f), to determine whether it contains any allegations which, if proved, would entitle the plaintiff to the relief sought. See Miller Brewing Co. v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993); Delta Tire Corp. v. Sports Car Club of America, Inc., 186 USPQ 431 (TTAB 1975); and National Semiconductor Corp. v. Varian Associates, 184 USPQ 62 (TTAB 1974).

OLD EDITION

503.03 Leave to Amend Defective Pleading

A plaintiff may amend its complaint once as a matter of course at any time before an answer thereto is served, and may amend its complaint thereafter with the written consent of every adverse party or by leave of the Board, which is freely given when justice so requires. See TBMP §507.02. Thus, plaintiffs to proceedings before the Board ordinarily can, and often do, respond to a motion to dismiss by filing, inter alia, an amended complaint. If the amended complaint corrects the defects noted by the defendant in its motion to dismiss, and states a claim upon which relief can be granted, the motion to dismiss normally will be moot.

If no amended complaint is submitted in response to a motion to dismiss for failure to state a claim upon which relief can be granted, and the Board finds, upon determination of the motion, that the complaint fails to state a claim upon which relief can be granted, the Board generally will allow the plaintiff an opportunity to file an amended pleading. See, for example, Miller Brewing Co. v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993); Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 (TTAB 1985); and Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984).

However, in appropriate cases, that is, where justice does not require that leave to amend be given, the Board, in its discretion, may refuse to allow an opportunity, or a further opportunity, for amendment. See, for example, FRCP 15(a); Pure

Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984) (amendment would serve no useful purpose); and McDonnell Douglas Corp. v. National Data Corp., 228 USPQ 45 (TTAB 1985) (plaintiff had been allowed two opportunities to perfect its pleading, and it would not be in the interests of justice to allow further leave to amend). Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987); American Hygienic Labs, Inc. v. Tiffany & Co., 228 USPQ 855 (TTAB 1986); and TBMP §507.02.

503.04 Matters Outside the Pleading

If, on a motion to dismiss for failure to state a claim upon which relief can be granted, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under FRCP 56. Ordinarily, the parties to the proceeding will be notified that the motion to dismiss is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. See, for example, FRCP 12(b); Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993); Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992); Wells Fargo & Co. v. Lundeen & Associates, 20 USPQ2d 1156 (TTAB 1991); Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985); and Exxon Corp. v. National Foodline Corp., 196 USPQ 444 (TTAB 1977), aff'd, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978). Cf. Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988).

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion to dismiss as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. See Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

504 Motion for Judgment on the Pleadings

OLD EDITION

504.01 Time for Filing

After the pleadings are closed, but within such time as not to delay the trial, any party to an inter partes proceeding before the Board may file a motion for judgment on the pleadings. See FRCP 12(c). In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period. See 37 CFR §2.116(e); Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, 5 USPQ2d 1376 (TTAB 1986); and La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976). Thus to be timely, a motion for judgment on the pleadings must be filed after the pleadings are closed, but prior to the opening of the first testimony period, as originally set or as reset. Cf. 37 CFR §2.127(e)(1); Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, supra; Lukens Inc. v. Vesper Corp., 1 USPQ2d 1299 (TTAB 1986), aff'd, Vesper Corp. v. Lukens Inc., 831 F.2d 306 (Fed. Cir. 1987); Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co., 226 USPQ 718 (TTAB 1985); Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985); La Maur, Inc. v. Bagwells Enterprises, Inc., supra; Peterson's Ltd. v. Consolidated Cigar Corp., 183 USPQ 559 (TTAB 1974); and Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 182 USPQ 572 (Comm'r 1974).

When a motion to dismiss for failure to state a claim upon which relief can be granted is filed after the answer, but prior to trial, the motion may be construed by the Board as a motion for judgment on the pleadings. See Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990). Cf. TBMP §503.01.

OLD EDITION

504.02 Nature of Motion

A motion for judgment on the pleadings is a test solely of the undisputed facts appearing in all the pleadings, supplemented by any facts of which the Board will take judicial notice. See 2A Moore's Federal Practice ¶12.15 (2d ed. 1985).

For purposes of the motion, all well pleaded factual allegations of the nonmoving party must be accepted as true, while those allegations of the moving party which have been denied (or which are taken as denied, pursuant to FRCP 8(d), because

no responsive pleading thereto is required or permitted) are deemed false. Conclusions of law are not taken as admitted. See Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1992); International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983); 2A Moore's Federal Practice ¶12.15 (2d ed. 1985); and Wright & Miller, Federal Practice and Procedure: Civil 2d §1367 et seq. (1990). All reasonable inferences from the pleadings are drawn in favor of the nonmoving party. See Baroid Drilling Fluids Inc. v. Sun Drilling Products, supra; CBS Inc. v. Mercandante, 23 USPQ2d 1784 (TTAB 1992); and Wright & Miller, supra.

A judgment on the pleadings may be granted only where, on the facts as deemed admitted, there is no genuine issue of material fact to be resolved, and the moving party is entitled to judgment, on the substantive merits of the controversy, as a matter of law. See Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1992); CBS Inc. v. Mercandante, 23 USPQ2d 1784 (TTAB 1992); International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983); 2A Moore's Federal Practice ¶12.15 (2d ed. 1985); and Wright & Miller, Federal Practice and Procedure: Civil 2d §1367 et seq. (1990).

A party may not obtain a judgment on the pleadings if the nonmoving party's pleading raises issues of fact which, if proved, would establish the nonmoving party's entitlement to judgment. See Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1992), and Wright & Miller, Federal Practice and Procedure: Civil 2d §1368 (1990).

OLD EDITION

504.03 Matters Outside the Pleadings

If, on a motion for judgment on the pleadings, matters outside the pleading are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under FRCP 56. Ordinarily, the parties to the proceeding will be notified that the motion for judgment on the pleadings is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. See FRCP 12(c), and Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988). Cf. Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983); Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137

(TTAB 1990); Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985); International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983); and Exxon Corp. v. National Foodline Corp., 196 USPQ 444 (TTAB 1977), aff'd, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978).

Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion for judgment on the pleadings as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. See Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983).

505 Motion for a More Definite Statement

505.01 Nature of Motion

If, in an inter partes proceeding before the Board, a pleading to which a responsive pleading must be made is so vague or ambiguous that a party cannot reasonably be required to frame a responsive pleading, the responding party may move for a more definite statement. See FRCP 12(e), and Wright & Miller, Federal Practice and Procedure: Civil 2d §1376 (1990). Cf. CBS Inc. v. Mercandante, 23 USPQ2d 1784, at fn.8 (TTAB 1992). The motion must point out the defects complained of, specify the details which the movant desires to have pleaded, and indicate that the movant is unable to frame a responsive pleading without the desired information. See FRCP 12(e), and Wright & Miller, supra, at §1378.

A motion for a more definite statement is appropriate only in those cases where the pleading states a claim upon which relief can be granted, but is so vague or ambiguous that the movant cannot make a responsive pleading in good faith or without prejudice to itself. See Wright & Miller, Federal Practice and Procedure: Civil 2d §1376-1377 (1990). If the movant believes that the pleading does not state a claim upon which relief can be granted, its proper remedy is a motion under FRCP 12(b)(6) to dismiss for failure to state a claim upon which relief can be granted, not a motion for a more definite statement. See Wright & Miller, supra, at §1376.

OLD EDITION

A motion for a more definite statement may not be used to obtain discovery. The only information which a movant may obtain by this motion is that which it needs to make its responsive pleading. See 2A Moore's Federal Practice ¶12.18[1] (2d ed. 1985), and Wright & Miller, Federal Practice and Procedure: Civil 2d §1376-1377 (1990).

505.02 Time for Filing

A motion for a more definite statement, if filed, must be filed within the time for, and before, the moving party's responsive pleading. See FRCP 12(e), and 2A Moore's Federal Practice ¶12.19 (2d ed. 1985). An extension of time to file a responsive pleading automatically extends the time to file a motion for a more definite statement, unless the Board orders otherwise. See Moore's Federal Practice, supra.

505.03 Failure to Obey Order for More Definite Statement

If the Board, upon motion, issues an order for a more definite statement, and the order is not obeyed within the time specified by the Board, the Board may strike the pleading to which the motion was directed, or make such order as it deems just. See FRCP 12(e).

506 Motion to Strike Matter From Pleading

506.01 Nature of Motion

Upon motion, or upon its own initiative, the Board may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See FRCP 12(f).

Motions to strike are not favored, and matter will not be stricken unless it clearly has no bearing upon the issues in the case. See Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988); Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., 177 USPQ 401 (TTAB 1973); 2A

OLD EDITION

Moore's Federal Practice ¶12.21[2] (2d ed. 1985); and Wright & Miller, Federal Practice and Procedure: Civil 2d §1380 (1990). The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. See TBMP §§312.03 and 318.02(b); Harsco Corp. v. Electrical Sciences Inc., supra; and McDonnell Douglas Corp. v. National Data Corp., 228 USPQ 45 (TTAB 1985). See also Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). Thus, the Board, in its discretion, may decline to strike even objectionable pleadings where their inclusion will not prejudice the adverse party, but rather will provide fuller notice of the basis for a claim or defense. See Harsco Corp. v. Electrical Sciences Inc., supra, and Moore's Federal Practice, supra. A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. See Harjo v. Pro Football Inc., 30 USPQ2d 1828 (TTAB 1994).

Nevertheless, the Board grants motions to strike in appropriate cases. See, for example, American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992) (insufficient affirmative defenses stricken); Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990) (pleaded ground for cancellation stricken because not available, respondent's registration being more than five years old); Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988) (immaterial allegation stricken; however, other allegations which bore directly on issues in case, were not prejudicial to defendant, and gave defendant more complete notice of plaintiff's claim, not stricken); Continental Gummi-Werke AG v. Continental Seal Corp., 222 USPQ 822 (TTAB 1984) (affirmative defense stricken because identical to counterclaim asserted in same case); W. R. Grace & Co. v. Arizona Feeds, 195 USPQ 670 (Comm'r 1977) (affirmative defenses stricken as redundant because same allegations formed basis for counterclaim asserted in same case); Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc., 180 USPQ 794 (TTAB 1974) (complaint stricken for failure to comply with requirement of FRCP 10(b) that each numbered paragraph be limited to a single set of circumstances, but plaintiff allowed opportunity to submit substitute complaint); Textron, Inc. v. Gillette Co., 180 USPQ 152 (TTAB 1973) (allegations in answer which merely reiterated denial of likelihood of confusion without adding anything of substance thereto stricken as redundant; however, other allegations which amplified the denial of likelihood of confusion, and thus served to apprise plaintiff with greater particularity of defendant's position, not stricken); Gould Inc. v. Sanyo Electric Co., 179 USPQ 313 (TTAB 1973) (affirmative defense attacking validity of plaintiff's pleaded registration stricken since such an allegation may be

OLD EDITION

entertained only if presented as counterclaim); S. C. Johnson & Son, Inc. v. GAF Corp., 177 USPQ 720 (TTAB 1973) (affirmative defense of failure to state a claim upon which relief can be granted stricken since complaint did state such a claim); and McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959) (recital of evidentiary material, namely, list in defendant's pleading of more than 50 asserted third-party registrants and users, stricken). Cf. Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., 177 USPQ 401 (TTAB 1973) (allegations pertinent to the issues in the case not stricken).

506.02 Time for Filing

A motion to strike matter from a pleading should be filed within the time for, and before, the moving party's responsive pleading. See FRCP 12(f), and Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990). If a motion to strike matter from a complaint is filed with an answer to the complaint, the motion to strike is construed by the Board as having been filed first.

If no responsive pleading is required, the motion should be filed within 20 days after service upon the moving party of the pleading which is the subject of the motion (25 days, if service of the pleading was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)). See FRCP 12(f). See also American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992).

However, the Board, upon its own initiative, and at any time, may order stricken from a pleading any insufficient defense or any redundant, immaterial, impertinent, or scandalous matter. See FRCP 12(f). Thus, the Board, in its discretion, may entertain an untimely motion to strike matter from a pleading. See 2A Moore's Federal Practice ¶12.21[1] (2d ed. 1985); Wright & Miller, Federal Practice and Procedure: Civil 2d §1380 (1990); American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992); and Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990).

OLD EDITION

506.03 Exhibits Attached to Pleadings

Exhibits submitted with pleadings will not be stricken by the Board since they are clearly contemplated by 37 CFR §§2.104(a), 2.105, 2.112(a), 2.113, and 2.122(c). However, except for status and title copies of a plaintiff's pleaded registrations filed by the plaintiff with its complaint pursuant to 37 CFR §2.122(d)(1), exhibits attached to pleadings are not evidence in behalf of the party to whose pleading they are attached unless they are identified and introduced in evidence as exhibits during the testimony period. See 37 CFR §2.122(c), and TBMP §313.

507 Motion to Amend Pleading

507.01 In General

The primary purpose of pleadings, under the Federal Rules of Civil Procedure, is to give fair notice of the claims or defenses asserted. See TBMP §§312.03, 318.02(b), 506.01, and cases cited in the foregoing sections. See also Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). Claims or defenses which are not asserted in the pleadings as originally filed, or as amended or deemed amended, will not be entertained by the Board. See TBMP §321, and cases cited therein.

Amendments to pleadings in inter partes proceedings before the Board are governed by FRCP 15. See 37 CFR §§2.107, 2.115, and 2.116(a). Amendments in general are governed by FRCP 15(a). Amendments to conform the pleadings to trial evidence are governed by FRCP 15(b).

A motion for leave to amend a pleading should be accompanied by a signed copy of the proposed amended pleading. See Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

507.02 Amendments--General Rule--FRCP 15(a)

A party to an inter partes proceeding before the Board may amend its pleading once as a matter of course at any time before a responsive pleading is served. If

OLD EDITION

the pleading is one to which no responsive pleading is permitted, it may be amended once as a matter of course at any time within 20 days after it is served. See FRCP 15(a). An amendment filed as a matter of course need not be accompanied by a motion for leave to amend. See Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

Thereafter, a party may amend its pleading only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires. See FRCP 15(a). In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. See, for example, Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993); United States Olympic Committee v. O-M Bread Inc., 26 USPQ2d 1221 (TTAB 1993); Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992); Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991); Huffy Corp. v. Geoffrey, Inc., 18 USPQ2d 1240 (Comm'r 1990); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); Microsoft Corp. v. Qantel Business Systems Inc., 16 USPQ2d 1732 (TTAB 1990); Marmark Ltd. v. Nutrexpa S.A., 12 USPQ2d 1843 (TTAB 1989); See's Candy Shops Inc. v. Campbell Soup Co., 12 USPQ2d 1395 (TTAB 1989); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989); Fioravanti v. Fioravanti Corrado S.R.L., 230 USPQ 36 (TTAB 1986), recon. denied, 1 USPQ2d 1304 (TTAB 1986); American Hygienic Labs, Inc. v. Tiffany & Co., 228 USPQ 855 (TTAB 1986); Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985); Caron Corp. v. Helena Rubenstein, Inc., 193 USPQ 113 (TTAB 1976); Anheuser-Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975); Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974); Mack Trucks, Inc. v. Monroe Auto Equipment Co., 182 USPQ 511 (TTAB 1974); Johnson & Johnson v. Cenco Medical Health Supply Corp., 177 USPQ 586 (Comm'r 1973); American Optical Corp. v. American Olean Tile Co., 168 USPQ 471 (TTAB 1971); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). This is so even when a plaintiff seeks to amend its complaint to plead a claim other than those stated in the original complaint (see, for example Marmark Ltd. v. Nutrexpa S.A., 12 USPQ2d 1843 (TTAB 1989); Fioravanti v. Fioravanti Corrado S.R.L., 230 USPQ 36 (TTAB 1986), recon. denied, 1 USPQ2d 1304 (TTAB 1986); American Hygienic Labs, Inc. v. Tiffany & Co., 228 USPQ 855 (TTAB 1986); Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985); Buffett v. Chi-Chi's, Inc., 226 USPQ 428

OLD EDITION

(TTAB 1985); Gemini Engine Co. v. Solar Turbines Inc., 225 USPQ 620 (TTAB 1985); Mack Trucks, Inc. v. Monroe Auto Equipment Co., 182 USPQ 511 (TTAB 1974); and Johnson & Johnson v. Cenco Medical Health Supply Corp., 177 USPQ 586 (Comm'r 1973)), including a claim based on a registration issued to or acquired by plaintiff after the filing date of the original complaint (see Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); Huffy Corp. v. Geoffrey, Inc., 18 USPQ2d 1240 (Comm'r 1990); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); and Cudahy Co. v. August Packing Co., 206 USPQ 759 (TTAB 1979)).

The timing of a motion for leave to amend under FRCP 15(a) plays a large role in the Board's determination of whether the adverse party would be prejudiced by allowance of the proposed amendment. See Metromedia Steakhouses Inc. v. Pondco II Inc., 28 USPQ2d 1205 (TTAB 1993) (amendment by opposer, just after close of discovery, to assert res judicata, based on a judgment entered in another case after the filing of the subject opposition, would not be unfair, since applicant has been afforded adequate notice, and no further discovery will be necessary); Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993) (no prejudice to applicant--discovery still open when motion filed, and opposer agreed to allow applicant further time for follow-up discovery on new claim); United States Olympic Committee v. O-M Bread Inc., 26 USPQ2d 1221 (TTAB 1993) (applicant would not be prejudiced because proceeding still in pre-trial stage and discovery had been extended); Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990) (where opposer filed motion to amend its pleading during its testimony period, motion nevertheless granted since the interests of justice and judicial economy would best be served thereby, and since any prejudice suffered by applicant could be mitigated by reopening discovery solely for applicant); Microsoft Corp. v. Qantel Business Systems Inc., 16 USPQ2d 1732 (TTAB 1990) (ordinarily, leave to amend should be granted whenever, inter alia, doing so will not unduly delay trial--here, proceeding was still in the discovery stage, and respondent had not shown that any undue prejudice would result from the amendment of the petition to cancel); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989) (since cases were still in the discovery stage, respondent would not be prejudiced by allowance of amendment); Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment--proceeding remained in a fairly early stage); Caron Corp. v. Helena Rubenstein, Inc., 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); Anheuser-

OLD EDITION

Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975) (since proceeding was still in the pre-trial stage, amendment of the pleadings could not prejudice opposer); Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974) (since, inter alia, the trial period had not yet commenced, no prejudice to applicant); Mack Trucks, Inc. v. Monroe Auto Equipment Co., 182 USPQ 511 (TTAB 1974) (applicant would not be unduly prejudiced by entry of the proposed amendment since no testimony had as yet been taken); American Optical Corp. v. American Olean Tile Co., 168 USPQ 471 (TTAB 1971) (where applicant filed motion to amend its pleading after the close of opposer's testimony period, but before the opening of applicant's testimony period, Board found that opposer would not be prejudiced by entry of the amendment if, inter alia, opposer was allowed to take discovery thereon); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (where plaintiff filed motion to amend after close of its testimony period, motion denied as untimely to extent it sought amendment under FRCP 15(a)); and Long John Silver's, Inc. v. Lou Scharf Inc., 213 USPQ 263 (TTAB 1982) (opposer's motion to amend to rely on 8 additional marks, shortly after the close of the discovery period, denied where opposer knew, or should have known, of the existence of the marks at the time the opposition was filed, and the discovery period had already been extended several times at opposer's request--allowance of the amendment at that late date would be prejudicial to applicant).

The timing of a motion for leave to amend is particularly important in the case of a motion for leave to amend to assert a counterclaim for cancellation of one or more of the plaintiff's pleaded registrations. If grounds for the counterclaim are known to the defendant when its answer to the complaint is filed, the counterclaim should be pleaded with or as part of the answer. If, during the proceeding, but after answer, the defendant learns of grounds for a counterclaim to cancel a registration pleaded by the plaintiff, the counterclaim should be pleaded promptly after the grounds therefor are learned. See 37 CFR §§2.106(b)(2)(i) and 2.114(b)(2)(i); TBMP §319.04, and cases cited therein; and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

In granting a motion for leave to amend under FRCP 15(a), the Board may, in its discretion, reopen the discovery period so as to avoid any prejudice to the adverse party by reason of the amendment. See Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); Buffett v. Chi-Chi's, Inc., 226 USPQ 428

OLD EDITION

(TTAB 1985); Anheuser-Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975); American Optical Corp. v. American Olean Tile Co., 168 USPQ 471 (TTAB 1971); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

A proposed amendment need not of itself set forth a claim or defense; a proposed amendment may serve simply to amplify allegations already included in the moving party's pleading. See Avedis Zildjian Co. v. D. H. Baldwin Co., 180 USPQ 539 (TTAB 1973). However, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993); CBS Inc. v. Mercandante, 23 USPQ2d 1784 (TTAB 1992); Microsoft Corp. v. Qantel Business Systems Inc., 16 USPQ2d 1732 (TTAB 1990); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987); American Hygienic Labs, Inc. v. Tiffany & Co., 228 USPQ 855 (TTAB 1986); and W. R. Grace & Co. v. Arizona Feeds, 195 USPQ 670 (Comm'r 1977). Cf. TBMP §503.03.

OLD EDITION

507.03 Amendments to Conform to the Evidence--FRCP 15(b)

507.03(a) During Trial After Objection to Trial Evidence

If evidence is objected to at trial on the ground that it is not within the issues raised by the pleadings, the Board, upon motion, may allow the pleadings to be amended, and will do so freely when the presentation of the merits of the case will be subserved thereby and the objecting party fails to satisfy the Board that the admission of such evidence would prejudice it in maintaining its action or defense upon the merits. See FRCP 15(b), and Ercona Corp. v. JENAer Glaswerk Schott & Gen., 182 USPQ 573 (TTAB 1974).

The motion for leave to amend should be filed promptly after the objection is made. See Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). If the motion is granted, the Board may extend the objecting party's testimony period, or reopen discovery for that party, if necessary to enable the objecting party to meet the evidence which

was the subject of the objection. See FRCP 15(b). Cf. Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985); Anheuser-Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975); and American Optical Corp. v. American Olean Tile Co., 168 USPQ 471 (TTAB 1971).

507.03(b) To Add Issues Tried by Express or Implied Consent

When issues not raised by the pleadings are tried by the express or implied consent of the parties, the Board will treat them in all respects as if they had been raised in the pleadings. Any amendment of the pleadings necessary to cause them to conform to the evidence and to raise the unpleaded issues may be made upon motion of any party at any time, even after judgment, but failure to so amend will not affect the result of the trial of these issues. See, for example, FRCP 15(b); Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); Kasco Corp. v. Southern Saw Service Inc., 27 USPQ2d 1501 (TTAB 1993); Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993); Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992); Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd., 3 USPQ2d 1600 (TTAB 1987); Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); Color Key Corp. v. Color 1 Associates, Inc., 219 USPQ 936 (TTAB 1983); ABC Moving Co. v. Brown, 218 USPQ 336 (TTAB 1983); Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168 (TTAB 1982); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); Trans Union Corp. v. Trans Leasing International, Inc., 200 USPQ 748 (TTAB 1978); Intermed Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977); Copperweld Corp. v. Astralloy-Vulcan Corp., 196 USPQ 585 (TTAB 1977); Bekaert Steel Wire Corp. v. S.p.A. Officine Maccaferri Gia' Raffaele Maccaferri & Figli, 196 USPQ 558 (TTAB 1977); Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc., 190 USPQ 158 (TTAB 1976); Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975); Dap, Inc. v. Litton Industries, Inc., 185 USPQ 177 (TTAB 1975); Downtowner Corp. v. Uptowner Inns, Inc., 178

OLD EDITION

USPQ 105 (TTAB 1973), aff'd without opinion, Uptowner Inns, Inc. v. Downtowner Corp., 508 F.2d 847, 183 USPQ 427 (CCPA 1974); Smith Kline & French Laboratories v. USV Pharmaceutical Corp., 175 USPQ 666 (TTAB 1972); Conwood Corp. v. Loew's Theatres, Inc., 173 USPQ 829 (TTAB 1972); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

Implied consent to the trial of an unpleaded issue can be found only where the nonoffering party (1) raised no objection to the introduction of evidence on the issue, and (2) was fairly apprised that the evidence was being offered in support of the issue. See, for example, Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984); P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801 (CCPA 1978); Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd., 3 USPQ2d 1600 (TTAB 1987); Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985); Color Key Corp. v. Color 1 Associates, Inc., 219 USPQ 936 (TTAB 1983); ABC Moving Co. v. Brown, 218 USPQ 336 (TTAB 1983); Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168 (TTAB 1982); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc., 190 USPQ 158 (TTAB 1976); Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975); Downtowner Corp. v. Uptowner Inns, Inc., 178 USPQ 105 (TTAB 1973), aff'd without opinion, Uptowner Inns, Inc. v. Downtowner Corp., 508 F.2d 847, 183 USPQ 427 (CCPA 1974); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991).

Inasmuch as the Board does not read trial testimony or examine other trial evidence prior to final hearing, it is the practice of the Board, when confronted with a FRCP 15(b) motion to amend the pleadings to include an issue assertedly tried by express or implied consent, to defer determination of the motion until final hearing. See Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981); New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co., 207 USPQ 954 (TTAB 1980); Plus Products v. Redken Laboratories, Inc., 199 USPQ 111 (TTAB 1978); and Beth A. Chapman, TIPS FROM THE TTAB: Amending Pleadings: The Right Stuff, 81 Trademark Rep. 302 (1991). Cf. TBMP §502.01.

OLD EDITION

508 Motion for Default Judgment for Failure to Answer

If a defendant fails to file an answer to a complaint during the time allowed therefor, the Board, on its own initiative, may issue a notice of default allowing the defendant 20 days from the mailing date of the notice in which to show cause why default judgment should not be entered against it. If the defendant fails to file a response to the notice, or files a response which does not show good cause, default judgment may be entered against it. See 37 CFR §§2.106(a) and 2.114(a); FRCP 55(a) and 55(b); and TBMP §317.

The issue of whether default judgment should be entered against a defendant, for failure to file a timely answer to the complaint, may also be raised by means other than the Board's issuance of a notice of default. For example, the plaintiff, realizing that the defendant is in default, may file a motion for default judgment (in which case the motion may serve as a substitute for the Board's issuance of a notice of default); or the defendant itself, realizing that it is in default, may file a motion asking that its late-filed answer be accepted. However the issue is raised, the standard for determining whether default judgment should be entered against the defendant, for its failure to file a timely answer to the complaint, is the FRCP 55(c) standard, which requires that the defendant show good cause why default judgment should not be entered against it. See TBMP §317, and authorities cited therein.

If a plaintiff files a motion for default judgment for failure of the defendant to file a timely answer to the complaint, and the defendant fails to file a brief in opposition to the plaintiff's motion, default judgment may be entered against defendant. See FRCP 55(b) and 55(c), and 37 CFR §2.127(a).

If a defendant files an answer after the due date therefor, but before the issuance by the Board of a notice of default, and also files a motion asking that the late-filed answer be accepted, and the plaintiff fails to file a brief in opposition to the defendant's motion, the motion may be granted as conceded. See 37 CFR §2.127(a), and TBMP §502.03.

For further information concerning default judgment for failure of the defendant to file a timely answer to the complaint, see TBMP §317.

509 Motion to Extend Time; Motion to Reopen Time

OLD EDITION

FRCP 6(b) Enlargement. When by these rules or by a notice given thereunder or by order of court an act is required or allowed to be done at or within a specified time, the court for cause shown may at any time in its discretion (1) with or without motion or notice order the period enlarged if request therefor is made before the expiration of the period originally prescribed or as extended by a previous order, or (2) upon motion made after the expiration of the specified period permit the act to be done where the failure to act was the result of excusable neglect; but it may not extend the time for taking any action under Rules ... 60(b) ... except to the extent and under the conditions stated in them.

509.01 Nature of Motions

A party may file a motion for an enlargement of the time in which an act is required or allowed to be done. If the motion is filed prior to the expiration of the period as originally set or previously extended, the motion is a motion to extend, and the moving party need only show good cause for the requested extension. If, however, the motion is not filed until after the expiration of the period as originally set or previously extended, the motion is a motion to reopen, and the moving party must show that its failure to act during the time allowed therefor was the result of excusable neglect. See, for example, FRCP 6(b); Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984); Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982); Terra Products Corp. v. Comez, 206 USPQ 1033 (TTAB 1979); and Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509 (TTAB 1976).

For further information concerning good cause for a motion to extend, see Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 USPQ 888 (CCPA 1980); American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); and Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975).

OLD EDITION

For further information concerning excusable neglect for a motion to reopen, see Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); American Vitamin Products, Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992); Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., 14 USPQ2d 2064 (TTAB 1990); Consolidated Foods Corp. v. Berkshire Handkerchief Co., 229 USPQ 619 (TTAB 1986); Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984); Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982); Terra Products Corp. v. Comez, 206 USPQ 1033 (TTAB 1979); Riko Enterprises, Inc. v. Lindsley, 198 USPQ 480 (Comm'r 1977); Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976); Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 428 (TTAB 1976), recon. denied, 190 USPQ 431 (TTAB 1976); Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509 (TTAB 1976); Volkswagenwerk Aktiengesellschaft v. Advance Welding & Mfg. Corp., 184 USPQ 367 (TTAB 1974); Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973); Perfect Film & Chemical Corp. v. Society Ordinastral, 172 USPQ 696 (TTAB 1972); American Home Products Corp. v. David Kamenstein, Inc., 172 USPQ 376 (TTAB 1971); Wilson Sporting Goods Co. v. Northwestern Golf Co., 169 USPQ 510 (TTAB 1971); and Clairol Inc. v. Holland Hall Products, Inc., 161 USPQ 616 (TTAB 1969). Cf. Williams v. Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975), and In re Sotheby's Inc., 18 USPQ2d 1969 (Comm'r 1989).

If a party files a motion to reopen its testimony period to introduce newly discovered evidence, the moving party must show not only that the proposed evidence has been newly discovered, but also that the evidence could not have been discovered earlier through the exercise of reasonable diligence. See, for example Rowell Laboratories, Inc. v. Canada Packers Inc., 215 USPQ 523 (TTAB 1982); Oxford Pendaflex Corp. v. Roladex Corp., 204 USPQ 249 (TTAB 1979); Wilson Sporting Goods Co. v. Northwestern Golf Co., 169 USPQ 510 (TTAB 1971); and United States Plywood Corp. v. Modiglass Fibers, Inc., 125 USPQ 144 (TTAB 1960). See also Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc., 221 USPQ 354 (TTAB 1984); Tektronix, Inc. v. Daktronix, Inc., 187 USPQ 588 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495 (TTAB 1970).

OLD EDITION

509.02 Form and Determination of Motions

If a motion to extend or a motion to reopen is made with the consent of the nonmoving party, the motion may be filed either as a stipulation with the signature of both parties, or as a consented motion in which the moving party states that the nonmoving party has given its oral consent thereto. Ordinarily, a consented motion to extend or reopen will be granted by the Board.

Any consented motion to extend or reopen a time or times should be filed in multiple form, i.e., one copy of the stipulation for the Board proceeding file, plus as many additional copies as there are parties, so that if the stipulation is approved, it may be so stamped by the Board, and an approved copy may be returned promptly to each party. See 37 CFR §§2.102(d) and 2.121(d), and TBMP §§501.03 and 502.02. Cf. TBMP §403.03.

Further, a consented motion to extend or reopen a time or times should specify the closing date for each rescheduled time. A consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, should be submitted in the form used in a trial order, specifying the closing date for each period to be reset. See 37 CFR §2.121(d). If a consented motion to extend or reopen testimony periods, or the discovery period and testimony periods, specifies only the closing date for the first period to be reset, and the motion is approved, the Board will automatically reschedule the subsequent periods as well. See 37 CFR §2.121(a). However, receipt by the parties of the Board's action on the motion will be delayed, because the Board will not be able to simply stamp the motion "Approved" and return the copies to the parties, but rather will have to prepare a letter indicating that the motion has been approved and specifying the closing date for each period being rescheduled.

When a motion to extend, or a motion to reopen, is filed without the consent of the nonmoving party, it should be filed in single (not multiple) form. The Board normally will defer action on the motion until after the expiration of the nonmoving party's time to file a brief in opposition to the motion. Cf. 37 CFR §2.127(a). If the nonmoving party fails to file a brief in opposition thereto, the motion normally will be granted by the Board as conceded. See 37 CFR §2.127(a), and TBMP §502.03. If the motion is contested by the nonmoving party, the Board will decide the motion on its merits.

OLD EDITION

A party has no right to assume that its motion to extend (much less a motion to reopen) made without the consent of the adverse party will always be granted automatically. See Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 USPQ 888 (CCPA 1980). Moreover, while the Board attempts, where possible, to notify the parties of its decision on an unconsented motion to extend, or a motion to reopen, prior to expiration of the enlargement sought, the Board is under no obligation to do so, and in many cases cannot. See Chesebrough-Pond's Inc. v. Faberge, Inc., supra. Cf. TBMP §202.01; In re Holland American Wafer Co., 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984); In re L.R. Sport Inc., 25 USPQ2d 1533 (Comm'r 1992); and In re Application Papers Filed November 12, 1965, 152 USPQ 194 (Comm'r 1966). Therefore, it is preferable, at least where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion.

The resetting of the closing date for discovery will result in the automatic rescheduling of the testimony periods by the Board. However, the resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods--such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a).

When a motion other than a motion to extend has been filed, a party should not presume that the Board will automatically reset trial dates when it determines the pending motion. When the Board determines a pending motion, and there is no motion to extend trial dates, the Board, in the exercise of its discretion, may or may not reset trial dates. A party which wishes to have trial dates reset upon the determination of a particular motion should file a motion requesting such action, and specifying the dates which it wishes to have reset.

Extensions of time to seek judicial review of a final decision of the Board (whether by way of appeal to the Court of Appeals for the Federal Circuit or by way of a civil action) may be granted by the Commissioner upon written request, which should be directed to the Office of the Solicitor (not the Board). See 37 CFR §2.145(e); Appeals to the Federal Circuit from PTO, 1120 TMOG 22 (November 13, 1990); and TBMP §§902.02 and 903.04.

OLD EDITION

510 Motion to Suspend; Motion to Resume

37 CFR §2.117 Suspension of proceedings.
(a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that parties to a pending case are engaged in a civil action which may be dispositive of the case, proceedings before the Board may be suspended until termination of the civil action.

(b) Whenever there is pending, at the time when the question of the suspension of proceedings is raised, a motion which is potentially dispositive of the case, the motion may be decided before the question of suspension is considered.

(c) Proceedings may also be suspended, for good cause, upon motion or a stipulation of the parties approved by the Board.

OLD EDITION

510.01 In General

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board. See 37 CFR §2.117, and Opticians Ass'n of America v. Independent Opticians of America Inc., 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990). Some of the most common reasons for suspension are discussed below.

510.02 Suspension Pending Outcome of Another Proceeding

510.02(a) Suspension

Whenever it comes to the attention of the Board that the parties to a case pending before it are involved in a civil action which may be dispositive of the Board case, proceedings before the Board may be suspended until final determination of the civil action. See, for example, 37 CFR §2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992); Toro Co. v. Hardigg Industries, Inc., 187 USPQ 689 (TTAB 1975), rev'd on other grounds,

549 F.2d 785, 193 USPQ 149 (CCPA 1977); Other Telephone Co. v. Connecticut National Telephone Co., 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974); Tokaido v. Honda Associates Inc., 179 USPQ 861 (TTAB 1973); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971); Squirrel Brand Co. v. Barnard Nut Co., 101 USPQ 340 (Comm'r 1954); Townley Clothes, Inc. v. Goldring, Inc., 100 USPQ 57 (Comm'r 1953); and David B. Allen, TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act, 74 Trademark Rep. 180 (1984).

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a Federal district court. To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See, for example, Goya Foods Inc. v. Tropicana Products Inc., 846 F.2d 848, 6 USPQ2d 1950 (2d Cir.1988); American Bakeries Co. v. Pan-O-Gold Baking Co., 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986); Toro Co. v. Hardigg Industries, Inc., 187 USPQ 689 (TTAB 1975), rev'd on other grounds, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); Other Telephone Co. v. Connecticut National Telephone Co., 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974); Tokaido v. Honda Associates Inc., 179 USPQ 861 (TTAB 1973); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971); Tuvache, Inc. v. Emilio Pucci Perfumes International, Inc., 263 F. Supp. 104, 152 USPQ 574 (S.D.N.Y. 1967); Marc A. Bergsman, TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings, 80 Trademark Rep. 540 (1990); and David B. Allen, TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act, 74 Trademark Rep. 180 (1984).

OLD EDITION

However, the Board may also, in its discretion, suspend pending the final determination of another Board proceeding in which the parties are involved, or a civil action pending between the parties in a state court (see Mother's Restaurant Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983), and Argo & Co. v. Carpetsheen Manufacturing, Inc., 187 USPQ 366 (TTAB 1975)), or a foreign action between the parties, wherein one party challenges the validity of a foreign registration upon which the other party's subject application is based (see Marie Claire Album S.A. v. Kruger GmbH & Co. KG, 29 USPQ2d 1792 (TTAB 1993), and Fioravanti v. Fioravanti Corrado S.R.L., 230 USPQ 36

(TTAB 1986), recon. denied, 1 USPQ2d 1304 (TTAB 1986)) or even another proceeding in which only one of the parties is involved (see Argo & Co. v. Carpetsheen Manufacturing, Inc., supra).

Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board. See, for example Other Telephone Co. v. Connecticut National Telephone Co., 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974); Tokaido v. Honda Associates Inc., 179 USPQ 861 (TTAB 1973); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971); and Martin Beverage Co. v. Colita Beverage Corp., 169 USPQ 568 (TTAB 1971). But see E.I. du Pont de Nemours & Co. v. G.C. Murphy Co., 199 USPQ 807 (TTAB 1978), and Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973) (in each case, a motion to suspend filed after the conclusion of testimony and briefing periods, when the Board proceeding was ready for decision, was denied).

Suspension of a Board proceeding pending the final determination of another proceeding is solely within the discretion of the Board; the court in which a civil action is pending has no power to suspend proceedings in a case before the Board, nor do parties or their attorneys. See Opticians Ass'n of America v. Independent Opticians of America Inc., 734 F. Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990), and Martin Beverage Co. v. Colita Beverage Corp., 169 USPQ 568 (TTAB 1971). However, if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding, the Board will go forward with its proceeding. See David B. Allen, TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act, 74 Trademark Rep. 180 (1984).

When a motion to suspend pending the outcome of a civil action is filed, the Board normally will require that a copy of the pleadings from the civil action be submitted, so that the Board can ascertain whether the final determination of the civil action will have a bearing on the issues before the Board. See SCOA Industries Inc. v. Kennedy & Cohen, Inc., 188 USPQ 411 (TTAB 1975). This requirement ordinarily is waived if the parties stipulate to the suspension.

The Board does not usually require that issue be joined (i.e., that an answer be filed) in one or both proceedings before the Board will consider suspending a Board proceeding pending the outcome of another proceeding. Such a

OLD EDITION

requirement is made only in those cases where there is no stipulation to suspend and it is not possible for the Board to ascertain, prior to the filing of an answer in one or both proceedings, whether the final determination of the other proceeding will have a bearing on the issues before the Board. See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23129, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 19.

If there is pending, at the time when the question of suspension of proceedings before the Board is raised, a motion which is potentially dispositive of the case, the potentially dispositive motion may be decided before the question of suspension is considered. See 37 CFR §2.117(b), and Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23129, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 20. Cf. Allegro High Fidelity, Inc. v. Zenith Radio Corp., 197 USPQ 550 (TTAB 1977); Continental Specialties Corp. v. Continental Connector Corp., 192 USPQ 449 (TTAB 1976); and Toro Co. v. Hardigg Industries, Inc., 187 USPQ 689 (TTAB 1975), rev'd on other grounds, 549 F.2d 785, 193 USPQ 149 (CCPA 1977) (NOTE: each of these cases was decided prior to the adoption, in 1983, of 37 CFR §2.117(b)). The purpose of this practice is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially dispositive motion. See David B. Allen, TIPS FROM THE TTAB: Impact of TTAB Decisions in Civil Litigation: The Alphonse-Gaston Act, 74 Trademark Rep. 180 (1984). However, the Board, in its discretion, may elect to suspend without first deciding the potentially dispositive motion. See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23129, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 20.

OLD EDITION

510.02(b) Resumption

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been finally determined, the interested party should file a paper notifying the Board of the disposition of the other proceeding, and requesting that further appropriate action be taken in the Board proceeding (i.e., usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding). The paper should be accompanied by a copy of the decision in the other proceeding.

A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided.

510.03 Suspension for Other Reasons

510.03(a) Suspension

The Board suspends proceedings in cases before it for a wide variety of reasons.

Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board. See 37 CFR §2.117(c). For example, proceedings may be suspended, upon motion or stipulation under 37 CFR §2.117(c), for purposes of settlement negotiations, subject to the right of either party to request resumption at any time. See MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979).

The Board will automatically suspend proceedings in a case before it if it comes to the attention of the Board that the defendant has filed a petition for bankruptcy. See In re Checkers of North America Inc., 23 USPQ2d 1451 (Comm'r 1992). Under the automatic stay provisions of Section 362 of the United States Bankruptcy Code, 11 U.S.C. §362, a petition for bankruptcy (filed under Section 301, 302, or 303 of the Code, 11 U.S.C. §301, 302, or 303) operates as a stay, inter alia, of the commencement or continuation of a judicial, administrative, or other process against the debtor that was or could have been commenced before the commencement of the bankruptcy case. However, if it is the Board proceeding plaintiff, rather than defendant, which has filed a petition for bankruptcy, the automatic stay provisions do not mandate the suspension of the Board proceeding unless there is a counterclaim in the Board proceeding for cancellation of the plaintiff's registration(s).

If, in a Board proceeding, a party's attorney or other authorized representative files a request to withdraw as counsel for the party, and the request is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it

OLD EDITION

desires to represent itself, failing which the Board may issue an order to show cause why default judgment should not be entered against the party. See, with respect to withdrawal of counsel, TBMP §§116.02-116.05 and 513.01. For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP §510.03(b). A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance in the party's behalf in the proceeding. See TBMP §114.03. See also TBMP §§114.04 and 114.05.

When a party to a Board proceeding files a motion which is potentially dispositive of the proceeding, such as a motion to dismiss, a motion for judgment on the pleadings, or a motion for summary judgment, the case will be suspended by the Board with respect to all matters not germane to the motion. See 37 CFR §2.127(d); Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985); Nestle Co. v. Joyva Corp., 227 USPQ 477 (TTAB 1985); and MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979). The filing of a potentially dispositive motion does not, in and of itself, operate to suspend a case; until the Board issues its suspension order, all times continue to run. See SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994), and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986). Once the Board has suspended proceedings in a case pending determination of a potentially dispositive motion, no party should file any paper which is not relevant to the motion. See 37 CFR §2.127(d); Pegasus Petroleum Corp. v. Mobil Oil Corp., supra; and Nestle Co. v. Joyva Corp., supra.

Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions pursuant to 37 CFR §2.124, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions upon written questions. See 37 CFR §2.124(d)(2), and TBMP §714.04.

OLD EDITION

510.03(b) Resumption

When proceedings are suspended for purposes of settlement negotiations, the Board normally sets a specific period of suspension (up to six months). Each party has the right to request resumption at any time during the suspension period. See MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB

1979). If no word is heard from either party prior to the expiration of the suspension period, the Board resumes proceedings. Until the Board issues an order resuming proceedings and setting new response and/or trial dates, proceedings remain suspended, despite the fact that the suspension period set by the Board has run.

When proceedings have been suspended by the Board because a Board proceeding defendant (or plaintiff whose registration is the subject of a counterclaim) has filed a petition for bankruptcy, the Board periodically inquires as to the status of the bankruptcy case. In order to expedite matters, however, when the bankruptcy case has been concluded, or the involved application or registration of the bankrupt party has been transferred to some other person, the interested party should immediately file a paper notifying the Board thereof. Once the Board has been notified of the outcome of the bankruptcy case, and/or of the disposition of the bankrupt's involved application or registration, the Board will resume proceedings and take further appropriate action.

If proceedings have been suspended in order to allow a party, whose attorney or other authorized representative has withdrawn, a period of time in which to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself (see TBMP §510.03(a)), and new counsel is appointed (and the Board is informed thereof) during the time allowed, the Board will resume proceedings, and go forward with that person representing the party. If, instead, the party files a paper stating that it desires to represent itself, the Board will resume proceedings and go forward with the party representing itself, but the party may employ a new attorney or other authorized representative at any time thereafter. If the party fails, during the time allowed, to either appoint new counsel (and inform the Board thereof) or file a paper stating that it desires to represent itself, the Board may issue an order noting that the party appears to have lost interest in the case, and allowing the party time in which to show cause why default judgment should not be entered against it. If the party, in turn, files a response indicating that it has not lost interest in the case, default judgment will not be entered against it. If the party fails to file a response to the show cause order, default judgment may be entered against it.

When proceedings have been suspended pending determination of a potentially dispositive motion, and the determination of the motion does not dispose of the case, the Board, in its decision on the motion, will issue an order resuming proceedings, and taking further appropriate action. See 37 CFR §2.127(d).

OLD EDITION

511 Motion to Consolidate

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See FRCP 42(a); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991); Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987); Federated Department Stores, Inc. v. Gold Circle Insurance Co., 226 USPQ 262 (TTAB 1985); Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199 (TTAB 1981), set aside on other grounds and new decision entered, 217 USPQ 464 (TTAB 1983); World Hockey Ass'n v. Tudor Metal Products Corp., 185 USPQ 246 (TTAB 1975); and Izod, Ltd. v. La Chemise Lacoste, 178 USPQ 440 (TTAB 1973). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. See, for example, Wright & Miller, Federal Practice and Procedure: Civil §2383 (1971); Lever Brothers Co. v. Shaklee Corp., 214 USPQ 654 (TTAB 1982) (consolidation denied where one case was just in pleading stage, and testimony periods had expired in other); Envirotech Corp. v. Solaron Corp., 211 USPQ 724 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same and issue was likelihood of confusion); World Hockey Ass'n v. Tudor Metal Products Corp., supra (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties); and Izod, Ltd. v. La Chemise Lacoste, supra (consolidation denied where issues differed). Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered (see Bigfoot 4x4 Inc. v. Bear Foot Inc., supra), it is not always necessary (see Wright & Miller, supra, at §2384, and Izod, Ltd. v. La Chemise Lacoste, supra).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, for example, Wright & Miller, Federal Practice and Procedure: Civil §2383 (1971); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993) (stipulation); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) (Board's initiative); Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989) (stipulation); Bigfoot 4x4 Inc. v. Bear Foot Inc., 5

OLD EDITION

USPQ2d 1444 (TTAB 1987) (joint motion); Federated Department Stores, Inc. v. Gold Circle Insurance Co., 226 USPQ 262 (TTAB 1985) (motion); Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199 (TTAB 1981), set aside on other grounds and new decision entered, 217 USPQ 464 (TTAB 1983) (motion); World Hockey Ass'n v. Tudor Metal Products Corp., 185 USPQ 246 (TTAB 1975) (Board's initiative).

Generally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until issue has been joined) in each case sought to be consolidated. However, the Board may, in its discretion, order cases consolidated prior to joinder of issue. Cf. 37 CFR §§2.104(b) and 2.114(b), and TBMP §306.

When cases have been ordered consolidated, they may (but do not have to) be presented on the same records and briefs. See Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989); Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987); Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199 (TTAB 1981), set aside on other grounds and new decision entered, 217 USPQ 464 (TTAB 1983); World Hockey Ass'n v. Tudor Metal Products Corp., 185 USPQ 246 (TTAB 1975). Papers filed therein should bear the number of each of the consolidated cases. The oldest (i.e., first-filed) of the consolidated cases is treated as the "parent" case. With certain exceptions (such as the pleadings and all other papers up to the point of consolidation, the consolidation order, and the Board's final decision), most of the papers filed by the parties, or issued by the Board, in a consolidated proceeding are placed only in the file of the parent case. Thus, parties filing papers in a consolidated proceeding usually need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient.

When actions by different plaintiffs are consolidated, and the plaintiffs are represented by different counsel, the plaintiffs may be required to appoint one lead counsel to supervise and coordinate the conduct of the plaintiffs' cases. See TBMP §117.02.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

OLD EDITION

512 Motion to Join or Substitute

512.01 Assignment of Mark

When there has been an assignment of a mark which is the subject of, or relied upon in, an inter partes proceeding before the Board, the assignee may be joined or substituted, as may be appropriate, upon motion granted by the Board, or upon the Board's own initiative.

When a mark which is the subject of a Federal application or registration has been assigned, together with the application or registration, in accordance with Section 10 of the Act, 15 U.S.C. §1060, any action with respect to the application or registration which may or must be taken by the applicant or registrant may be taken by the assignee (acting itself, or through its attorney or other authorized representative), provided that the assignment has been recorded or that proof of the assignment has been submitted. See 37 CFR §§3.71 and 3.73(b). If the mark in an application or registration which is the subject matter of an inter partes proceeding before the Board is assigned, together with the application or registration, the assignee may be joined as a party (as a party defendant, in the case of an opposition or cancellation proceeding; or as a junior or senior party, as the case may be, in an interference or concurrent use proceeding) upon the filing with the Board of a copy of the assignment. When the assignment is recorded in the Assignment Branch of the PTO, the assignee may be substituted as a party if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. See, for example, 37 CFR §§2.113, 3.71 and 3.73(b); FRCP 17 and 25; Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993); Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990); Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857 (TTAB 1986); Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984); Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc., 217 USPQ 810 (TTAB 1982); Liberty & Co. v. Liberty Trouser Co., 216 USPQ 65 (TTAB 1982); Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976); and Aloe Creme Laboratories, Inc. v. Aloe 99, Inc., 188 USPQ 316 (TTAB 1975).

OLD EDITION

If a mark pleaded by a plaintiff is assigned, and a copy of the assignment is filed with the Board, the assignee ordinarily will be substituted if the assignment occurred prior to the commencement of the proceeding, or the discovery and testimony periods have closed, or the assignor is no longer in existence, or the defendant raises no objection to substitution; otherwise, the assignee will be joined, rather than substituted, to facilitate the taking of discovery and the introduction of evidence. The assignment does not have to be recorded with respect to a plaintiff's pleaded application or registration before substitution or joinder (whichever is appropriate) is made. However, recordation is advisable because it will aid the assignee in its effort to prove ownership of the application or registration at trial. See, for example, FRCP 17 and 25; 37 CFR §2.102(b); TBMP §303.05(b); William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1871 (TTAB 1994); SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1707 (TTAB 1994); Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993); Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992); Huffy Corp. v. Geoffrey Inc., 18 USPQ2d 1240 (Comm'r 1990); S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987); Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988); Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985); E.E. Dickinson Co. v. T.N. Dickinson Co., 221 USPQ 713 (TTAB 1984); and Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982). Cf. Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993).

If the mark of an excepted common law user (which is not the owner of an involved application or registration) in a concurrent use proceeding is assigned, the assignee will be joined or substituted as party defendant upon notification to the Board of the assignment. See Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993), and Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc., 215 USPQ 1133 (TTAB 1982).

Alternatively, if there has been an assignment of a mark which is the subject of, or is relied upon in, a proceeding before the Board, and the Board does not order that the assignee be joined or substituted in the proceeding, the proceeding may be continued in the name of the assignor. See FRCP 25(c), and Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982).

Further, the fact that a third party related to the plaintiff, such as a parent or licensor of the plaintiff, may also have an interest in a mark relied on by the

OLD EDITION

plaintiff does not mean that the third party must be joined as a party plaintiff. See Avia Group International Inc. v. Faraut, 25 USPQ2d 1625 (TTAB 1992).

512.02 Change of Name

If the name of a party to an inter partes proceeding before the Board is changed, the title of the Board proceeding may be changed, upon motion or upon the Board's own initiative, to reflect the change of name, provided that appropriate evidence thereof (such as, a copy of the name change document, or the numbers of the reel and frame where such document is recorded in the Assignment Branch of the PTO) is made of record in the proceeding. See, for example, WMA Group Inc. v. Western International Media Corp., 29 USPQ2d 1478 (TTAB 1993); Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992); NutraSweet Co. v. K & S Foods Inc., 4 USPQ2d 1964 (TTAB 1987), and Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984). Cf. In re Brittains Tullis Russell Inc., 23 USPQ2d 1457 (Comm'r 1991). If no such evidence is made of record in the proceeding, the proceeding may be continued in the party's old name. See, for example, Maine Savings Bank v. First Banc Group of Ohio, Inc., 220 USPQ 736 (TTAB 1983), and National Blank Book Co. v. Leather Crafted Products, Inc., 218 USPQ 827 (TTAB 1983). Cf. FRCP 25(c).

A name change document does not have to be recorded with respect to a defendant's involved application or registration, or a plaintiff's pleaded application or registration, in order for the Board proceeding title to be changed to reflect the new name. However, recordation is advisable because it facilitates proof of ownership of the application or registration, and because filing for recordation is one of the 37 CFR §3.85 requirements for an applicant which desires, if it prevails in the proceeding, to have its registration issue in its new name (see TBMP §512.03).

512.03 Issuance of Registration to Assignee, or in New Name

37 CFR §3.85 Issue of registration to assignee.
The certificate of registration may be issued to the assignee of the applicant, or in a new name of the applicant, provided that the party files a written request in

OLD EDITION

the trademark application by the time the application is being prepared for issuance of the certificate of registration, and the appropriate document is recorded in the Office. If the assignment or name change document has not been recorded in the Office, then the written request must state that the document has been filed for recordation. The address of the assignee must be made of record in the application file.

Even where the assignee of an application which is the subject matter of a Board inter partes proceeding has been joined or substituted as a party to the proceeding (see TBMP §512.01), any registration issued from the application may issue in the name of the assignor unless the assignee complies with the requirements of 37 CFR §3.85. Specifically, to ensure that the registration will issue in its name, the assignee must file a written request in the application (or in the Board proceeding, if that proceeding has not yet ended), by the time the application is being prepared for issuance of the certificate of registration, that the registration be issued in its name. In addition, an appropriate document must be of record in the Assignment Search Room of the PTO, or the written request must state that the document has been filed for recordation. Finally, the address of the assignee must be made of record in the application file.

Similarly, even though the title of an inter partes proceeding before the Board may have been changed to reflect a name change of an applicant whose application is the subject of the proceeding, any registration issued from the application may issue in the applicant's original name unless the applicant complies with the requirements of 37 CFR §3.85. See Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992).

If an assignment or change of name document is recorded in the Assignment Search Room well prior to the time the subject application is prepared for issuance of a registration, the registration may issue in the name of the assignee, or in the new name, even if no 37 CFR §3.85 request is filed. However, the registration may issue in the name of the assignor, or in the old name. The purpose of the written request is to call the attention of the PTO to the assignment, or change of name, and thus to ensure that the registration issues in the name of the assignee, or in the new name. Accordingly, it is sufficient for the purpose if applicant files a paper referring to the assignment or change of name, and the assignment or change of name document has either been recorded, or applicant states that the document has been submitted for recording.

OLD EDITION

512.04 Misidentification

When it is shown to the satisfaction of the Board that a party in whose name a Board proceeding complaint was filed was misidentified therein by mistake, the Board may allow amendment of the complaint, pursuant to FRCP 15(a), to correct the misidentification and/or to substitute the proper party in interest. See Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985); Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505 (TTAB 1974); Textron, Inc. v. Gillette Co., 177 USPQ 530 (Comm'r 1973); Lone Star Manufacturing Co. v. Bill Beasley, Inc., 176 USPQ 426 (TTAB 1972), rev'd on other grounds, 498 F.2d 906, 182 USPQ 368 (CCPA 1974); Davidson v. Instantype, Inc., 165 USPQ 269 (TTAB 1970); Pyco, Inc. v. Pico Corp., 165 USPQ 221 (TTAB 1969); and Raker Paint Factory v. United Lacquer Mfg. Corp., 141 USPQ 407 (TTAB 1964). Cf. 37 CFR §2.102(b); TBMP §303.05(c); and Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993) (misidentification of potential opposer in request for extension of time to oppose)..

When an application or registration is the subject of an inter partes proceeding before the Board, and it is shown to the satisfaction of the Board that the applicant was misidentified in the application by mistake, the Board may allow amendment of the application or registration (and of the Board proceeding title) to correct the misidentification. See Argo & Co. v. Springer, 198 USPQ 626 (TTAB 1978); Argo & Co. v. Springer, 189 USPQ 581 (TTAB 1976); and U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc., 183 USPQ 613 (Comm'r 1974). Cf. TMEP §§802.06 and 802.07; In re Tong Yang Cement Corp., 19 USPQ2d 1689 (TTAB 1991); In re Atlanta Blue Print Co., 19 USPQ2d 1078 (Comm'r 1990); In re Techsonic Industries, Inc., 216 USPQ 619 (TTAB 1982); and In re Eucryl Ltd., 193 USPQ 377 (TTAB 1976).

OLD EDITION

513 Motion to Withdraw as Representative; Petition to Disqualify

513.01 Motion to Withdraw as Representative

37 CFR §2.19(b) An individual authorized to represent an applicant or party in a trademark case may withdraw upon application to and approval by the Commissioner.

37 CFR §10.40 Withdrawal from employment.
(a) A practitioner shall not withdraw from employment in a proceeding before the Office without permission from the Office (see §§1.36 and 2.19 of this subchapter). In any event, a practitioner shall not withdraw from employment until the practitioner has taken reasonable steps to avoid foreseeable prejudice to the rights of the client, including giving due notice to his or her client, allowing time for employment of another practitioner, delivering to the client all papers and property to which the client is entitled, and complying with applicable laws and rules. A practitioner who withdraws from employment shall refund promptly any part of a fee paid in advance that has not been earned.

(b) Mandatory withdrawal. A practitioner representing a client before the Office shall withdraw from employment if:

(1) The practitioner knows or it is obvious that the client is bringing a legal action, commencing a proceeding before the Office, conducting a defense, or asserting a position in litigation or any proceeding pending before the Office, or is otherwise having steps taken for the client, merely for the purpose of harassing or maliciously injuring any person;

(2) The practitioner knows or it is obvious that the practitioner's continued employment will result in violation of a Disciplinary Rule;

(3) The practitioner's mental or physical condition renders it unreasonably difficult for the practitioner to carry out the employment effectively; or

(4) The practitioner is discharged by the client.

(c) Permissive withdrawal. If paragraph (b) of this section is not applicable, a practitioner may not request permission to withdraw in matters pending before the Office unless such request or such withdrawal is because:

(1) The petitioner's client:

(i) Insists upon presenting a claim or defense that is not warranted under existing law and cannot be supported by good faith argument for an extension, modification, or reversal of existing law;

(ii) Personally seeks to pursue an illegal course of conduct;

(iii) Insists that the practitioner pursue a course of conduct that is illegal or that is prohibited under a Disciplinary Rule;

(iv) By other conduct renders it unreasonably difficult for the practitioner to carry out the employment effectively;

(v) Insists, in a matter not pending before a tribunal, that the practitioner engage in conduct that is contrary to the judgment and advice of the practitioner but not prohibited under the Disciplinary Rule; or

OLD EDITION

(vi) Has failed to pay one or more bills rendered by the practitioner for an unreasonable period of time or has failed to honor an agreement to pay a retainer in advance of the performance of legal services.

(2) The practitioner's continued employment is likely to result in a violation of a Disciplinary Rule;

(3) The practitioner's inability to work with co-counsel indicates that the best interests of the client likely will be served by withdrawal;

(4) The practitioner's mental or physical condition renders it difficult for the practitioner to carry out the employment effectively;

(5) The practitioner's client knowingly and freely assents to termination of the employment; or

(6) The practitioner believes in good faith, in a proceeding pending before the Office, that the Office will find the existence of other good cause for withdrawal.

A practitioner who wishes to withdraw from employment as the attorney or other authorized representative of a party to a proceeding before the Board must file a request with the Board for permission to do so. The request to withdraw must be based upon one of the grounds for mandatory or permissive withdrawal listed in 37 CFR §§10.40(b) and 10.40(c). Moreover, the practitioner must comply with the requirements of 37 CFR §10.40(a). See 37 CFR §§2.19(b) and 10.40. Cf. In re Legendary Inc., 26 USPQ2d 1478 (Comm'r 1992).

A request for permission to withdraw should include (1) a specification of the basis for the request; (2) a statement that the practitioner has notified the client of his or her desire to withdraw from employment, and has allowed time for employment of another practitioner; (3) a statement that all papers and property that relate to the proceeding and to which the client is entitled have been delivered to the client; (4) if any part of a fee paid in advance has not been earned, a statement that the unearned part has been refunded; and (5) proof of service of the request upon the client and upon every other party to the proceeding. See 37 CFR §10.40. Cf. In re Legendary Inc., 26 USPQ2d 1478 (Comm'r 1992).

If the request is granted, the Board will suspend proceedings and allow the party a stated period of time (usually 30 days) in which to appoint a new attorney or other authorized representative (and inform the Board thereof), or to file a paper stating that it desires to represent itself, failing which the Board may issue an order to show cause why default judgment should not be entered against the

OLD EDITION

party based on the party's apparent loss of interest in the case. See Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993).

A party may inform the Board of the appointment of new counsel either by filing written notification thereof (as, for example, by filing a copy of the new appointment), or by having new counsel make an appearance in the party's behalf in the proceeding. See TBMP §114.03. See also TBMP §§114.04 and 114.05.

For information concerning action by the Board after expiration of the time allowed in the suspension order, see TBMP §510.03(b). For further information concerning withdrawal of counsel, see TBMP §§116.02-116.05. Cf. TMEP §602.03(a).

OLD EDITION

513.02 Petition to Disqualify

37 CFR §10.130(b) Petitions to disqualify a practitioner in ex parte or inter partes cases in the Office are not governed by §§10.130 through 10.170 and will be handled on a case-by-case basis under such conditions as the Commissioner deems appropriate.

If a party to an inter partes proceeding before the Board believes that a practitioner representing another party to the proceeding should be disqualified (due, for example, to a conflict of interest, or because the practitioner may testify in the proceeding as a witness on behalf of his client), the party may file a petition to disqualify the practitioner.

Petitions to disqualify are not disciplinary proceedings and hence are not governed by 37 CFR §§10.130-10.170. Rather, petitions to disqualify are governed by 37 CFR §10.130(b), and are determined in the manner specified in that rule. For examples of cases involving petitions to disqualify, see the decisions cited in TBMP §114.08.

When a petition to disqualify is filed in connection with a proceeding pending before the Board, the Board immediately issues an action suspending proceedings in the case and advising the parties that no additional papers should be filed by the parties until further notice, pending consideration of the petition. After the petition has been determined or dismissed, the Board issues an action

resuming proceedings in the case, and taking further appropriate action therein.

With respect to disqualification due to an asserted conflict of interest, see TBMP §114.08, and authorities cited therein. With respect to disqualification due to testimony on behalf of client, see 37 CFR §10.63; Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992); and Little Caesar Enterprises Inc. v. Domino's Pizza Inc., 11 USPQ2d 1233 (Comm'r 1989). Cf. Computer Associates International Inc. v. Computer Automation Inc., 678 F. Supp. 424, 6 USPQ2d 1459 (S.D.N.Y. 1987).

514 Motion to Amend Application or Registration

37 CFR §2.133(a) An application involved in a proceeding may not be amended in substance nor may a registration be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or except upon motion.

(b) If, in an inter partes proceeding, the Trademark Trial and Appeal Board finds that a party whose application or registration is the subject of the proceeding is not entitled to registration in the absence of a specified restriction to the involved application or registration, the Trademark Trial and Appeal Board will allow the party time in which to file a request that the application or registration be amended to conform to the findings of the Trademark Trial and Appeal Board, failing which judgment will be entered against the party.

(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.

OLD EDITION

514.01 In General

The amendment of any application or registration which is the subject of an inter partes proceeding before the Board is governed by 37 CFR §2.133. Thus, an application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and

the approval of the Board, or except upon motion. Similarly, a registration which is the subject of a Board inter partes proceeding may not be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Board, or except upon motion. See 37 CFR §2.133(a). Cf. TBMP §212.

A proposed amendment must also comply with all other applicable rules and statutory provisions. These include 37 CFR §§2.71-2.75, in the case of a proposed amendment to an application; and 37 CFR §2.173 and Section 7(e) of the Act, 15 U.S.C. §1057(e), in the case of a proposed amendment to a registration. Thus, for example, a proposed amendment which involves an addition to the identification of goods or services, or which materially alters the character of the subject mark, will not be approved by the Board. See Section 7(e) of the Act; 37 CFR §§2.71(b), 2.72, and 2.173(a) and 2.173(b); and Aries Systems Corp. v. World Book Inc., 26 USPQ2d 1926 (TTAB 1993). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991).

A request to amend an application or registration which is the subject of a Board inter partes proceeding should bear at its top both the number of the subject application or registration, and the Board proceeding number and title. In addition, the request should include proof of service of a copy thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

When the Board grants a request to amend a registration which is the subject of a Board inter partes proceeding, and forwards the registration to the Post Registration branch of the Office of Trademark Services for amendment of the registration, action by the Post Registration branch is limited to the ministerial duty of ensuring that the authorized change to the registration is made. See In re Pamex Foods, Inc., 209 USPQ 275 (Comm'r 1980).

OLD EDITION

514.02 Amendment With Consent

When a request to amend an application or registration which is the subject of a Board inter partes proceeding is made with the consent of the other party or parties, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request ordinarily will be approved by the Board.

514.03 Amendment Without Consent

The Board, in its discretion, may grant a motion to amend an application or registration which is the subject of an inter partes proceeding, even if the other party or parties do not consent thereto. See 37 CFR §2.133(a).

When a motion to amend an application or registration in substance is made without the consent of the other party or parties, it ordinarily should be made prior to trial, in order to give the other party or parties fair notice thereof; an unconsented motion to amend which is not made prior to trial, and which, if granted, would affect the issues involved in the proceeding, normally will be denied by the Board unless the matter is tried by express or implied consent of the parties pursuant to FRCP 15(b). See, for example, Signal Companies v. Southwestern Petroleum Corp., 181 USPQ 599 (TTAB 1973), and Mack Trucks, Inc. v. Hydra-Mac, Inc., 180 USPQ 147 (TTAB 1973), aff'd, Hydra-Mac, Inc. v. Mack Trucks, Inc., 507 F.2d 1399, 184 USPQ 351 (CCPA 1975). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991). Cf. Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990), and TBMP §§311, 321, and 507.

The Board generally will defer determination of an unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment. See Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990) (defendant's motion to amend its identification of goods to include restriction); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987) (defendant's motion to amend dates of use in its subject application); and Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985) (defendant's motion to amend dates of use in its subject application). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991).

If a defendant, whose application or registration is the subject of a Board inter partes proceeding, wishes to defend by asserting that it is at least entitled to a registration with a particular restriction, the defense should be raised either in the defendant's answer to the complaint, or by way of a timely motion to amend the application or registration to include the restriction. See 37 CFR §§2.133(a) and 2.133(b); Personnel Data Systems Inc. v. Parameter Driven Software Inc., 20 USPQ2d 1863 (TTAB 1991); Flow Technology Inc. v. Picciano, 18 USPQ2d

OLD EDITION

1970 (TTAB 1991); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); TBMP §318.02(b); and Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991). The proposed restriction should be described in defendant's pleading, or in its motion to amend, in sufficient detail to give the plaintiff fair notice thereof. See Space Base Inc. v. Stadis Corp., supra, and TBMP §318.02(b). See also Flow Technology Inc. v. Picciano, supra.

If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction which was timely proposed by the defendant, the proposed restriction will be approved and entered. If a further refinement thereof is found necessary by the Board, and is within the scope of the notice given to plaintiff by defendant, or was tried with the express or implied consent of plaintiff, defendant will be allowed time in which to file a request that its application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party. See 37 CFR §2.133(b), and Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991). See also Section 18 of the Act, 15 U.S.C. §1068. If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered. See Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, supra.

Geographic limitations will be considered and determined by the Board only in the context of a concurrent use proceeding. See 37 CFR §2.133(c), and TBMP §1101.02. Moreover, Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173 cannot be used to impose concurrent use restrictions on registrations. See In re Forbo, 4 USPQ2d 1415 (Comm'r 1984), and In re Alfred Dunhill Ltd., 4 USPQ2d 1383 (Comm'r 1987). However, an applicant whose geographically unrestricted application is the subject of an opposition proceeding may file a motion to amend its application to one for a concurrent use registration, with the opposer being recited as the exception to the applicant's right to exclusive use. If the proposed amendment is otherwise appropriate, and is made with the consent of the opposer, the opposition will be dismissed without prejudice in favor of a concurrent use proceeding. If the opposer does not consent to the amendment, the amendment may nevertheless be approved and entered, and a concurrent use proceeding instituted, provided that applicant agrees to accept entry of judgment against itself in the opposition with respect to its request for a geographically unrestricted registration. See TBMP §1112; Faces, Inc. v. Face's, Inc., 222 USPQ 918 (TTAB 1983); Louise E. Rooney, TIPS FROM THE TTAB: Rule

OLD EDITION

2.133 Today, 81 Trademark Rep. 408 (1991); and Janet E. Rice, TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings, 76 Trademark Rep. 252 (1986).

514.04 Amendment to Allege Use; Statement of Use

For information concerning the handling of an amendment to allege use, or a statement of use, filed during an opposition proceeding in an intent-to-use application which is the subject of the opposition, see TBMP §219.

515 Motion to Remand Application to Examining Attorney

37 CFR §2.130 New matter suggested by Examiner of Trademarks.
If, during the pendency of an inter partes case, facts appear which, in the opinion of the Examiner of Trademarks, render the mark of any applicant involved unregistrable, the attention of the Trademark Trial and Appeal Board shall be called thereto. The Board may suspend the proceeding and refer the application to the Examiner of Trademarks for his determination of the question of registrability, following the final determination of which the application shall be returned to the Board for such further inter partes action as may be appropriate. The consideration of such facts by the Examiner of Trademarks shall be ex parte, but a copy of the action of the examiner will be furnished to the parties to the inter partes proceeding.

37 CFR §2.131 Remand after decision in inter partes proceeding.
If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Board. If, upon reexamination, the examiner finally refuses

OLD EDITION

registration to the applicant, an appeal may be taken as provided by §§2.141 and 2.142.

If, during the pendency of an opposition, concurrent use, or interference proceeding, the Examining Attorney learns of facts which, in his or her opinion, render the subject mark of an involved applicant unregistrable, the Examining Attorney may file a request that the Board suspend the inter partes proceeding, and remand the application to the Examining Attorney for further ex parte examination. See 37 CFR §2.130.

There is no provision under which such a remand may be made upon motion by a party to the proceeding. Moreover, a request to amend an application which is the subject of an inter partes proceeding before the Board is not remanded to the Examining Attorney for consideration, but rather is considered and determined by the Board. See generally 37 CFR §2.133(a), and TBMP §514.

However, if, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to FRCP 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, include a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the Examining Attorney reexamine the application in light of the disclosed facts. See, for example, 37 CFR §2.131; First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628 (TTAB 1988); West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co., 2 USPQ2d 1306 (TTAB 1987); Floralife, Inc. v. Floraline International Inc., 225 USPQ 683 (TTAB 1984); Wilderness Group, Inc. v. Western Recreational Vehicles, Inc., 222 USPQ 1012 (TTAB 1984); Color Key Corp. v. Color 1 Associates, Inc., 219 USPQ 936 (TTAB 1983); and Antillian Cigar Corp. v. Benedit Cigar Corp., 218 USPQ 187 (TTAB 1983). A 37 CFR §2.131 remand may be made by the Board upon its own initiative, or upon request granted by the Board. Thus, if a party to the proceeding believes that the facts disclosed therein appear to render the subject mark of an involved applicant unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to FRCP 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR §2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, at oral hearing, or by separate motion.

OLD EDITION

516 Motion to Divide Application

An application which is the subject of an inter partes proceeding before the Board may be physically divided into two or more separate applications upon motion granted by the Board, and payment of the required fee. See 37n CFR §2.87.

For example, if an application which is the subject of an opposition includes multiple classes (see 37 CFR §2.86(b)), not all of which have been opposed, the applicant may file a motion to divide out the unopposed classes. If applicant seeks to divide out an entire class or classes, a fee for dividing the application must be submitted for each new application to be created by the division. See 37 CFR §§2.87(a) and 2.87(b). If the motion is granted, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. §1051(b), for issuance of a notice of allowance.

Similarly, if an application which is the subject of an opposition includes more than one item of goods, or more than one service, in a single class (see 37 CFR §2.86(a)), and the opposition is not directed to all of the goods or services, the applicant may file a motion to divide out the unopposed goods or services. Applicant must also submit both a fee for dividing the application, and an application filing fee, for each new application to be created by the division. See 37 CFR §§2.87(a) and 2.87(b). If the motion is granted, each new application created by the division will be forwarded to issue or, in the case of an intent to use application filed under Section 1(b) of the Act, 15 U.S.C. §1051(b), for issuance of a notice of allowance.

Any request to divide an application which is the subject of a Board inter partes proceeding will be construed by the Board as a motion to divide, and every other party to the proceeding will be allowed an opportunity to file a brief in opposition thereto.

A registration may not be divided. See TMEP §1105.06(b).

For further information concerning division of an application, see TMEP §§1105.06 and 1105.06(a).

OLD EDITION

517 Motion to Strike Brief on Motion

517.01 Brief in Support of, or in Opposition to, Motion

Specific provision is made in the Trademark Rules of Practice for the filing of a brief in support of a motion and a brief in opposition to a motion. See 37 CFR §2.127(a). See also TBMP §502.03.

Subject to the provisions of FRCP 11, a party is entitled to offer in its brief any argument it feels will be to its advantage. Accordingly, when a brief in support of, or in opposition to, a motion has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the original motion, and any portions of the brief which are found by the Board to be improper will be disregarded.

However, if a brief in opposition to a motion is not timely filed, it may be stricken, or given no consideration, by the Board.

OLD EDITION

517.02 Reply Brief on Motion

The Trademark Rules of Practice neither specifically provide for, nor prohibit, a reply brief on a motion. Thus, when a party moves to strike a reply brief on a motion, the Board, in its discretion, may elect either to entertain the brief, or to strike it as being unwarranted under the circumstances. See TBMP §502.03, and cases cited therein.

The Board may also strike a reply brief as untimely if it is not filed within the time allowed for filing other responsive briefs on motions, i.e., within 15 days from the date of service of the paper to which the brief responds (20 days if service of the paper to which the brief responds was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §§2.119(c)), unless another time is specified by the Board, or the time is extended by stipulation of the parties approved by the Board or by order of the Board on motion for good cause. See TBMP §502.03, and authorities cited therein.

518 Motion for Reconsideration of Decision on Motion

A request for reconsideration or modification of an order or decision issued on a motion must be filed within 30 days from the date of the order or decision. See 37 CFR §2.127(b). Unless the Commissioner, upon petition, waives the time requirement of 37 CFR §2.127(b), the Board need not consider a request for reconsideration or modification filed more than 30 days from the date of the order or decision complained of. See Avedis Zildjian Co. v. D. H. Baldwin Co., 181 USPQ 736 (Comm'r 1974). Nor does the rule contemplate a second request for reconsideration of the same basic issue. See Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986), and Avedis Zildjian Co. v. D. H. Baldwin Co., supra. However, the Board may, on its own initiative, reconsider and modify one of its orders or decisions if it finds error therein, and the Board may also, in its discretion, consider an untimely request for reconsideration or modification. See Avedis Zildjian Co. v. D. H. Baldwin Co., supra.

Any brief in response to a request for reconsideration or modification of an order or decision issued on a motion must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.120(c)). See 37 CFR §2.127(b).

When a party upon which a motion has been served fails to file a brief in response, and the Board grants the motion as conceded pursuant to 37 CFR §2.127(a), the nonresponding party cannot use a request for reconsideration as a second opportunity to file a brief in opposition to the motion. See Joy Manufacturing Co. v. Robbins Co., 181 USPQ 408 (TTAB 1974). Cf. General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc., 189 USPQ 425 (TTAB 1975).

Generally, the premise underlying a motion for reconsideration, modification or clarification under 37 CFR §2.127(b) is that, based on the facts before it and the prevailing authorities, the Board erred in reaching the order or decision it issued. Such a motion may not properly be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in a brief on the original motion. Rather, the motion normally should be limited to a

OLD EDITION

demonstration that, based on the facts before it and the applicable law, the Board's ruling is in error and requires appropriate change. Cf. TBMP §544.

An interlocutory motion, request, or other matter which is not actually or potentially dispositive of a proceeding may be acted upon by a single Board administrative trademark judge, or by a Board interlocutory attorney to whom authority so to act has been delegated. See 37 CFR §2.127(c). See also TBMP §502.05. When a single Board administrative trademark judge, or a single duly authorized interlocutory attorney, has acted upon an interlocutory motion, request, or other matter not actually or potentially dispositive of the proceeding, and one or more of the parties is dissatisfied with the action, the dissatisfied party or parties may seek review thereof by requesting, under 37 CFR §2.127(b), the same single Board judge, or the same single interlocutory attorney, to reconsider the action, and/or by filing a petition to the Commissioner for review of the decision under 37 CFR §2.146(e)(2) (see TBMP §905). A request that the action of the single Board judge, or single interlocutory attorney, be reviewed by one or more (other) administrative trademark judges of the Board is improper and will be denied. However, at final hearing, the Board panel to which the case is assigned for decision may review an interlocutory ruling and reverse it, if appropriate. See, for example, Harley-Davidson Motor Co. v. Pierce Foods Corp., 231 USPQ 857, 859 (TTAB 1986).

OLD EDITION

519 Motion for Leave to Serve Additional Interrogatories

37 CFR §2.120(d)(1) The total number of written interrogatories which a party may serve upon another party pursuant to Rule 33 of the Federal Rules of Civil Procedure, in a proceeding, shall not exceed seventy-five, counting subparts, except that the Trademark Trial and Appeal Board, in its discretion, may allow additional interrogatories upon motion therefor showing good cause, or upon stipulation of the parties. A motion for leave to serve additional interrogatories must be filed and granted prior to the service of the proposed additional interrogatories; and must be accompanied by a copy of the interrogatories, if any, which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. ...

A motion under 37 CFR §2.120(d)(1) for leave to serve additional interrogatories must be filed and granted prior to service of the proposed additional interrogatories; and must be accompanied both by a copy of any interrogatories

which have already been served by the moving party, and by a copy of the interrogatories proposed to be served. See 37 CFR §2.120(d)(1); Chicago Corp. v. North American Chicago Corp., 16 USPQ2d 1479 (TTAB 1990); Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 USPQ2d 1466 (TTAB 1990); Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., 16 USPQ2d 1398 (TTAB 1990); Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990); Notice of Final Rulemaking, published in the Federal Register on September 12, 1991 at 56 FR 46376 and in the Official Gazette of October 22, 1991 at 1131 TMOG 54, as corrected in the Federal Register of October 23, 1991 at 56 FR 54917; and Helen R. Wendel, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: The Burden Shifts: Revised Discovery Practice Under Trademark Rule 2.120(d)(1), 82 Trademark Rep. 89 (1992).

Good cause for the service of additional interrogatories will generally be found only where it is shown that there is a legitimate need for further discovery by interrogatories. See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 USPQ2d 1466 (TTAB 1990). The mere fact that the additional interrogatories may be relevant and narrowly drawn to a single issue, or that they may be easy to answer, is insufficient, in and of itself, to show good cause for the service of additional interrogatories. See Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 USPQ2d 1466 (TTAB 1990); Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., 16 USPQ2d 1398 (TTAB 1990); Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990).

For further information concerning good cause for a motion to serve additional interrogatories, see TBMP §406.03(C).

For information concerning the interrogatory limit specified in 37 CFR §2.120(d)(1), see TBMP §406.03.

520 Motion to Take Foreign Deposition Orally

37 CFR §2.120(c)(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil

OLD EDITION

Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

37 CFR §2.120(a)(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by §2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

Ordinarily, the discovery deposition of a natural person who resides in a foreign country, and who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party, must, if taken in a foreign country, be taken upon written questions in the manner described in 37 CFR §2.124. See 37 CFR §2.120(c)(1). See also TBMP §404.03(c)(1), and authorities cited therein. Moreover, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her discovery deposition. See TBMP §404.03(c)(1), and authorities cited therein.

However, the parties may stipulate, or the Board, upon motion for good cause, may order, that the deposition, when taken in a foreign country, be taken by oral examination. See 37 CFR §2.120(c)(1); Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989); Jonergin Co. v. Jonergin Vermont Inc., 222 USPQ 337 (Comm'r 1983); and TBMP §404.03(c)(1).

Similarly, a testimony deposition taken in a foreign country must be taken by deposition upon written questions in the manner described in 37 CFR §2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See 37 CFR §2.123(a)(2).

In determining whether good cause exists for a motion to take a foreign deposition orally, the Board weighs the equities, including the advantages of an oral deposition and any financial hardship that the nonmoving party might suffer if the deposition were taken orally in the foreign country. See Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989). Cf. Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990); Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980); and TBMP §532.

OLD EDITION

521 Motion to Quash Notice of Deposition

A party to an inter partes proceeding before the Board may file a motion, prior to the taking of a noticed discovery or testimony deposition, to quash the notice of deposition. In the case of a notice of discovery deposition, the motion may alternatively be titled a motion for a protective order. See TBMP §414.

A motion to quash may be filed on a variety of grounds. For example, a party may move to quash a notice of deposition on the ground that (1) the proposed deposition is untimely (see Marshall Field & Co. v. Mrs. Field's Cookies, 17 USPQ2d 1652 (TTAB 1990), and Rhone-Poulenc Industries v. Gulf Oil Corp., 198 USPQ 372 (TTAB 1978)); or (2) constitutes harassment (see Kellogg Co. v. New Generation Foods Inc., 6 USPQ2d 2045 (TTAB 1988); cf. Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976)); or (3) in the case of a discovery deposition to be taken in the United States, is not scheduled to be taken in the Federal judicial district where the proposed deponent resides or is regularly employed (see 37 CFR §2.120(b)); or (4) in the case of a deposition to be taken in a foreign country, is scheduled to be taken orally in violation of 37 CFR §2.120(c) or 2.123(a)(2) (see Rhone-Poulenc Industries v. Gulf Oil Corp.,supra); or (5) that the deposing party has noticed depositions for more than one place at the same time, or so nearly at the same time that reasonable opportunity for travel from one place of examination to another is not available (see 37 CFR §2.123(c)); or (6) that there was not due (i.e., reasonable) notice of the proposed deposition (see 37 CFR §§2.123(c) and 2.124(b)(2); FRCP 30(b) and 31(a); and TBMP §§404.04 and 713.05); or (7) that the taking of the deposition should be deferred until after determination of a certain motion pending before the Board (see Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975)); or (8) that the deposing party improperly seeks to force a foreign natural person to come to the United States for the taking of his or her deposition (see TBMP §404.03(c)(1), and authorities cited therein); or (9) that a testimony deposition scheduled to be taken upon written questions should be taken orally (usually, this motion is titled as a motion that a deposition be taken orally) (see 37 CFR §2.123(a)(1); Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990); and Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980)).

OLD EDITION

However, the Board has no jurisdiction over nonparty depositions, or adverse witness depositions, taken by subpoena, and thus has no authority to quash such depositions. See Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987), and TBMP §§404.03(b)(2) and 713.06(b).

A motion to quash a notice of deposition should be filed promptly after the grounds therefor become known to the moving party. When time is of the essence, the moving party may telephone the Board interlocutory attorney to whom the case is assigned and ask that the motion be resolved by telephone conference call. See 37 CFR §2.120(i)(1), and TBMP §502.07(a). However, the Board will not resolve a motion by telephone conference until a copy of the motion has been received by the Board. A copy of the motion should also have been received by every other party to the proceeding.

To expedite matters, the moving party may hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned. Alternatively, if the motion has been filed with the Board by some (acceptable) method other than hand delivery to the interlocutory attorney, but has not yet actually been received by the Board and/or entered in the proceeding file for which it is intended, the moving party may call the interlocutory attorney and request permission to fax a copy of the motion to the Board. See TBMP §107.

OLD EDITION

522 Motion for Order re Manner or Place of Document Production

37 CFR §2.120(d)(2) The production of documents and things under the provisions of Rule 34 of the Federal Rules of Civil Procedure will be made at the place where the documents and things are usually kept, or where the parties agree, or where and in the manner which the Trademark Trial and Appeal Board, upon motion, orders.

In an inter partes proceeding before the Board, the place of production of documents and things is governed by 37 CFR §2.120(d)(2). See also Unicut Corp. v. Unicut, Inc., 220 USPQ 1013 (TTAB 1983); Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976); and TBMP §408.03.

Accordingly, upon motion, the Board, in its discretion, may make any appropriate order concerning the place and/or manner of production of

documents and things. For example, the Board may order that the responding party photocopy the documents designated in a request and mail the photocopies to the requesting party, all at the requesting party's expense. See Unicut Corp. v. Unicut, Inc., 220 USPQ 1013 (TTAB 1983); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 385 (1985); and Janet E. Rice, TIPS FROM THE TTAB: Recent Changes in the TTAB Discovery Rules, 74 Trademark Rep. 449, 451 (1984).

523 Motion to Compel Discovery

523.01 In General

37 CFR §2.120(e) Motion for an order to compel discovery. If a party fails to designate a person pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, or if a party or such designated person, or an officer, director or managing agent of a party fails to attend a deposition or fails to answer any question propounded in a discovery deposition, or any interrogatory, or fails to produce and permit the inspection and copying of any document or thing, the party seeking discovery may file a motion before the Trademark Trial and Appeal Board for an order to compel a designation, or attendance at a deposition, or an answer, or production and an opportunity to inspect and copy. ...

In inter partes proceedings before the Board, the motion to compel discovery procedure is available, for a failure to provide requested discovery, with respect to discovery depositions, interrogatories, and requests for production of documents and things. See 37 CFR §2.120(e). See also, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); General Sealer Corp. v. H. H. Robertson Co., 193 USPQ 384 (TTAB 1976); Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc., 191 USPQ 127 (TTAB 1976); Spa International, Inc. v. European Health Spa, Inc., 184 USPQ 747 (TTAB 1975); Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974); Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974); and Dow Corning Corp. v. Doric Corp., 183 USPQ 126 (TTAB 1974). Cf. FRCP 37(a)(2)(B).

OLD EDITION

Alternatively, if a witness objects to, and refuses to answer (or answer adequately), a question propounded during a discovery deposition, the propounding party may obtain an immediate ruling on the propriety of the objection by applying, under 35 U.S.C. §24, to the Federal district court in the jurisdiction where the deposition is being taken, for an order compelling answer. See TBMP §§404.02 and 415.03, and authorities cited therein.

The motion to compel procedure is not applicable to requests for admission. The procedure to be followed in the case of requests for admission is as set forth in 37 CFR §2.120(h) and FRCP 36(a). See TBMP §§415.02 and 524.

OLD EDITION

523.02 Special Requirements for Motion

37 CFR §2.120(e) Motion for an order to compel discovery. ... The motion shall include a copy of the request for designation or of the relevant portion of the discovery deposition; or a copy of the interrogatory with any answer or objection that was made; or a copy of the request for production, any proffer of production or objection to production in response to the request, and a list and brief description of the documents or things that were not produced for inspection and copying. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

A motion to compel must include a copy of the request for discovery and the response thereto, as specified in 37 CFR §2.120(e). See also, with respect to this requirement, Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc., 191 USPQ 127 (TTAB 1976); Amerace Corp. v. USM Corp., 183 USPQ 506 (TTAB 1974); and Helene Curtis Industries, Inc. v. John H. Breck, Inc., 183 USPQ 126 (TTAB 1974).

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. See, for

example, 37 CFR §2.120(e); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); Ford Motor Co. v. Shelby International, Inc., 193 USPQ 236 (TTAB 1976); Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc., 189 USPQ 479 (TTAB 1976); Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975); J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975); Penthouse International Ltd. v. Dyn Electronics, Inc., 184 USPQ 117 (TTAB 1974); and Angelica Corp. v. Collins & Aikman Corp., 183 USPQ 378 (TTAB 1974).

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination. See 37 CFR §2.120(e).

For information concerning the special requirements for a motion to compel answer to interrogatories which are the subject of a general objection on the ground of excessive number, see TBMP §406.03(e).

OLD EDITION

523.03 Time for Filing Motion

A motion to compel does not necessarily have to be filed during the discovery period. See Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974). However, the motion should be filed within a reasonable time after the failure to respond to a request for discovery or after service of the response believed to be inadequate.

523.04 Failure to File Motion

If a party which served a request for discovery receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. See British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987); Seligman & Latz, Inc. v. Merit Mercantile Corp., 222 USPQ 720

(TTAB 1984); Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979); Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc., 191 USPQ 468 (TTAB 1976); and Comserv Corp. v. Comserv, 179 USPQ 124 (TTAB 1973). Cf. TBMP §524.04. Cf. also TBMP §527.05.

524 Motion to Test Sufficiency of Response to Admission Request

524.01 In General

37 CFR §2.120(h) Request for admissions. Requests for admissions shall be governed by Rule 36 of the Federal Rules of Civil Procedure except that the Trademark Trial and Appeal Board does not have authority to award any expenses to any party. ...

FRCP 36(a) Request for Admission. ... The party who has requested the admissions may move to determine the sufficiency of the answers or objections. Unless the court determines that an objection is justified, it shall order that an answer be served. If the court determines that an answer does not comply with the requirements of this rule, it may order either that the matter is admitted or that an amended answer be served. ...

If a propounding party is dissatisfied with a responding party's answer or objection to a request for admission, and wishes to obtain a ruling on the sufficiency thereof, the propounding party may file a motion with the Board to determine the sufficiency of the response. See 37 CFR §2.120(h); FRCP 36(a); Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 188 USPQ 690 (TTAB 1975); and Watercare Corp. v. Midwesco-Enterprise, Inc., 171 USPQ 696 (TTAB 1971). Cf. 37 CFR §2.120(e), and TBMP §523.01.

If the Board, upon motion to test the sufficiency of a response to a request for admission, determines that an answer does not comply with the requirements of FRCP 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. See FRCP 36(a).

524.02 Special Requirements for Motion

OLD EDITION

37 CFR §2.120(h) Request for admissions. ... A motion by a party to determine the sufficiency of an answer or objection to a request made by that party for an admission shall include a copy of the request for admission and any exhibits thereto and of the answer or objection. The motion must be supported by a written statement from the moving party that such party or the attorney therefor has made a good faith effort, by conference or correspondence, to resolve with the other party or the attorney therefor the issues presented in the motion and has been unable to reach agreement. If issues raised in the motion are subsequently resolved by agreement of the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require adjudication.

A motion to determine the sufficiency of a response to a request for admission must include a copy of the request for admission (and any exhibits thereto) and of the answer or objection. See 37 CFR §2.120(h). Cf. 37 CFR §2.120(e).

In addition, the motion must be supported by a written statement from the moving party that such party or its attorney has made a good faith effort, by conference or correspondence, to resolve with the other party or its attorney the issues presented in the motion, and has been unable to reach agreement. See 37 CFR §2.120(h). Cf. 37 CFR §2.120(e), and TBMP §523.02 and cases cited therein.

In the event that issues raised in the motion are subsequently resolved by the parties, the moving party should inform the Board in writing of the issues in the motion which no longer require determination. See 37 CFR §2.120(h). Cf. 37 CFR §2.120(e).

OLD EDITION

524.03 Time for Filing Motion

A motion to test the sufficiency of a response to a request for admission does not necessarily have to be filed during the discovery period. Cf. Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974), and TBMP §523.03. However, the motion should be filed within a reasonable time after service of the response believed to be inadequate.

524.04 Failure to File Motion

If a party which served a request for admission receives a response thereto which it believes to be inadequate, but fails to file a motion to test the sufficiency of the response, it may not thereafter be heard to complain about the sufficiency thereof. See Watercare Corp. v. Midwesco-Enterprise, Inc., 171 USPQ 696 (TTAB 1971). Cf. TBMP §523.04, and cases cited therein.

525 Motion to Withdraw or Amend Admission

FRCP 36(b) Effect of Admission. Any matter admitted under this rule is conclusively established unless the court on motion permits withdrawal or amendment of the admission. ...the court may permit withdrawal or amendment when the presentation of the merits of the action will be subserved thereby and the party who obtained the admission fails to satisfy the court that withdrawal or amendment will prejudice that party in maintaining the action or defense on the merits. Any admission made by a party under this rule is for the purpose of the pending action only and is not an admission for any other purpose nor may it be used against the party in any other proceeding.

Any matter admitted under FRCP 36 is conclusively established unless the Board, upon motion, permits withdrawal or amendment of the admission. See FRCP 36(b), and TBMP §411.04. This applies both to matters expressly admitted; and to those deemed admitted for failure to timely respond to a request for admission, where there is no persuasive showing that the failure to timely respond was the result of excusable neglect. See FRCP 6(b) and 36, and TBMP §§411.01 and 411.04.

The Board, upon motion, may permit withdrawal or amendment of an admission when the presentation of the merits of the proceeding will be subserved thereby, and the propounding party fails to satisfy the Board that withdrawal or amendment will prejudice said party in maintaining its action or defense on the merits. See FRCP 36(b); Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., 14 USPQ2d 2064 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); and BankAmerica Corp. v. International Travelers Cheque Co., 205 USPQ 1233 (TTAB 1979).

OLD EDITION

See also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C., 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991).

The timing of a motion to withdraw or amend an admission plays a significant role in the Board's determination of whether the propounding party will be prejudiced by withdrawal or amendment. See Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., 14 USPQ2d 2064 (TTAB 1990) (opposer's testimony period had not yet opened and any possible prejudice to opposer, the propounding party, could be overcome by extending the discovery period), and Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989) (case was still in pre-trial stage and prejudice to the propounding party could be avoided or mitigated by reopening discovery for that party). See also American Automobile Ass'n (Inc.) v. AAA Legal Clinic of Jefferson Crooke, P.C., 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991). Cf. TBMP §507.02.

526 Motion for a Protective Order

37 CFR §2.120(f) Motion for a protective order. Upon motion by a party from whom discovery is sought, and for good cause, the Trademark Trial and Appeal Board may make any order which justice requires to protect a party from annoyance, embarrassment, oppression, or undue burden or expense, including one or more of the types of orders provided by clauses (1) through (8), inclusive, of Rule 26(c) of the Federal Rules of Civil Procedure. If the motion for a protective order is denied in whole or in part, the Board may, on such conditions (other than an award of expenses to the party prevailing on the motion) as are just, order that any party provide or permit discovery.

In inter partes proceedings before the Board, motions for a protective order are governed by 37 CFR §2.120(f).

It is generally inappropriate for a party to respond to a request for discovery by filing a motion attacking it, such as a motion to strike, or a motion for a protective order. Rather, the party ordinarily should respond by providing the information sought in those portions of the request which it believes to be proper, and stating its objections to those which it believes to be improper. See TBMP §414, and cases cited therein.

OLD EDITION

Moreover, if a party upon which interrogatories have been served believes that the number of interrogatories served exceeds the limitation specified in 37 CFR §2.120(d)(1), and is not willing to waive this basis for objection, the party must, within the time for (and instead of) serving answers and specific objections to the interrogatories, or a motion for a protective order, serve a general objection on the ground of their excessive number, leaving the inquiring party with the burden of filing a motion to compel if it believes that the objection is not well taken. See 37 CFR §2.120(d)(1), and TBMP §406.03(e).

Nevertheless, there are certain situations (such as, for example, when a request for discovery otherwise constitutes clear harassment, or when a defendant upon which a request for discovery has been served is not and was not, at the time of the commencement of the proceeding, the real party in interest) in which a party may properly respond to a request for discovery by filing a motion for a protective order that the discovery not be had, or be had only on specified terms and conditions. See, for example, Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976).

Except in those situations, a motion for a protective order ordinarily should be filed in a Board proceeding only in response to a motion to compel where, for example, matter sought to be discovered assertedly constitutes trade secret or confidential information, or cannot be provided without undue burden or expense. See Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975); and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 387-388 (1985).

When the Board grants a request for a protective order with respect to confidential or trade secret information, it normally will direct either the disclosing party, or the parties together, to prepare an order with terms which are mutually agreeable to them. See, for example, Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); and Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975).

For examples of cases involving a motion for a protective order relating to discovery, see Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991) (request for protective order that discovery be governed by the Hague Evidence Convention); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988) (motion for

OLD EDITION

protective order relating to discovery of confidential information); Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976) (motion for protective order that assignor need not respond to discovery requests); Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975) (motion for protective order forbidding that discovery not be taken until Board's determination of pending motion to dismiss); and Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975) (request for protective order relating to discovery of confidential information).

For further information concerning protective orders, see TBMP §416.

527 Motion for Discovery Sanctions

527.01 For Failure to Comply With Board Discovery Order

37 CFR §2.120(g) Sanctions.
(1) If a party fails to comply with an order of the Trademark Trial and Appeal Board relating to dicovery, including a protective order, the Board may make any appropriate order, including any of the orders provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure, except that the Board does not have authority to hold any person in contempt or to award any expenses to any party. The Board may impose against a party any of the sanctions provided by this subsection in the event that said party or any attorney, agent, or designated witness of that party fails to comply with a protective order made pursuant to Rule 26(c) of the Federal Rules of Civil Procedure.

OLD EDITION

If a party fails to comply with an order of the Board relating to discovery, including a protective order or an order compelling discovery, the Board may enter appropriate sanctions, as defined in 37 CFR §2.120(g)(1). See 37 CFR §2.120(g)(1). See also, for example, TBMP §502.06; Seligman & Latz, Inc. v. Merit Mercantile Corp., 222 USPQ 720 (TTAB 1984); Unicut Corp. v. Unicut, Inc., 222 USPQ 341 (TTAB 1984); Unicut Corp. v. Unicut, Inc., 220 USPQ 1013 (TTAB 1983); and Caterpillar Tractor Co. v. Catfish Anglers Together, Inc., 194 USPQ 99 (TTAB 1976). Cf. Ingalls Shipbuilding, Inc. v. United States, 857 F.2d 1448, 11 Fed. R. Serv.3d 1342 (Fed. Cir. 1988). In the case of a protective order, these sanctions may be entered by the Board against a party if the party or any attorney, agent, or designated witness of the party fails to comply with the protective order. See 37 CFR §2.120(g)(1).

The sanctions which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board does not have authority to hold any person in contempt, or to award any expenses, including attorneys' fees, to any party. See 37 CFR §§2.120(g)(1) and 2.127(f), and TBMP §502.06.

The motion for sanctions for failure to comply with an order of the Board lies only when the Board has entered an order relating to discovery (i.e., an order compelling discovery or a protective order) and the order has assertedly been violated. See, for example, MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); General Sealer Corp. v. H. H. Robertson Co., 193 USPQ 384 (TTAB 1976); Spa International, Inc. v. European Health Spa, Inc., 184 USPQ 747 (TTAB 1975); and Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974).

The motion for sanctions for failure to comply with an order of the Board relating to discovery does not apply in situations involving requests for admissions. Sanctions in those situations are governed by FRCP 36, except that the Board does not have authority to award any expenses to any party. See 37 CFR §2.120(h), and TBMP §502.06. For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, see TBMP §527.04.

OLD EDITION

527.02 If Party Says It Will Not Respond to Discovery Request

37 CFR §2.120(g)(2) If a party, or an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or 31(a) of the Federal Rules of Civil Procedure to testify on behalf of a party, fails to attend the party's or person's discovery deposition, after being served with proper notice, or fails to provide any response to a set of interrogatories or to a set of requests for production of documents and things, and such party or the party's attorney or other authorized representative informs the party seeking discovery that no response will be made thereto, the Board may make any appropriate order, as specified in paragraph (g)(1) of this section.

The motion for sanctions under 37 CFR §2.120(g)(2) is available only for discovery depositions, interrogatories, and requests for production of documents and things, and lies only where the responding party (1) has failed to respond, and (2) has informed the party seeking discovery that no response will be made.

The sanctions which may be entered by the Board include, inter alia, striking all or part of the pleadings of the disobedient party; refusing to allow the disobedient party to support or oppose designated claims or defenses; prohibiting the disobedient party from introducing designated matters in evidence; and entering judgment against the disobedient party. However, the Board does not have authority to hold any person in contempt, or to award any expenses, including attorneys' fees, to any party. See 37 CFR §§2.120(g)(1) and (2), and 2.127(f), and TBMP §502.06.

The motion for sanctions under 37 CFR §2.120(g)(2) does not apply in situations involving requests for admissions. For information concerning sanctions for failure to respond, or respond properly, to requests for admissions, see TBMP §527.04.

OLD EDITION

527.03 Untimely Response to Discovery Requests

A party which fails to respond to a request for discovery (except for a request for admission) during the time allowed therefor, and which is unable to show that its failure was the result of excusable neglect, may be found, upon motion to compel filed by the propounding party, to have forfeited its right to object to the discovery request on its merits. See Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979); MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979); and Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975).

527.04 In the Case of Requests for Admission

The entry of sanctions for failure to respond, or respond properly, to requests for admission is governed by 37 CFR §2.120(h) and FRCP 36, except that the Board does not have authority to award expenses to any party. See 37 CFR §2.120(h), and TBMP §502.06.

If a party upon which requests for admission have been served fails to file a timely response thereto, the requests will stand admitted (automatically), and may be relied upon by the propounding party pursuant to 37 CFR §2.120(j)(3)(i), unless the party upon which the requests were served is able to show that its failure to timely respond was the result of excusable neglect; or unless a motion to withdraw or amend the admissions is filed pursuant to FRCP 36(b), and granted by the Board. See FRCP 6(a) and 36(a), and TBMP §411.01. For information concerning motions to withdraw or amend admissions, see TBMP §525.

If a party upon which requests for admission have been served responds by serving answers and/or objections thereto, and the propounding party believes that one or more of the answers and/or objections is insufficient, the propounding party may file a motion with the Board to determine the sufficiency of the answers and/or objections believed to be insufficient. See 37 CFR §2.120(h); FRCP 36(a); Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 188 USPQ 690 (TTAB 1975); and Watercare Corp. v. Midwesco-Enterprise, Inc., 171 USPQ 696 (TTAB 1971). If the Board determines that an answer does not comply with the requirements of FRCP 36(a), it may order either that the matter is deemed admitted or that an amended answer be served. If the Board determines that an objection is not justified, it will order that an answer be served. See FRCP 36(a). For information concerning motions to determine the sufficiency of answers or objections to requests for admission, see TBMP §524.

OLD EDITION

527.05 Estoppel Sanction

A party which responds to a request for discovery by indicating that it does not have the information sought, or by stating objections thereto, may be barred by its own action from later introducing the information sought in the request as part of its evidence on the case, providing that the propounding party raises the matter by objecting to the evidence in question on that ground, and preserves the objection in its brief on the case (it is not necessary that the objecting party file a motion asking for application of this sanction). See, for example Weiner King,

Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820 (CCPA 1980); Super Valu Stores Inc. v. Exxon Corp., 11 USPQ2d 1539 (TTAB 1989); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988); Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895 (TTAB 1988); ConAgra Inc. v. Saavedra, 4 USPQ2d 1245 (TTAB 1987); National Aeronautics and Space Administration v. Bully Hill Vineyards Inc., 3 USPQ2d 1671 (TTAB 1987); Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985); Era Corp. v. Electronic Realty Associates, Inc., 211 USPQ 734 (TTAB 1981); Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980); Shoe Factory Supplies Co. v. Thermal Engineering Co., 207 USPQ 517 (TTAB 1980); Refreshment Machinery Inc. v. Reed Industries, Inc., 196 USPQ 840 (TTAB 1977); Autac Inc. v. Walco Systems, Inc., 195 USPQ 11 (TTAB 1977); and Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976). Cf. Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989); Nestle Foods Corp. v. Kellogg Co., 6 USPQ2d 1145 (TTAB 1988); Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987); Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979); Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc., 191 USPQ 468 (TTAB 1976); and TBMP §523.04.

OLD EDITION

528 Motion for Summary Judgment

FRCP 56. Summary Judgment
(a) For Claimant. A party seeking to recover upon a claim [or] counterclaim ... may ... move with or without supporting affidavits for a summary judgment in the party's favor upon all or any part thereof.

(b) For Defending Party. A party against whom a claim [or] counterclaim ... is asserted ... may ... move with or without supporting affidavits for a summary judgment in the party's favor as to all or any part thereof.

(c) Motion and Proceedings Thereon. ... The adverse party ... may serve opposing affidavits. The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law. ...

(d) Case Not Fully Adjudicated on Motion. If on motion under this rule judgment is not rendered upon the whole case or for all the relief asked and a trial is necessary, the court ..., by examining the pleadings and the evidence before it ..., shall if practicable ascertain what material facts exist without substantial controversy and what material facts are actually and in good faith controverted. It shall thereupon make an order specifying the facts that appear without substantial controversy, ... and directing such further proceedings in the action as are just. Upon the trial of the action the facts so specified shall be deemed established, and the trial shall be conducted accordingly.

(e) Form of Affidavits; Further Testimony; Defense Required. Supporting and opposing affidavits shall be made on personal knowledge, shall set forth such facts as would be admissible in evidence, and shall show affirmatively that the affiant is competent to testify to the matters stated therein. Sworn or certified copies of all papers or parts thereof referred to in an affidavit shall be attached thereto or served therewith. The court may permit affidavits to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party.

(f) When Affidavits are Unavailable. Should it appear from the affidavits of a party opposing the motion that the party cannot for reasons stated present by affidavit facts essential to justify the party's opposition, the court may refuse the application for judgment or may order a continuance to permit affidavits to be obtained or depositions to be taken or discovery to be had or may make such other order as is just.

* * *

OLD EDITION

528.01 General Nature of Motion

The motion for summary judgment is a pretrial device to dispose of cases in which "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to

any material fact and that the moving party is entitled to judgment as a matter of law." See, for example, FRCP 56(c); Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986); Dana Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989); Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, 5 USPQ2d 1376 (TTAB 1986); Bongrain International (American) Corp. v. Moquet Ltd., 230 USPQ 626 (TTAB 1986); and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986).

The purpose of the motion is judicial economy, that is, to avoid an unnecessary trial where there is no genuine issue of material fact and more evidence than is already available in connection with the summary judgment motion could not reasonably be expected to change the result in the case. See, for example, Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); Exxon Corp. v. National Foodline Corp., 579 F.2d 1244, 198 USPQ 407 (CCPA 1978); University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994); Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993); National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212 (TTAB 1990); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 USPQ2d 1241 (TTAB 1989).

The summary judgment procedure is regarded as "a salutary method of disposition," and the Board does not hesitate to dispose of cases on summary judgment when appropriate. See, for example, Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992); INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992); Bongrain International (American) Corp. v. Moquet Ltd., 230 USPQ 626 (TTAB 1986); T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413, at 413-414 (1990); and T. Jeffrey Quinn, TIPS FROM THE

OLD EDITION

TTAB: Inter Partes Summary Judgment Revisited, 76 Trademark Rep. 73, 77-78 (1986). But see Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991) ("As a general rule, the factual question of intent is particularly unsuited to disposition on summary judgment."), and Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993).

A party moving for summary judgment has the burden of demonstrating the absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. See, for example, Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Scripps Clinic & Research Foundation v. Genentech Inc., 927 F.2d 1565, 18 USPQ2d 1001, clarified, on recon., 18 USPQ2d 1896 (Fed. Cir. 1991); Meyers v. Brooks Shoe Inc., 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990); C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc., 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989). The burden of the moving party may be met by showing (that is, pointing out) "that there is an absence of evidence to support the nonmoving party's case." See Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986). See also Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Avia Group International Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); and Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

When the moving party's motion is supported by evidence sufficient, if unopposed, to indicate that there is no genuine issue of material fact, and that the moving party is entitled to judgment, the nonmoving party may not rest on mere denials or conclusory assertions, but rather must proffer countering evidence, by affidavit or as otherwise provided in FRCP 56, showing that there is a genuine factual dispute for trial. See FRCP 56(e); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc., 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir.

OLD EDITION

1984); Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992); Flow Technology Inc. v. Picciano, 18 USPQ2d 1970 (TTAB 1991); National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212 (TTAB 1990); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); and Coup v. Vornado Inc., 9 USPQ2d 1824 (TTAB 1988). A factual dispute is genuine only if, on the evidence of record, a reasonable fact finder could resolve the matter in favor of the nonmoving party. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc., 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); and Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987).

In deciding a motion for summary judgment, the Board may not resolve an issue of fact; it may only determine whether a genuine issue of material fact exists. See Meyers v. Brooks Shoe Inc., 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990); Litton Industries, Inc. v. Litronix Inc., 577 F.2d 709, 198 USPQ 280 (CCPA 1978); University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994); Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989); and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist; and the evidentiary record on summary judgment, and all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993); Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); Larry Harmon Pictures Corp. v. Williams Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991); Scripps Clinic & Research Foundation v. Genentech Inc., 927 F.2d 1565, 18 USPQ2d 1001, clarified, on recon., 18 USPQ2d 1896 (Fed. Cir. 1991); Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); C.R. Bard Inc. v. Advanced Cardiovascular

OLD EDITION

Systems Inc., 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990); Litton Industries, Inc. v. Litronix Inc., 577 F.2d 709, 198 USPQ 280 (CCPA 1978); University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994); Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993); Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989); and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986).

A fact is material if it "may affect the decision, whereby the finding of that fact is relevant and necessary to the proceedings." See Opryland USA Inc. v. Great American Music Show Inc., supra, at 1472, and University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. See, for example, Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); and Bongrain International (American) Corp. v. Moquet Ltd., 230 USPQ 626 (TTAB 1986). See also Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992) (whether a genuine factual issue is material so as to preclude summary judgment depends upon applicable substantive law). Further, a dispute over a fact relating only to an issue which is not the subject of the summary judgment motion is not a genuine issue of fact material to the determination of the motion. See United States Olympic Committee v. O-M Bread Inc., 29 USPQ2d 1555 (TTAB 1993).

Where both parties have moved for summary judgment, the mere fact that they have done so does not establish that there is no genuine issue of material fact, and that judgment should be entered in favor of one of them. See Scripps Clinic & Research Foundation v. Genentech Inc., 927 F.2d 1565, 18 USPQ2d 1001, clarified, on recon., 18 USPQ2d 1896 (Fed. Cir. 1991), and University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994).

A party moving for summary judgment should specify, in its brief in support of the motion, the material facts which are undisputed. The nonmoving party, in turn, should specify, in its brief in opposition to the motion, the material facts which are in dispute. See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990).

OLD EDITION

A motion for summary judgment should be filed in single (not multiple) form.

528.02 Time for Filing Motion

37 CFR §2.127(e)(1) A motion for summary judgment should be filed prior to the commencement of the first testimony period, as originally set or as reset, and the Trademark Trial and Appeal Board, in its discretion, may deny as untimely any motion for summary judgment filed thereafter.

A motion for summary judgment filed in an inter partes proceeding before the Board ordinarily should be filed after the time when the Board notifies the parties of the institution of the proceeding, but before the opening of the first testimony period, as originally set or as reset.

When the Board determines that an opposition or a petition to cancel has been timely filed in proper form, and that the required fee has been submitted, the Board sets up the opposition or cancellation proceeding file, and prepares a letter wherein it, inter alia, notifies defendant of the filing of the complaint, and notifies both parties of the formal institution of the proceeding. A copy of the notification letter is mailed to each of the parties. The Board sends a copy of the complaint to the defendant along with its copy of the notification letter. See TBMP §315.01. The defendant does not know, until it receives these papers from the Board, that an opposition or cancellation has been timely filed in proper form, with the required fee, and that the proceeding has been instituted by the Board. Accordingly, a motion for summary judgment filed prior to the mailing of the Board's notification letter is premature, and the defendant need not respond thereto. See Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993).

Further, the motion for summary judgment is a pretrial device, intended to save the time and expense of a full trial when a party is able to demonstrate, prior to trial, that there is no genuine issue of material fact, and that it is entitled to judgment as a matter of law. See TBMP §528.01, and authorities cited therein. In inter partes proceedings before the Board, the trial period commences with the opening of the first testimony period (see TBMP §§504.01 and 701), testimony is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision (see TBMP §502.01, and cases cited therein). For these reasons, a motion for

OLD EDITION

summary judgment ordinarily should be filed prior to the opening of the first testimony period, as originally set or as reset, and the Board, in its discretion, may deny as untimely any summary judgment motion filed thereafter. See, for example, 37 CFR §2.127(e)(1); Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992); Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, 5 USPQ2d 1376 (TTAB 1986); Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co., 226 USPQ 718 (TTAB 1985); American Meat Institute v. Horace W. Longacre, Inc., 211 USPQ 712 (TTAB 1981); Allegro High Fidelity, Inc. v. Zenith Radio Corp., 197 USPQ 550 (TTAB 1977); La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976); Peterson's Ltd. v. Consolidated Cigar Corp., 183 USPQ 559 (TTAB 1974); and Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 182 USPQ 572 (Comm'r 1974). Cf. TBMP §504.01. If testimony periods are reset prior to the opening of the plaintiff's testimony period-in-chief, a motion for summary judgment filed before a first trial period commences is timely. Once the first trial period commences, however, any summary judgment motion filed thereafter is untimely, even if it is filed prior to the opening of a rescheduled testimony period-in-chief for plaintiff, and/or even if no trial evidence has actually been adduced by the plaintiff. See La Maur, Inc. v. Bagwells Enterprises, Inc., supra; David J. Kera, TIPS FROM THE TTAB: Summary Judgment, 71 Trademark Rep. 59, 62 (1981); and T. Jeffrey Quinn, TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited, 76 Trademark Rep. 73, at 73-74 (1986).

The Board generally will not consider a motion for summary judgment filed after the first trial period commences unless it involves a matter of res judicata (claim preclusion) or collateral estoppel (issue preclusion); was submitted by agreement of the parties (prior to the taking of any testimony); or was not opposed by the nonmoving party (at least on the basis of its untimeliness). See Bausch & Lomb Inc. v. Leupold & Stevens Inc., 1 USPQ2d 1497 (TTAB 1986); Lukens Inc. v. Vesper Corp., 1 USPQ2d 1299 (TTAB 1986), aff'd, Vesper Corp. v. Lukens Inc., 831 F.2d 306 (Fed. Cir. 1987); Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985); and Foodland, Inc. v. Foodtown Super Markets, Inc., 138 USPQ 591 (TTAB 1963).

528.03 Suspension Pending Determination of Motion

OLD EDITION

37 CFR §2.127(d) When any party files a motion to dismiss, or a motion for judgment on the pleadings, or a motion for summary judgment, or any other motion which is potentially dispositive of a proceeding, the case will be suspended by the Trademark Trial and Appeal Board with respect to all matters not germane to the motion and no party should file any paper which is not germane to the motion. If the case is not disposed of as a result of the motion, proceedings will be resumed pursuant to an order of the Board when the motion is decided.

When a party files a timely motion for summary judgment, the Board will suspend proceedings in the case with respect to all matters not germane to the motion (if the motion was untimely filed, the Board, in its discretion, may issue an immediate action denying the motion for that reason). See 37 CFR §§2.127(d) and (e)(1). The filing of a summary judgment motion does not, in and of itself, automatically suspend proceedings in a case; rather, proceedings are suspended when the Board issues an order to that effect. See Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986), and T. Jeffrey Quinn, TIPS FROM THE TTAB: Inter Partes Summary Judgment Revisited, 76 Trademark Rep. 73, at 74 (1986). Cf. Consultants & Designers, Inc. v. Control Data Corp., 221 USPQ 635 (TTAB 1984). If the Board's determination of the summary judgment motion does not dispose of the case, the Board ordinarily will issue an order resuming proceedings. See 37 CFR §2.127(d).

Once the Board has suspended proceedings in a case pending the determination of a motion for summary judgment, no party should file any paper which is not germane to the motion. See 37 CFR §2.127(d). Examples of papers which are or may be germane to a motion for summary judgment include a brief in opposition to the summary judgment motion, a motion for an extension of time in which to respond to the summary judgment motion, a motion under FRCP 56(f) for discovery to enable the nonmoving party to respond to the summary judgment motion, a cross-motion for summary judgment, and a motion for leave to amend a party's pleading. See TBMP §528.07, and cases cited therein (motion for leave to amend pleading); and Nestle Co. v. Joyva Corp., 227 USPQ 477 (TTAB 1985) (cross-motion for summary judgment).

528.04 Miscaptioned Motion

OLD EDITION

If, on a motion captioned as a motion to dismiss (for failure to state a claim upon which relief can be granted), or a motion for judgment on the pleadings, matters outside the pleadings are submitted and not excluded by the Board, the motion will be treated as a motion for summary judgment under FRCP 56. Ordinarily, the parties to the proceeding will be notified that the motion to dismiss, or for judgment on the pleadings, is being treated as a motion for summary judgment, and they will be given reasonable opportunity to present all material made pertinent to such a motion by FRCP 56. See TBMP §§503.04 and 504.03, and authorities cited therein. Such notice may be unnecessary, however, in those cases where the parties themselves clearly have treated a motion to dismiss, or a motion for judgment on the pleadings, as a motion for summary judgment, and the nonmoving party has responded to the motion on that basis. See TBMP §§503.04 and 504.03, and Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983). Cf. Parker Brothers v. Tuxedo Monopoly, Inc., 225 USPQ 1222 (TTAB 1984).

Conversely, a motion for summary judgment without supporting evidence is the functional equivalent of a motion to dismiss for failure to state a claim upon which relief can be granted, or of a motion for judgment on the pleadings. See S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987); and Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d §2722 (1983). For information concerning the motion to dismiss for failure to state a claim, see TBMP §503. For information concerning the motion for judgment on the pleadings, see TBMP §504.

OLD EDITION

528.05 Summary Judgment Evidence

528.05(a) In General

The types of evidence which may be submitted in support of, or in opposition to, a motion for summary judgment include "the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any." See FRCP 56(c). See also FRCP 56(e).

The evidentiary record upon summary judgment in an inter partes proceeding before the Board also includes, without action by any party, the file of any application or registration which is the subject of the proceeding. See 37 CFR §2.122(b). It also includes a copy of any registration pleaded and made of record

by the plaintiff with its complaint, in the manner prescribed in 37 CFR §2.122(d)(1). In addition, a party may make of record, for purposes of summary judgment, copies of other registrations; documents or things produced in response to a request for production; official records, if competent evidence and relevant to an issue; printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue, if the publication is competent evidence and relevant to an issue; and testimony from other proceedings, so far as relevant and material. See 37 CFR §§2.122(b), 2.122(d)(2), 2.122(e), 2.122(f), and 2.127(e)(2).

In a Board proceeding, the only evidentiary materials likely to be already of record when a motion for summary judgment is filed are the pleadings; the file of any application or registration which is the subject matter of the proceeding; and any registration pleaded and made of record by the plaintiff with its complaint. See Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). Any other evidence which a party wishes to have considered upon summary judgment must be submitted in connection with the summary judgment motion.

Evidence submitted in connection with a motion for summary judgment is of record only for purposes of that motion. If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record to be considered at final hearing unless it is properly introduced in evidence during the appropriate trial period. See Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB 1983); American Meat Institute v. Horace W. Longacre, Inc., 211 USPQ 712 (TTAB 1981); Oxy Metal Industries Corp. v. Technic, Inc., 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976); and Clairol Inc. v. Holland Hall Products, Inc., 165 USPQ 214 (TTAB 1970).

What follows, in TBMP §§528.05(b) through 528.05(e), is a more detailed discussion of some of the types of evidence which may be submitted in connection with a summary judgment motion.

528.05(b) Affidavits and Accompanying Exhibits

OLD EDITION

Affidavits may be submitted in support of, or in opposition to, a motion for summary judgment provided that they (l) are made on personal knowledge; (2) set forth such facts as would be admissible in evidence; and (3) show affirmatively that the affiant is competent to testify to the matters stated therein. See FRCP 56(e). See also FRCP 56(c); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); C & G Corp. v. Baron Homes, Inc., 183 USPQ 60 (TTAB 1974); John T. Clark Co. v. Colgate-Palmolive Co., 176 USPQ 93 (TTAB 1972); 4U Company of America, Inc. v. Naas Foods, Inc., 175 USPQ 251 (TTAB 1972); and Jos. Schlitz Brewing Co. v. United Vintners, Inc., 166 USPQ 493 (TTAB 1970). This is so even though affidavits are self-serving in nature, and even though there is no opportunity for cross-examination of the affiant (of course, an adverse party may have an opportunity for direct examination of the affiant, if a FRCP 56(f) motion to take the discovery deposition of the affiant is made and granted--see TBMP §528.06). See FRCP 56(e); C & G Corp. v. Baron Homes, Inc., supra; and Jos. Schlitz Brewing Co. v. United Vintners, Inc., supra.

The Board may permit affidavits submitted in connection with a summary judgment motion to be supplemented or opposed by depositions, answers to interrogatories, or further affidavits. See FRCP 56(e), and Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993).

Documents submitted with a summary judgment affidavit, but not identified therein, cannot be considered as exhibits to the affidavit. See Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc., 6 USPQ2d 1028 (TTAB 1988). An affidavit which is not supported by documentary evidence may nevertheless be given consideration if the statements contained in the affidavit are clear and convincing in character, and uncontradicted. See 4U Company of America, Inc. v. Naas Foods, Inc., 175 USPQ 251 (TTAB 1972). Cf., for example, Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305 (TTAB 1979); GAF Corp. v. Anatox Analytical Services, Inc., 192 USPQ 576 (TTAB 1976); Clubman's Club Corp. v. Martin, 188 USPQ 455 (TTAB 1975); and Rite Aid Corp. v. Rite-Way Discount Corp., 182 USPQ 698 (TTAB 1974), aff'd, 508 F.2d 828, 184 USPQ 351 (CCPA 1975).

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR §2.20. See 37 CFR §2.20, and Taylor Brothers, Inc. v. Pinkerton Tobacco Co., 231 USPQ 412 (TTAB 1986).

OLD EDITION

528.05(c) Discovery Responses

37 CFR §2.127(e)(2) For purposes of summary judgment only, a discovery deposition, or an answer to an interrogatory, or a document or thing produced in response to a request for production, or an admission to a request for admission, will be considered by the Trademark Trial and Appeal Board if any party files, with the party's brief on the summary judgment motion, the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for production and the documents or things produced in response thereto, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto).

Cf. 37 CFR §2.120(j), governing the use of discovery responses as trial evidence, and TBMP §§709-711.

528.05(d) Registrations

37 CFR §2.122(d)(1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. ...

If a plaintiff's registration is pleaded and made of record pursuant to 37 CFR §2.122(d)(1), the registration is of record for all purposes, including a summary judgment motion.

Alternatively, a plaintiff may make its pleaded registration of record, for purposes of summary judgment only, by filing such a status and title copy with its brief on the summary judgment motion. See Bongrain International (American) Corp. v. Moquet Ltd., 230 USPQ 626 (TTAB 1986). Cf. 37 CFR §2.122(d)(2). A registration owned by a defendant may be made of record, for purposes of summary judgment only, in the same manner.

OLD EDITION

A party may make a third-party registration of record, for purposes of summary judgment only, by filing a copy thereof with its brief on the summary judgment motion; the copy need not be a certified copy, nor need it be a status and title copy. See Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984), and Interbank Card Ass'n v. United States National Bank of Oregon, 197 USPQ 123 (TTAB 1977). See also 37 CFR §2.122(e).

For purposes of summary judgment only, a copy of a trademark search report, made of record as an exhibit to an affidavit, or as part of a discovery response, submitted in opposition to a summary judgment motion, may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation. See Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993).

OLD EDITION

528.05(e) Testimony From Another Proceeding

37 CFR §2.122(f) Testimony from other proceedings. By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

Upon motion granted by the Board, testimony taken in another proceeding, or in a suit or action in a court, between the same parties or their privies, may be used in connection with a summary judgment motion in a pending Board proceeding, to the extent that the testimony is relevant and material. The use of such testimony, however, is subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." See 37 CFR §2.122(f), and Oxy Metal Industries Corp. v. Technic, Inc., 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976). See also TBMP §531.

When the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken upon recall of the same witness for examination or cross-examination, or in rebuttal

thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period. See Oxy Metal Industries Corp. v. Technic, Inc., supra, and TBMP §528.05(a).

528.06 Request for Discovery to Respond to Summary Judgment

A party which believes that it cannot effectively oppose a motion for summary judgment without first taking discovery, may file a request with the Board for time to take the needed discovery. The request must be supported by an affidavit showing that the nonmoving party cannot, for reasons stated, present by affidavit facts essential to justify its opposition to the motion. See FRCP 56(f); Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); Avia Group International Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988); Spectra Corp. v. Lutz, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989); Nature's Way Products Inc. v. Nature's Herbs Inc., 9 USPQ2d 2077 (TTAB 1989); and T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990). See also Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992).

A request for FRCP 56(f) discovery, if filed, should be filed on or before the due date for the nonmoving party's response to the summary judgment motion. The affidavit in support of the request may be signed either by the requesting party or by its counsel, as appropriate. See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990).

It is not sufficient that a nonmoving party simply state in its FRCP 56(f) affidavit that it needs discovery in order to respond to the motion for summary judgment; rather, the party must state therein the reasons why it is unable, without discovery, to present by affidavit facts sufficient to show the existence of a genuine issue of material fact for trial. See Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989). Moreover,

OLD EDITION

summary judgment need not be denied based on a nonmoving party's unsupported speculative hope that it will find, through discovery, some evidence to help its case. See Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989); Spectra Corp. v. Lutz, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988); Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987); Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990); Nature's Way Products Inc. v. Nature's Herbs Inc., 9 USPQ2d 2077 (TTAB 1989); and J.I. Case Co. v. F.L. Industries, Inc., 229 USPQ 697 (TTAB 1986).

In lieu of an affidavit, a party may submit a declaration meeting the requirements of 37 CFR §2.20. See 37 CFR §2.20. Cf. Taylor Brothers, Inc. v. Pinkerton Tobacco Co., 231 USPQ 412 (TTAB 1986).

When a request for discovery under FRCP 56(f) is granted by the Board, the discovery allowed is limited to that which the nonmoving party must have in order to oppose the motion for summary judgment; this is so even if the nonmoving party had, at the time when the summary judgment motion was filed, requests for discovery outstanding, and those requests remain unanswered. See T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990). Cf. Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D. Ohio 1992).

For further information concerning requests for discovery under FRCP 56(f), see T. Jeffrey Quinn, TIPS FROM THE TTAB: Discovery Safeguards in Motions for Summary Judgment: No Fishing Allowed, 80 Trademark Rep. 413 (1990).

OLD EDITION

528.07 Unpleaded Issue

528.07(a) Not Basis for Summary Judgment

A party may not obtain summary judgment on an issue which has not been pleaded. See FRCP 56(a) and 56(b); Paramount Pictures Corp. v. White, 31 USPQ2d 1768 (TTAB 1994); Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993); Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991); Giant Food, Inc. v. Standard Terry Mills, Inc., 231

USPQ 626 (TTAB 1986); Consolidated Foods Corp. v. Berkshire Handkerchief Co., 229 USPQ 619 (TTAB 1986); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); Genesco, Inc. v. Levi Strauss & Co., 219 USPQ 1205 (TTAB 1983), aff'd, Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984); and Intermed Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977). Moreover, at the summary judgment stage of a proceeding before the Board, there has not yet been a trial of any issue, whether pleaded or unpleaded, and therefore the requirements of FRCP 15(b) for an amendment to conform the pleadings to the evidence cannot have been met. See Genesco, Inc. v. Levi Strauss & Co., supra, and Intermed Communications, Inc. v. Chaney, supra.

However, a party which seeks summary judgment on an unpleaded issue may move to amend its pleading to assert the matter. See Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993); Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 USPQ2d 1241 (TTAB 1989); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986); and Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984). Alternatively, if the parties, upon summary judgment motion, have treated an unpleaded issue on its merits, and the nonmoving party has not objected to the motion on the ground that it is based on an unpleaded issue, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. See: Paramount Pictures Corp. v. White, 31 USPQ2d 1768 (TTAB 1994); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986); Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984); and Intermed Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977).

OLD EDITION

528.07(b) Not Defense Against Summary Judgment

A party may not defend against a motion for summary judgment by asserting the existence of genuine issues of material fact as to an unpleaded claim or defense. See Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992), and Perma Ceram Enterprises, Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992). Cf. TBMP §528.07(a), and authorities cited therein.

However, a party which seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, may move to amend its pleading to allege the matter. See United States Olympic Committee v. O-M Bread Inc., 26 USPQ2d 1221 (TTAB 1993). Alternatively, if a party seeks to defend against a motion for summary judgment by asserting the existence of genuine issues of material fact regarding an unpleaded claim or defense, and the party moving for summary judgment treats the unpleaded matter on its merits, and does not object thereto on the ground that the matter is unpleaded, the Board may deem the pleadings to have been amended, by agreement of the parties, to allege the matter. Cf. TBMP §528.07(a), and authorities cited therein.

OLD EDITION

528.08 Entry of Summary Judgment in Favor of Nonmoving Party

If the Board concludes, upon motion for summary judgment, that there is no genuine issue of material fact, but that it is the nonmoving party, rather than the moving party, which is entitled to judgment as a matter of law, the Board may, in appropriate cases, enter summary judgment sua sponte in favor of the nonmoving party (that is, enter summary judgment in favor of the nonmoving party even though there is no cross-motion for summary judgment). See, for example, Sprinklets Water Center Inc. v. McKesson Corp., 25 USPQ2d 1441 (E.D. Mich. 1992); Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857 (TTAB 1986); Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984); and Visa International Service Ass'n v. Life-Code Systems, Inc., 220 USPQ 740 (TTAB 1983). See also, for example (particularly with respect to when it may be appropriate for a court to enter summary judgment sua sponte in favor of the nonmoving party), Celotex Corp. v. Catrett, 477 U.S. 317 (1986); Coach Leatherware Co. v. AnnTaylor Inc., 933 F.2d 162, 18 USPQ2d 1907 (2d Cir. 1991); Arkwright-Boston Manufacturers Mutual Insurance Co. v. Aries Marine Corp., 932 F.2d 442, 19 Fed. R Serv.3d 1290 (5th Cir. 1991); and Wright, Miller & Kane, Federal Practice and Procedure: Civil 2d §2720 (1986).

529 Motion for FRCP 11, or Other Non-Discovery, Sanctions

529.01 FRCP 11 Sanctions

FRCP 11(b) Representations to Court. By presenting to the court (whether by signing, filing, submitting, or later advocating) a pleading, written motion, or other paper, an attorney or unrepresented party is certifying that to the best of the person's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, --

(1) it is not being presented for any improper purpose, such as to harass or to cause unnecessary delay or needless increase in the cost of litigation;

(2) the claims, defenses, and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;

(3) the allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and

(4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on a lack of information or belief.

(c) Sanctions. If, after notice and a reasonable opportunity to respond, the court determines that subdivision (b) has been violated, the court may, subject to the conditions stated below, impose an appropriate sanction upon the ... parties that have violated subdivision (b) or are responsible for the violation.

(1) How Initiated.

(A) By Motion. A motion for sanctions under this rule shall be made separately from other motions or requests and shall describe the specific conduct alleged to violate subdivision (b). It shall be served ..., but shall not be filed with or presented to the court unless, within 21 days after service of the motion (or such other period as the court may prescribe), the challenged paper, claim, defense, contention, allegation, or denial is not withdrawn or appropriately corrected. ...

(B) On Court's Initiative. On its own initiative, the court may enter an order describing the specific conduct that appears to violate subdivision (b) and directing [a] ... party to show cause why it has not violated subdivision (b) with respect thereto.

(2) Nature of Sanction; Limitations. A sanction imposed for violation of this rule shall be limited to what is sufficient to deter repetition of such conduct or comparable conduct by others similarly situated. Subject to the limitations in subparagraphs (A) and (B), the sanction may consist of, or include, directives of a nonmonetary nature, ...

OLD EDITION

(3) Order. When imposing sanctions, the court shall describe the conduct determined to constitute a violation of this rule and explain the basis for the sanction imposed.

(d) Inapplicability to Discovery. Subdivisions (a) through (c) of this rule do not apply to ... discovery requests, responses, objections, and motions that are subject to the provisions of Rules 26 through 37.

37 CFR §10.18 Signature and certificate of practitioner.
(a) Except where a copy, including a photocopy or facsimile transmission, of a personally signed piece of correspondence is permitted to be filed pursuant to §1.4 of this chapter, every piece of correspondence filed by a practitioner on behalf of himself or herself or representing an applicant or a party to a proceeding in the Patent and Trademark Office must bear an original signature personally signed in permanent ink by such practitioner except for correspondence which is required to be signed by the applicant or party. The signature of a practitioner on correspondence filed by the practitioner, regardless of whether the correspondence has an original signature or is a copy, including a photocopy or facsimile transmission, of correspondence bearing an original signature, constitutes a certificate that:

(1) The correspondence has been read by the practitioner;

(2) The filing of the correspondence is authorized;

(3) To the best of practitioner's knowledge, information, and belief, there is good ground to support the correspondence, including any allegations of improper conduct contained or alleged therein; and

(4) The correspondence is not interposed for delay.

(b) Any practitioner knowingly violating the provisions of this section is subject to disciplinary action. See §10.23(c)(15).

The quoted provisions of FRCP 11 are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. See 37 CFR §2.116(a); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Avia Group International Inc. v. Faraut, 25 USPQ2d 1625 (TTAB 1992); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986); and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986). See also, Alan S.

OLD EDITION

Cooper, The Application of Rule 11 Sanctions in Trademark Cases, 78 Trademark Rep. 427 (1988). Thus, if a paper filed in an inter partes proceeding before the Board violates the provisions of FRCP 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction.

While FRCP 11 provides, inter alia, for the imposition of monetary sanctions, the Board does not have authority to impose monetary sanctions, or to award attorneys' fees or other expenses to any party. See 37 CFR §§2.120(f), 2.120(g)(1), 2.120(h), and 2.127(f), and TBMP §502.06.

However, the Board does have authority to enter other appropriate sanctions, up to and including the entry of judgment, against a party which violates FRCP 11. See 37 CFR §2.116(a); Avia Group International Inc. v. Faraut, 25 USPQ2d 1625 (TTAB 1992); Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990); Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987); Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986); and Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986). See also, Alan S. Cooper, The Application of Rule 11 Sanctions in Trademark Cases, 78 Trademark Rep. 427 (1988). The Board may find a FRCP 11 violation, and impose an appropriate sanction, not only upon motion, but also upon its own initiative. See FRCP 11, and Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986).

A motion for sanctions under FRCP 11(c) is governed by, and should not be filed in violation of, FRCP 11(b). If the Board finds that a motion for FRCP 11(c) sanctions itself violates the provisions of FRCP 11(b), an appropriate FRCP 11(c) sanction may be entered against the party which filed the motion.

The provisions of 37 CFR §10.18 are also applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. Any practitioner who knowingly violates the provisions of that rule is subject to disciplinary action. See 37 CFR §10.18. For information concerning disciplinary proceedings, see 37 CFR §§10.130-10.170, and TBMP §115.02.

529.02 Other Non-Discovery Sanctions

OLD EDITION

There are certain situations, in addition to those involving a failure to provide discovery (see TBMP §527) or a violation of FRCP 11 (see TBMP §529.01), in which the Board, in its discretion, may enter sanctions against a party.

For example, when a party to an inter partes proceeding before the Board advises an adverse party that it will not take any further action in the case, the adverse party may file a motion asserting this fact and requesting entry of judgment in its favor. If, as is usually the case, the motion is uncontested, it normally will be granted by the Board. See 37 CFR §2.127(a), and TBMP §502.03.

Similarly, if a registrant (having been served by the Board with a copy of a petition to cancel its registration) or any other party to an inter partes proceeding before the Board, relocates, and fails to inform its attorney (if it is represented by an attorney) or the Board or any adverse party of its new address, with the result that the party cannot be found, and papers relating to the proceeding cannot be served upon it, any adverse party may file a motion asserting such fact and requesting entry of judgment in its own favor. Again, if the motion is uncontested, it normally will be granted by the Board.

OLD EDITION

530 Motion to Offer Discovery Deposition of Self or Nonparty

37 CFR §2.120(j) Use of discovery deposition, ...
(1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragraph (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the

parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

Ordinarily, the discovery deposition of a party (or of anyone who, at the time of taking the deposition, was an officer, director, or managing agent of a party, or a person designated by a party pursuant to FRCP 30(b)(6) or FRCP 31(a)(3)) may be offered in evidence only by an adverse party; a party may not, in the first instance, offer in evidence a discovery deposition taken of itself (or of its officer, director, managing agent, etc.) by an adverse party, except by stipulation of the parties approved by the Board, or by order of the Board on motion. Similarly, no party may offer into evidence the discovery deposition of a nonparty witness, except by stipulation of the parties approved by the Board, or by order of the Board on motion. See 37 CFR §2.120(j)(2), and TBMP §709 and authorities cited therein. Cf. 37 CFR §2.120(j)(4) (fairness exception, which provides that if only part of a discovery deposition is made of record by a party, an adverse party may introduce under notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party).

A motion for leave to offer in evidence a discovery deposition taken by an adverse party of the moving party itself (or of an officer, director, managing agent, etc., of the moving party), or the discovery deposition of a nonparty witness, must show that:

(1) The person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or

(2) Such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. See Maytag Co. v. Luskin's, Inc., 228 USPQ 747 (TTAB 1986); Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc., 221 USPQ 354 (TTAB 1984); National Fidelity Life Insurance v.

OLD EDITION

National Insurance Trust, 199 USPQ 691 (TTAB 1978); and Insta-Foam Products, Inc. v. Instapak Corp., 189 USPQ 793 (TTAB 1976) (the latter two cases were decided prior to the adoption of Rule 2.120(j)(2)).

A motion based on one of the first grounds listed above must be filed at the time of the purported offer of the deposition in evidence. A motion based on the second ground must be filed promptly after the circumstances claimed to justify use of the deposition become known. See 37 CFR §2.120(j)(2).

531 Motion to Use Testimony From Another Proceeding

37 CFR §2.122(f) Testimony from other proceedings. By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

The use, in an inter partes proceeding before the Board, of testimony taken in another Board proceeding, or testimony taken in a suit or action in a court, is governed by 37 CFR §2.122(f). Cf. TBMP §715 and authorities cited therein.

A party may seek, by motion, to use testimony from another proceeding either as evidence in its behalf upon summary judgment, or as part of its evidence on the case. See TBMP §§528.05(e) and 715, and authorities cited therein.

The Board prefers that a motion for leave to use testimony from another proceeding as evidence on the case be filed during the testimony period of the moving party. See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992). Cf. 37 CFR §2.120(j)(2). The better practice is to file the motion early in the testimony period, in order to minimize the resulting delay in the proceeding. If the motion is made without the consent of every adverse party, and the moving party believes that it will need additional time to present evidence if the motion is denied, the moving party should file with its motion under 37 CFR §2.122(f) a motion to extend its testimony period.

OLD EDITION

However, 37 CFR §2.122(f) does not require that a motion for leave to use testimony from another proceeding be filed during the testimony period of the moving party, and it is not unreasonable for a party to want to ascertain, prior to the opening of its testimony period, whether it will be allowed to rely on such testimony. Thus, a motion under 37 CFR §2.122(f) filed prior to the opening of the moving party's testimony period will not be denied as untimely. See Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992).

A motion for leave to use testimony from another proceeding should be accompanied by a copy of the testimony, and accompanying exhibits, sought to be introduced. A copy of the motion, testimony, and accompanying exhibits should be served on every other party to the proceeding. See 37 CFR §2.119(a), and Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992).

The Board has construed the term "testimony," as used in 37 CFR §2.122(f), as meaning only trial testimony (see Philip Morris Inc. v. Brown & Williamson Tobacco Corp., 230 USPQ 172, 182 (TTAB 1986)), or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

OLD EDITION

532 Motion That Deposition Upon Written Questions Be Taken Orally

37 CFR §2.123(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

A party served with notice of the taking, by an adverse party, of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, may, within 15 days from the

date of service of the notice (20 days if service of the notice was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), file a motion with the Board, showing good cause, for an order that the deposition be taken by oral examination. See 37 CFR §2.123(a)(1).

The determination of whether good cause exists for a motion that a testimonial deposition upon written questions instead be taken by oral examination, is made by the Board on a case-by-case basis, depending upon the particular facts and circumstances in each one. See Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990), and Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980). See also Louise E. Fruge, TIPS FROM THE TTAB: Depositions Upon Written Questions, 70 Trademark Rep. 253, at 254 (1980), and Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979). Cf. Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989), and TBMP §520.

OLD EDITION

533 Motion to Strike Notice of Reliance

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. Rule 2.120(j), 37 CFR §2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under FRCP 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR §2.122(e). Rule 2.122(d)(2), 37 CFR §2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Rule 2.122(e), 37 CFR §2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. See also TBMP §§703.02(a), 703.02(b), 703.03, and 707-711.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely. See TBMP §718.02(a), and cases cited therein.

An adverse party may also move to strike a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted. For example, a party may move to strike a 37 CFR §2.122(e) notice of reliance on a printed publication, on the ground that it does not include a copy of the printed publication, or does not indicate the general relevance thereof. See TBMP §718.02(b), and cases cited therein. When, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party which filed the notice of reliance time in which to cure the defect, failing which the notice will stand stricken. See Heaton Enterprises of Nevada Inc. v. Lang, 7 USPQ2d 1842 (TTAB 1988).

Objections to a notice of reliance on substantive grounds, such as objections on the grounds that evidence offered under a notice of reliance constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, normally need not and should not by raised by motion to strike. Rather, such objections should be raised in the objecting party's brief on the case, unless the ground for objection is one which could have been cured if raised promptly by motion to strike. See TBMP §718.02(c), and authorities cited therein.

If a motion to strike a notice of reliance raises objections which cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. See M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990).

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing. See TBMP §718.02(c), and cases cited therein.

OLD EDITION

534 Motion to Strike Trial Testimony Deposition

534.01 On Ground of Untimeliness

37 CFR §2.121(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall

be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. ...

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a), and TBMP §701.

When there is no such approved stipulation, or granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely. See 37 CFR §§2.121(a) and 2.123(l), and M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990). Alternatively, the adverse party may raise this ground for objection in its brief on the case. See TBMP §718.03(a), and authorities cited therein. Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

OLD EDITION

534.02 On Ground of Improper or Inadequate Notice

37 CFR §2.123(c) Notice of examination of witnesses. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. ...

37 CFR §2.123(e)(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which

motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is to be taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. See 37 CFR §2.123(e)(3); Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990) (short notice); Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986) (witness not identified); Home Juice Co. v. Runglin Cos., 231 USPQ 897 (TTAB 1986) (motion to strike untimely); and Alpha Industries, Inc. v. Alpha Microsystems, 220 USPQ 67 (TTAB 1983) (no objection based on inadequate notice raised). Cf. Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984) (witness not identified); Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802, at fn. 6 (TTAB 1982) (short notice); O. M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976) (witness not identified); and Allstate Life Insurance Co. v. Cuna International, Inc., 169 USPQ 313 (TTAB 1971), aff'd without opinion, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973) (witnesses not identified) [NOTE: this group of cases was decided under 37 CFR §2.123(e)(3) as it existed prior to a rule change effective June 22, 1983, which added thereto, inter alia, the requirement that an adverse party which wishes to preserve an objection based on improper or inadequate notice must move to strike the testimony promptly after its completion].

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. See 37 CFR §2.123(e)(3).

534.03 When Motion to Strike Should Not Be Filed

OLD EDITION

Objections to testimony depositions on grounds other than the ground of untimeliness, or the ground of improper or inadequate notice, generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the applicable rules, or orally "on the record" at the taking of the deposition, as appropriate. See TBMP §718.03(c).

535 Motion for Judgment for Plaintiff's Failure to Prove Case

535.01 In General

37 CFR §2.132 Involuntary dismissal for failure to take testimony.
(a) If the time for taking testimony by any party in the position of plaintiff has expired and that party has not taken testimony or offered any other evidence, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground of the failure of the plaintiff to prosecute. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to show cause why judgment should not be rendered against him. In the absence of a showing of good and sufficient cause, judgment may be rendered against the party in the position of plaintiff. If the motion is denied, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(b) If no evidence other than a copy or copies of Patent and Trademark Office records is offered by any party in the position of plaintiff, any party in the position of defendant may, without waiving the right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the party in the position of plaintiff has shown no right to relief. The party in the position of plaintiff shall have fifteen days from the date of service of the motion to file a brief in response to the motion. The Trademark Trial and Appeal Board may render judgment against the party in the position of plaintiff, or the Board may decline to render judgment until all of the evidence is in the record. If judgment is not rendered, testimony periods will be reset for the party in the position of defendant and for rebuttal.

(c) A motion filed under paragraph (a) or (b) of this section must be filed before the opening of the testimony period of the moving party, except that the Trademark Trial and Appeal Board may in its discretion grant a motion under

OLD EDITION

paragraph (a) even if the motion was filed after the opening of the testimony period of the moving party.

The Trademark Rules of Practice permit the filing of a motion for judgment directed to the sufficiency of a plaintiff's trial evidence in two particular situations, described in 37 CFR §§2.132(a) and 2.132(b). Only in these two situations will such a motion be entertained by the Board. See TBMP §535.04.

535.02 Motion for Judgment Under Rule 2.132(a)

The first situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence, is when the plaintiff's testimony period has passed, and the plaintiff has not taken testimony or offered any other evidence. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal for failure of the plaintiff to prosecute. See 37 CFR §2.132(a). See also, for example, Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Hartwell Co. v. Shane, 17 USPQ2d 1569, at fn.4 (TTAB 1990); Hester Industries Inc. v. Tyson Foods Inc., 2 USPQ2d 1646 (TTAB 1987); Loren Cook Co. v. Acme Engineering and Manufacturing Corp., 216 USPQ 517 (TTAB 1982); and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 275-276 (1984). A motion for judgment under 37 CFR §2.132(a) should be filed before the opening of the moving party's testimony period, but the Board may, in its discretion, grant the motion even if it was filed thereafter. See 37 CFR §2.132(c), and Hewlett-Packard Co. v. Olympus Corp., supra.

When a motion for judgment under 37 CFR §2.132(a) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)) in which to show cause why judgment should not be rendered against it. In the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff. See 37 CFR §2.132(a).

The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard which would have to be met by any motion under FRCP 6(b) to reopen the plaintiff's testimony period. See Grobet File Co.

OLD EDITION

of America Inc. v. Associated Distributors Inc., 12 USPQ2d 1649 (TTAB 1989), and Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982). For examples of cases involving the question of whether good and sufficient cause has been shown for a plaintiff's failure to offer any evidence, see Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (plaintiff, without first obtaining defendant's consent thereto, sent defendant a proposed "stipulated" extension of plaintiff's testimony period and asked that defendant sign it and forward it to the PTO; defendant did not do so); Grobet File Co. of America Inc. v. Associated Distributors Inc., 12 USPQ2d 1649 (TTAB 1989) (defendant had filed several motions to extend its time to respond to discovery requests); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987) (plaintiff entitled to know disposition of defendant's pending motion to amend its answer before proceeding to trial); Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982) (misunderstanding between counsel for plaintiff and defendant); Proctor & Gamble Co. v. Johnson & Johnson Inc., 485 F.Supp. 1185, 205 USPQ 697 (S.D.N.Y. 1979), aff'd without opinion, 636 F.2d 1203 (2d Cir. 1980) (civil action filed by defendant prior to commencement of plaintiff's testimony period); Allegro High Fidelity, Inc. v. Zenith Radio Corp., 197 USPQ 550 (TTAB 1977) (civil action filed by plaintiff after close of its testimony period); Tel-E-Gift Corp. v. Teleflora Inc., 193 USPQ 254 (TTAB 1976) (communication problem between plaintiff and its counsel); Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 428 (TTAB 1976), recon. denied, 190 USPQ 431 (TTAB 1976) (inadequate docket system and heavy work load of plaintiff's counsel; request filed by plaintiff, after close of its testimony period, that Board take judicial notice of certain matters); Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509 (TTAB 1976) (answer to complaint contains certain admissions); A.R.A. Manufacturing Co. v. Equipment Co., 183 USPQ 558 (TTAB 1974) (unfamiliarity with current rule governing introduction of plaintiff's registration); Pierce Foods Corp. v. Mountain Mamma, Inc., 183 USPQ 380 (TTAB 1974) (applicant assertedly guilty of unclean hands); Other Telephone Co. v. Connecticut National Telephone Co., 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974) (during its testimony period, plaintiff had moved to suspend pending outcome of recently filed civil action); W. R. Grace & Co. v. Red Owl Stores, Inc., 181 USPQ 118 (TTAB 1973) (unfamiliarity with current rule governing introduction of plaintiff's registration); and Perfect Film & Chemical Corp. v. Society Ordinastral, 172 USPQ 696 (TTAB 1972) (allegations in pleading, and exhibits attached thereto, not evidence in plaintiff's behalf).

OLD EDITION

If a timely motion under 37 CFR §2.132(a) is denied, testimony periods will be reset for the defendant and for rebuttal. See 37 CFR §2.132(a).

The purpose of the motion under 37 CFR §2.132(a) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff has failed to offer any evidence during its testimony period. See Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976). However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. See Pfaltzgraf v. William Davies Co., 175 USPQ 620 (TTAB 1972), and Gary D. Krugman, TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods, 73 Trademark Rep. 76 (1983). If no motion under 37 CFR §2.132(a) is filed, trial dates will continue to run, and the case will be determined at final hearing; in those cases where plaintiff did, in fact, fail to offer any evidence during its testimony period, defendant need not offer evidence either. See, for example, Hester Industries Inc. v. Tyson Foods Inc., 2 USPQ2d 1646 (TTAB 1987), and Pfaltzgraf v. William Davies Co., 175 USPQ 620 (TTAB 1972).

The fact that a defendant may have previously sought judgment under 37 CFR §2.132(b) does not preclude it from thereafter seeking judgment under 37 CFR §2.132(a). See W. R. Grace & Co. v. Red Owl Stores, Inc., 181 USPQ 118 (TTAB 1973).

OLD EDITION

535.03 Motion for Judgment Under Rule 2.132(b)

The second situation in which a defendant may appropriately file a motion for judgment directed to the sufficiency of a plaintiff's trial evidence, is when the plaintiff's testimony period has passed, and the plaintiff has offered no evidence other than a copy or copies of PTO records. In such a situation, the defendant may, without waiving its right to offer evidence in the event the motion is denied, move for dismissal on the ground that upon the law and the facts the plaintiff has shown no right to relief. See 37 CFR §2.132(b). A motion for judgment under 37 CFR §2.132(b) must be filed before the opening of the moving party's testimony period. See 37 CFR §2.132(c).

When a motion for judgment under 37 CFR §2.132(b) has been filed by a defendant, the plaintiff has 15 days from the date of service of the motion (20 days, if service of the motion was made by first-class mail, "Express Mail," or

overnight courier--see 37 CFR §2.119(c)) to file a brief in response thereto. See 37 CFR §2.132(b).

In determining a motion under 37 CFR §2.132(b), the Board may either render judgment against the plaintiff, or decline to render judgment until all of the evidence is in the record. See 37 CFR §2.132(b). See also Merker Counter Co. v. Central Counter Co., 310 F.2d 746, 135 USPQ 433 (CCPA 1962); Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 USPQ2d 1879 (TTAB 1990); and Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., 193 USPQ 313 (TTAB 1976).

If a timely motion under 37 CFR §2.132(b) is denied, testimony periods will be reset for the defendant and for rebuttal. See 37 CFR §2.132(b).

The purpose of the motion under 37 CFR §2.132(b) is to save the defendant the expense and delay of continuing with the trial in those cases where plaintiff, during its testimony period, has offered no evidence other than copies of PTO records, and those records do not make out a prima facie case. See Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976). However, the defendant is under no obligation to file such a motion; the motion is optional, not mandatory. See Gary D. Krugman, TIPS FROM THE TTAB: Motions for Judgment After Commencement of Testimony Periods, 73 Trademark Rep. 76 (1983). Cf. Pfaltzgraf v. William Davies Co., 175 USPQ 620 (TTAB 1972).

The fact that a defendant may have previously sought judgment under 37 CFR §2.132(a) does not preclude it from thereafter seeking judgment under 37 CFR §2.132(b). Cf. W. R. Grace & Co. v. Red Owl Stores, Inc., 181 USPQ 118 (TTAB 1973).

OLD EDITION

535.04 Motion Under FRCP 41(b) or FRCP 50(a) Not Available

Trial testimony, in Board inter partes proceedings, is taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence, prior to final decision. See TBMP §502.01, and authorities cited therein.

Accordingly, the only means available for testing the sufficiency of trial evidence in an inter partes proceeding before the Board are the motions described in 37 CFR §§2.132(a) and 2.132(b). See TBMP §§535.02 and 535.03. The motion under FRCP 41(b) for involuntary dismissal, and the motion under FRCP 50(a) for a directed verdict, are not available in Board proceedings. See TBMP §502.01, and authorities cited therein.

536 Motion for Order to Show Cause Under Rule 2.134(b)

37 CFR §2.134(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under section 8 of the Act of 1946 or has failed to renew his involved registration under section 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

See, in this regard, TBMP §602.02(b) and authorities cited therein.

It is generally the responsibility of a petitioner for cancellation to keep track of the status of the respondent's subject registration, and to file a motion for an order to show cause under 37 CFR §2.134(b) if such registration is cancelled under Section 8 or 9 of the Act after the commencement of the proceeding. However, if the cancellation of the registration under Section 8 or 9 of the Act comes to the attention of the Board in another manner, the Board may issue an order to show cause upon its own initiative.

In those cases where the Board finds that respondent has shown good and sufficient cause why judgment should not be entered against it under 37 CFR §2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner will be given time in which to elect whether it wishes to

OLD EDITION

go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. See TBMP §602.02(b), and cases cited therein.

For further information concerning orders to show cause under 37 CFR §2.134(b), see TBMP §602.02(b).

537 Motion for Order to Show Cause Under Rule 2.128(a)(3)

37 CFR §2.128(a)(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

The principal purpose of 37 CFR §2.128(a)(3) is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is not the policy of the Board to enter judgment against a plaintiff for failure to file a main brief on the case if the plaintiff still wishes to obtain an adjudication of the case on the merits. See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23132, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 22; and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 275 (1984). If a show cause order is issued under 37 CFR §2.128(a)(3), and the plaintiff files a response indicating that it has not lost interest in the case, the show cause order will be considered discharged, and judgment will not be entered against plaintiff for failure to file a main brief.

When a plaintiff fails to file a main brief on the case, it is the normal practice of the Board to issue, sua sponte, an order to show cause why the failure to file a brief should not be treated as a concession of the case. If such an order is not issued by the Board sua sponte, or if an adverse party fears that the Board may inadvertently overlook a plaintiff's failure to file a main brief, the adverse party may file a motion for an order to show cause.

OLD EDITION

When it finds that a 37 CFR §2.128(a)(3) order to show cause has been discharged, the Board will reset the times for filing remaining briefs on the case. If the plaintiff includes with its response to the show cause order a motion under FRCP 6(b) to reopen its time to file a main brief (see TBMP §509), and the motion is granted, all times for filing briefs on the case will be reset.

If a 37 CFR §2.128(a)(3) order to show cause has been discharged, but the record shows that plaintiff failed, during its testimony period, to take any testimony or offer any other evidence in its behalf, the Board, in lieu of resetting the times for filing remaining briefs on the case, may enter judgment against plaintiff for failure to prove its case.

OLD EDITION

538 Motion for Leave to Exceed Page Limit for Brief on Case

37 CFR 2.128(b) ... Each brief shall contain an alphabetical index of cases cited therein. Without prior leave of the Trademark Trail and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. ...

For further information concerning the parts of a brief which fall within the page limit, see TBMP §801.03, and authorities cited therein.

A party seeking leave to file a brief on the case with more than the allowed number of pages must obtain "prior leave" from the Board to do so. See 37 CFR §2.128(b). Thus, the motion must be submitted on or before the date that the brief is due. See United Foods Inc. v. United Air Lines Inc., 33 USPQ2d 1542 (TTAB 1994). This is so even in those cases where the motion is filed with the consent of the adverse party or parties. Rule 2.128(b) is for the benefit of the Board, and only with the Board's permission, timely sought, will a brief exceeding the page limit be entertained.

The better, and preferred, practice, when a timely motion for leave to exceed the page limit is filed, is that the proposed overlength brief not be filed with the motion. If the moving party refrains from filing its brief with the motion, and the motion is granted, the Board, in its decision on the motion, will allow time for the filing of the brief, and specify the number of additional pages granted.

Alternatively, if the motion is denied, the Board, in its decision, will allow time for the filing of a brief which does not exceed the page limit specified in 37 CFR §2.128(b). On the other hand, if the proposed overlength brief is filed with the motion, and the motion is granted, the Board will accept the brief. If the motion is denied, the overlength brief will be given no consideration, and the Board will allow time for the filing of a brief which meets the limit. See United Foods Inc. v. United Air Lines Inc., 33 USPQ2d 1542 (TTAB 1994).

A timely motion to exceed the specified page limit need not be accompanied by a motion to extend the time for filing the subject brief. As noted in the preceding paragraph, when the Board rules upon the motion to exceed the page limit, it will reset the due date for the brief which is the subject of the motion, along with the due dates for any remaining briefs on the case, whether or not the motion is granted.

If a party files a brief which exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute brief which meets the limit. See United Foods Inc. v. United Air Lines Inc., 33 USPQ2d 1542 (TTAB 1994).

Motions for leave to file a brief on the case which exceeds the page limit are relatively rare and are disfavored by the Board. Because the Board is an administrative tribunal of limited jurisdiction, empowered to determine only the right to register (see TBMP §102.01), very few of the cases before it are of such nature as to require a brief on the case which exceeds the 37 CFR §2.128(b) page limit. Moreover, page limitations serve several important functions. They assist the Board in the management of its workload, and encourage litigants to focus their arguments and eliminate needless verbiage. Cf. Fleming v. County of Kane, 855 F.2d 496 (7th Cir. 1988).

A motion for leave to file a brief exceeding the page limit is evaluated on the basis of the reasonableness of the request in light of such factors as the number of additional pages sought, the novelty and/or complexity of the issues in the case, the extent of the trial record, and any other relevant facts or circumstances which may serve to demonstrate why additional pages are necessary. See United Foods Inc. v. United Air Lines Inc., 33 USPQ2d 1542 (TTAB 1994), and U.S. Navy v. United States Manufacturing Co., 2 USPQ2d 1254 (TTAB 1987). Cf. 37 CFR §2.129(a), and TBMP §542.02.

OLD EDITION

539 Motion for Leave to File Amicus Brief

Amicus briefs are neither provided for nor prohibited in the rules governing practice in Board proceedings. Thus, the Board may, in its discretion, entertain an amicus brief if the Board finds that such a brief is warranted under the circumstances of a particular case. See, for example, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987). Cf. TBMP §502.03 (reply briefs on motions neither provided for nor prohibited by rules and may be entertained by Board in its discretion), and Federal Circuit Rule 29 (governing the filing of amicus briefs in appeals to the Court of Appeals for the Federal Circuit).

An entity which wishes to file an amicus brief should file a motion with the Board for leave to do so. The motion may be accompanied by the proposed brief. An amicus brief should be filed within the time allowed the party whose position the brief serves to support, unless all parties consent otherwise, or the Board, upon motion for good cause shown, permits a later filing. Cf. Federal Circuit Rule 29.

A motion for leave to file an amicus brief may not be used as a substitute for a timely notice of opposition or petition for cancellation.

Motions for leave to file an amicus brief are rarely filed in Board proceedings, and the granting thereof by the Board is even rarer.

OLD EDITION

540 Motion to Strike Brief on Case

Specific provision is made in the Trademark Rules of Practice for the filing of briefs on the case, namely, the main brief of the party in the position of plaintiff, followed by the answering brief of the party in the position of defendant, followed by the reply brief of the party in the position of plaintiff. See 37 CFR §2.128(a). See also TBMP §801.02.

Subject to the provisions of FRCP 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. Accordingly, when a brief on the case has been regularly filed, the Board generally will not strike the brief, or any portion thereof, upon motion by an adverse party which simply objects to

the contents thereof. Rather, any objections which an adverse party may have to the contents of such a brief will be considered by the Board in its determination of the case, and any portions of the brief which are found by the Board to be improper will be disregarded.

However, if a brief on the case is not timely filed, or violates the length limit or other format requirements specified in 37 CFR §2.128(b) (see TBMP §§538 and 801.03), it may be stricken, or given no consideration, by the Board. See American Optical Corp. v. Atwood Oceanics, Inc., 177 USPQ 585 (Comm'r 1973) (brief too long and not in proper form), and Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd., 175 USPQ 250 (TTAB 1972) (brief untimely). If a brief is stricken because of a format violation, the Board may, in its discretion, allow the offending party time to submit a substitute brief complying with the requirements of 37 CFR §2.128(b). But see TBMP §538 (if a party files a brief which exceeds the page limit, but does not file a timely motion for leave to file such a brief, the brief will be stricken, without leave to file a substitute which meets the limit).

Because the rules do not provide for the filing of a reply or rejoinder brief by a party in the position of defendant, any such brief may be stricken, or given no consideration, by the Board. See Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Fortunoff Silver Sales, Inc. v. Norman Press, Inc., 225 USPQ 863 (TTAB 1985); Hydrotechnic Corp. v. Hydrotech International, Inc., 196 USPQ 387 (TTAB 1977); L. Leichner (London) Ltd. v. Robbins, 189 USPQ 254 (TTAB 1975); and Globe-Union Inc. v. Raven Laboratories Inc., 180 USPQ 469 (TTAB 1973).

Evidentiary material attached to a brief on the case can be given no consideration unless it was properly made of record during the testimony period of the offering party. If evidentiary material not of record is attached to a brief on the case, an adverse party may object thereto by motion to strike or otherwise. See, for example, Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984); Plus Products v. Physicians Formula Cosmetics, Inc., 198 USPQ 111 (TTAB 1978); Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976); L. Leichner (London) Ltd. v. Robbins, 189 USPQ 254 (TTAB 1975); Tektronix, Inc. v. Daktronics, Inc., 187 USPQ 588 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); and Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973).

OLD EDITION

541 Motion for Augmented Panel Hearing

Each case before the Board must be judicially "heard" (i.e., determined) by at least three members (administrative trademark judges) of the Board. See Section 17 of the Act, 15 U.S.C. §1067. See also 37 CFR §§2.129(a) and 2.142(e)(1); In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); Plus Products v. Medical Modalities Associates, Inc., 217 USPQ 464 (TTAB 1983); Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982); Ronson Corp. v. Ronco Teleproducts, Inc., 197 USPQ 492 (Comm'r 1978); and Ethicon, Inc. v. American Cyanamid Co., 193 USPQ 374 (Comm'r 1977). However, the Board may use an augmented panel to hear a case. See, for example, In re Ferrero S.p.A., 22 USPQ2d 1800 (TTAB 1992), recon. denied, 24 USPQ2d 1061 (TTAB 1992); In re Johanna Farms Inc., 8 USPQ2d 1408 (TTAB 1988); In re McDonald's Corp., 230 USPQ 210 (TTAB 1986); In re WSM, Inc., 225 USPQ 883 (TTAB 1985); and Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984). An augmented panel may include any number of Board members exceeding three, that is, from four to the entire body of members. For information concerning the constitution of Patent and Trademark Office Board panels, see In re Alappat, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. A motion requesting that a case be heard by an augmented panel should be filed no later than the time for requesting an oral hearing on the case (i.e., no later than 10 days after the due date for the filing of the last reply brief in the proceeding--see 37 CFR §2.129(a)).

An augmented panel is used by the Board only in extraordinary cases, involving precedent-setting issues of exceptional importance, or when consideration by an augmented panel is necessary to secure or maintain uniformity of Board decisions. See, for example, In re Johanna Farms Inc., 8 USPQ2d 1408 (TTAB 1988); In re McDonald's Corp., 230 USPQ 210 (TTAB 1986); In re WSM, Inc., 225 USPQ 883 (TTAB 1985); and Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984). Cf. Federal Circuit Rule 35.

542 Motion to Change Oral Hearing Date; For Additional Time

OLD EDITION

542.01 Motion to Change Oral Hearing Date

If a party to a proceeding before the Board desires to have an oral argument (i.e., oral hearing) at final hearing, the party must file a request therefor, by separate paper, not later than 10 days after the due date for the filing of the last reply brief in the proceeding. When a request for an oral hearing is filed, the Board sets the date and time for the hearing, and sends each party written notice thereof. See 37 CFR §2.129(a). It is the normal practice of the Board, in setting an oral hearing, to phone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed.

The date or time of an oral hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives. See 37 CFR §2.129(b). When parties agree to the resetting of an oral hearing, they should determine a new date and time convenient to every party and then contact the Board Administrator, by phone, well prior to the scheduled hearing date, to request that the hearing be reset for the new date and time. The parties should also file a written stipulation or consented motion confirming their agreement. If parties agree to the resetting of an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations.

When one or more of the parties does not consent to the resetting of an oral hearing, the party which wishes to have the hearing reset must file a motion therefor, showing good cause. See FRCP 6(b), and TBMP §509. The motion should be filed well in advance of the scheduled hearing date. Further, to ensure that the motion is determined (by telephone conference call, if necessary) prior to the scheduled hearing date, the moving party should either hand deliver its motion, at the offices of the Board, to the Board interlocutory attorney to whom the case is assigned, or, if the motion has been filed with the Board by some other method, telephone the interlocutory attorney handling the case and notify the attorney of the filing of the motion. See TBMP §502.07(a). An unconsented motion to reset an oral hearing should not be filed merely because another date would be more convenient. The process of scheduling an oral hearing is a time-consuming task for the Board. Because of the inherent difficulties in arranging a date for an oral hearing, an unconsented motion to reset the hearing should be filed only for the most compelling reasons. Examples thereof include the onset

OLD EDITION

of serious illness, nonelective surgery, death of a family member and similar unanticipated or unavoidable events.

Repeated stipulations or requests to reset an oral hearing should not be filed.

For further information concerning oral hearings, see TBMP §802.

542.02 Motion for Additional Time for Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. See 37 CFR §2.129(a), and TBMP §802.05. If, because of the novelty or complexity of the issues, the extent of the record, the presence of a counterclaim involving different issues than those involved in the original proceeding, etc., a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. See 37 CFR §2.129(a), and U.S. Navy v. United States Manufacturing Co., 2 USPQ2d 1254 (TTAB 1987). Cf. 37 CFR §2.128(b), and TBMP §538. If the request is granted, each party will be allowed the same amount of time for oral argument.

When a party decides to request additional time for oral argument, the party should immediately call the Board and notify the Board that it intends to file a request for additional time. Alternatively (and ideally), the request for additional time may be included in the request for oral hearing. This early notification is necessary to ensure that there will be time in the Board's hearing schedule for an extended oral hearing, and also to ensure that the request will be considered and determined prior to the date of the oral hearing. Cf. TBMP §542.01.

OLD EDITION

543 Motion for Leave to Audiotape Oral Hearing

Upon prior arrangement, the Board will usually permit a party to make an audiotape recording of an oral hearing. However, such a recording is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board).

Leave to audiotape an oral hearing is secured by filing a motion therefor showing good cause (such as, that the audiotape is desired by the requesting attorney, or the requesting attorney's firm, for personal use in evaluating the performance of the attorney as an advocate). The motion should be filed well in advance of the date set for the oral hearing, so that if an adverse party raises any objections, the Board will have time to rule upon the motion prior to the oral hearing.

Where permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audiotaping equipment in an unobtrusive manner.

A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be videotaped. Any motion for leave to videotape an oral hearing will be denied.

OLD EDITION

544 Motion for Reconsideration of Final Decision

37 CFR §2.129(c) Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within fifteen days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.

The filing of a request for rehearing, reconsideration, or modification of a decision issued after final hearing is governed by 37 CFR §2.129(c). Cf. 37 CFR §2.127(b), and TBMP §518.

There is no requirement that an adverse party file a brief in response to a request for rehearing, reconsideration, or modification of a decision issued after final hearing. However, it is the better practice to do so. See Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 201 USPQ 410 (TTAB 1979). If a responsive brief is filed, it must be filed within 15 days from the date of service of the request (20 days if service of the request was made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)).

Although 37 CFR §2.129(c) makes no provision for the filing of a reply brief on a request for rehearing, reconsideration, or modification of a decision issued after

final hearing, the Board may, in its discretion, consider such a brief. See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 185 USPQ 176 (TTAB 1975). Cf. TBMP §502.03, and cases cited therein.

Generally, the premise underlying a request for rehearing, reconsideration, or modification under 37 CFR §2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence (see Amoco Oil Co. v. Amerco, Inc., 201 USPQ 126 (TTAB 1978), and In re Cosmetically Yours, Inc., 171 USPQ 563 (TTAB 1971)), nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. For examples of cases in which a request for reconsideration of a decision after final hearing has been granted, see Steiger Tractor Inc. v. Steiner Corp., 3 USPQ2d 1708 (TTAB 1984), and In re Kroger Co., 177 USPQ 715 (TTAB 1973).

If a request for rehearing, reconsideration, or modification of a decision after final hearing is timely filed, the time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire two months after action on the request. See 37 CFR §2.145(d)(1), and TBMP §§902.02 and 903.04.

OLD EDITION

545 Motion for Relief From Final Judgment

FRCP 60(b) Mistakes; Inadvertence; Excusable Neglect; Newly Discovered Evidence; Fraud, etc. On motion and upon such terms as are just, the court may relieve a party or a party's legal representative from a final judgment, order, or proceeding for the following reasons: (1) mistake, inadvertence, surprise, or excusable neglect; (2) newly discovered evidence which by due diligence could not have been discovered in time to move for a new trial under Rule 59(b); (3) fraud (whether heretofore denominated intrinsic or extrinsic), misrepresentation, or other misconduct of an adverse party; (4) the judgment is void; (5) ... a prior judgment upon which [the judgment] is based has been reversed or otherwise vacated ...; or (6) any other reason justifying relief from the operation of the judgment. The motion shall be made within a reasonable time, and for reasons (1), (2), and (3) not more than one year after the judgment,

order, or proceeding was entered or taken. A motion under this subdivision (b) does not affect the finality of a judgment or suspend its operation. This rule does not limit the power of a court to entertain an independent action to relieve a party from a judgment, order, or proceeding ... or to set aside a judgment for fraud upon the court. ...

Motions to set aside or vacate a final judgment rendered by the Board are governed by FRCP 60(b). See 37 CFR §2.116(a). Thus, upon such terms as are just, the Board, on motion, may relieve a party from a final judgment for one of the reasons specified in FRCP 60(b).

FRCP 60(b), as made applicable by 37 CFR §2.116(a), applies to all final judgments issued by the Board, including default and consent judgments, summary judgments, and judgments entered after trial on the merits. As a practical matter, motions to vacate or set aside a final Board judgment are usually based upon the reasons set forth in subsections (1), (2) and/or (6) of FRCP 60(b).

For examples of cases involving a motion for relief from a final judgment of the Board, see Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc., 23 USPQ2d 1894 (TTAB 1992) (reason 6); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992) (reasons 1 and 6); Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991) (reason (1)); Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991) (reason (1)); Syosset Laboratories, Inc. v. TI Pharmaceuticals, 216 USPQ 330 (TTAB 1982) (reasons (1), (3), and (6)); Lee Byron Corp. v. H.D. Lee Co. 203 USPQ 1097 (TTAB 1979) (reason (2)); Amoco Oil Co. v. Amerco, Inc., 201 USPQ 126 (TTAB 1978) (reason (2)); Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978) (reason (1)); Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976) (reasons (1) and (6)); Williams v. Five Platters, Inc., 181 USPQ 409 (TTAB 1974), aff'd, 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (reason (1)); and Columbia Broadcasting System, Inc. v. De Costa, 165 USPQ 95 (TTAB 1970) (reason (6)). Cf. In re Sotheby's Inc., 18 USPQ2d 1969 (Comm'r 1989).

A motion for relief from judgment must be made within a reasonable time; if the motion is based on reasons (1), (2), and/or (3), it must be filed not more than one year after the judgment was entered. See FRCP 60(b); Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991); Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978); and Columbia Broadcasting System, Inc. v. De Costa, 165 USPQ 95 (TTAB 1970). The filing

OLD EDITION

of the motion will not affect the finality of the judgment or suspend its operation. See FRCP 60(b).

Relief from a final judgment is an extraordinary remedy to be granted only in exceptional circumstances. The determination of whether a motion under FRCP 60(b) should be granted is a matter which lies within the sound discretion of the Board. See: General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992), and Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991). Cf. Case v. BASF Wyandotte, 737 F.2d 1034, 222 USPQ 737 (Fed. Cir. 1984).

Where a motion for relief from judgment is made without the consent of the adverse party or parties, it must persuasively show (preferably by affidavits, declarations, documentary evidence, etc., as may be appropriate) that the relief requested is warranted for one or more of the reasons specified in FRCP 60(b).

Because default judgments for failure to timely answer the complaint are not favored by the law, a motion under FRCP 55(c) and 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are motions under FRCP 60(b) for relief from other types of judgments. See TBMP §317.03, and authorities cited therein. Among the factors to be considered in determining a motion to vacate a default judgment for failure to answer the complaint are (1) whether the plaintiff will be prejudiced, (2) whether the default was willful, and (3) whether the defendant has a meritorious defense to the action. See TBMP §317.03; Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991), and Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991). See also Waifersong Ltd. Inc. v. Classic Music Vending, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992). Cf. General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992).

If, in a cancellation proceeding, a petition to the Commissioner is filed concurrently with a FRCP 60(b) motion to the Board for relief from judgment, and the petition and motion seek the same relief and require review of the same set of facts, the Board will rule first upon the motion for relief from judgment. If the Board grants the motion, the Commissioner, as a ministerial act, will reinstate the subject registration. See National Telefilm Associates, Inc. v. Craig Denney Productions, 228 USPQ 61 (Comm'r 1985).

Where the parties are agreed that the circumstances warrant the vacating or setting aside of a final judgment, a stipulation or consented motion for relief from

OLD EDITION

the judgment should be filed. A consented request for relief from judgment ordinarily will be granted by the Board.

OLD EDITION

CHAPTER 600 WITHDRAWAL; SETTLEMENT

601 Withdrawal by Opposition or Cancellation Plaintiff

602 Withdrawal by Opposition or Cancellation Defendant

603 Withdrawal by Interference or Concurrent Use Applicant

604 Consent to Judgment

605 Settlement

606 Effect on Counterclaim

OLD EDITION

601 Withdrawal by Opposition or Cancellation Plaintiff

601.01 Withdrawal by Opposer

37 CFR §2.106(c) The opposition may be withdrawn without prejudice before the answer is filed. After the answer is filed, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative.

An opposer may withdraw its opposition without prejudice at any time before the applicant's answer thereto is filed. After the answer is filed, however, the opposition may not be withdrawn without prejudice except with the written consent of the applicant or the applicant's attorney or other authorized representative. See 37 CFR §2.106(c). See also Estee Lauder Inc. v. Aloe Creme Laboratories, Inc., 178 USPQ 254 (TTAB 1973). Cf. 37 CFR §2.114(c), and Johnson & Johnson v. Bio-Medical Sciences, Inc., 179 USPQ 765 (TTAB 1973). For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see Johnson & Johnson v. Bio-Medical Sciences, Inc., supra. Cf. Miller Brewing Co. v. Coy International Corp., 230 USPQ 675 (TTAB 1986); United States Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984); Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978); and In re Communications Technology Corp., 182 USPQ 695 (TTAB 1974).

An opposer which wishes to withdraw its opposition may do so by filing in the PTO a written withdrawal signed by the opposer or the opposer's attorney or other authorized representative. The withdrawal should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

OLD EDITION

601.02 Withdrawal by Petitioner

37 CFR §2.114(c) The petition for cancellation may be withdrawn without prejudice before the answer is filed. After the answer is filed, the petition may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative.

A petitioner may withdraw its petition for cancellation without prejudice at any time before the registrant's answer thereto is filed. After the answer is filed, however, the petition for cancellation may not be withdrawn without prejudice except with the written consent of the registrant or the registrant's attorney or other authorized representative. See 37 CFR §2.114(c), and Johnson & Johnson v. Bio-Medical Sciences, Inc., 179 USPQ 765 (TTAB 1973). Cf. 37 CFR §2.106(c), and Estee Lauder Inc. v. Aloe Creme Laboratories, Inc., 178 USPQ 254 (TTAB 1973). For information concerning the effect of a judgment entered against plaintiff for withdrawal after answer without consent, see Johnson & Johnson v. Bio-Medical Sciences, Inc., supra. Cf. Miller Brewing Co. v. Coy International Corp., 230 USPQ 675 (TTAB 1986); United States Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984); Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978); and In re Communications Technology Corp., 182 USPQ 695 (TTAB 1974).

A petitioner which wishes to withdraw its petition for cancellation may do so by filing in the PTO a written withdrawal signed by the petitioner or the petitioner's attorney or other authorized representative. The withdrawal should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

OLD EDITION

601.03 Effect of Motion for Judgment

A plaintiff in an opposition or cancellation proceeding may unilaterally withdraw its complaint without prejudice, even in the face of a defendant's motion to dismiss, motion for summary judgment, motion for judgment on the pleadings, etc., provided that the withdrawal is filed prior to answer. When a plaintiff unilaterally withdraws its complaint prior to answer in the face of a defendant's pending motion for judgment, the proceeding will be dismissed without prejudice (unless plaintiff specifies that it is withdrawing with prejudice), and the pending motion will be declared moot.

602 Withdrawal by Opposition or Cancellation Defendant

602.01 Withdrawal by Applicant

37 CFR §2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

37 CFR §2.135 Abandonment of application or mark.
After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

An applicant which wishes to expressly abandon its application may do so by filing in the PTO a written statement of abandonment or withdrawal of the application, signed by the applicant or the applicant's attorney or other authorized representative. See 37 CFR §2.68.

However, after the commencement of an opposition proceeding, if the applicant files a written abandonment of its subject application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. See 37 CFR §2.135. See also Fleming Companies Inc. v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992); Goodway Corp. v. International Marketing Group Inc., 15 USPQ2d 1749 (TTAB 1990); Grinnell Corp. v. Grinnell Concrete Pavingstones Inc., 14 USPQ2d 2065 (TTAB 1990); and In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. See 37 CFR §2.135. For information concerning the effect of a 37 CFR §2.135 judgment against applicant, see Miller Brewing Co. v. Coy International Corp., 230 USPQ 675 (TTAB 1986); United States Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984); Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978); and In re Communications Technology Corp., 182 USPQ 695 (TTAB 1974). Cf. Aromatique Inc. v. Lang, 25 USPQ2d 1359 (TTAB 1992),

OLD EDITION

and Johnson & Johnson v. Bio-Medical Sciences, Inc., 179 USPQ 765 (TTAB 1973).

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR §2.135.

An abandonment of an opposed application should be filed with the Board, and should bear at the top of its first page both the application serial number, and the opposition number and title. The abandonment should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

If an applicant files an unconsented abandonment after the commencement of an opposition, but before applicant has been notified thereof by the Board, applicant will be allowed an opportunity to obtain and submit the written consent of every adverse party, or to withdraw the abandonment and defend against the opposition, failing which judgment will be entered against applicant. See In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§218 and 307.11.

If an opposition and an unconsented abandonment of the opposed application are filed on the same day, the abandonment (unless specifically made with prejudice) is without prejudice to applicant; the opposition will be returned to the opposer; no proceeding will be instituted; and any submitted opposition fee will be refunded. See In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). Cf. TBMP §§218 and 307.11.

If it comes to the attention of the Board, after the filing of an opposition, that the opposed application was abandoned, prior to its publication for opposition, for failure of the applicant to respond to an Office action issued by the Trademark Examining Attorney, the Board will advise the parties that the application is not subject to opposition unless applicant files a petition to revive under 37 CFR §2.66, and the petition is granted. If a prior abandonment for failure to timely respond comes to the attention of the Board at a time reasonably contemporaneous with the filing of the opposition, and the application is not revived, the opposition will not be instituted; the opposition papers will be returned to the opposer; and any submitted opposition fee will be refunded. If the prior abandonment comes to the attention of the Board at a later stage in the

OLD EDITION

opposition, and the application is not revived, the opposition will be dismissed without prejudice. See Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992).

If, during the pendency of an opposition, the Board grants a request by the Trademark Examining Attorney for remand under 37 CFR §2.130 (see TBMP §515), and the application thereafter becomes abandoned, by operation of law, for failure of the applicant to respond to an Office action issued by the Examining Attorney, or because a final refusal to register issued by the Examining Attorney is affirmed on appeal, judgment under 37 CFR §2.135 will not be entered against applicant in the opposition. Rule 2.135 comes into play only when there is a written abandonment by the applicant. However, opposer will be given time in which to elect whether it wishes to go forward to obtain a determination of opposition on its merits, or to have the opposition dismissed without prejudice as moot. Cf. TBMP §602.02(b); Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989); United Rum Merchants Ltd. v. Distillers Corp. (S.A.), 9 USPQ2d 1481, 1484 (TTAB 1988); Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown, 220 USPQ 892 (TTAB 1984); and Daggett & Ramsdell, Inc. v. Procter & Gamble Co., 119 USPQ 350 (TTAB 1958), rev'd on other grounds, 275 F.2d 955, 125 USPQ 236 (CCPA 1960). If, after remand under 37 CFR §2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 CFR §2.135.

If an applicant whose application is the subject of an opposition files an abandonment of the application with the written consent of the opposer, the opposition will be dismissed without prejudice, and the application will stand abandoned. If the applicant files an abandonment of the application with the written consent of the opposer, and the opposer files a withdrawal of the opposition, the opposition will be dismissed without prejudice, and the application will stand abandoned. If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, the opposition will be dismissed without prejudice (and the application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing. See Aromatique Inc. v. Lang, 25 USPQ2d 1359 (TTAB 1992). If the applicant files an abandonment of the application with prejudice with the written consent of the opposer, and the opposer files a withdrawal of the opposition with prejudice with the written consent of the applicant, the opposition will be dismissed with prejudice, and the

OLD EDITION

application will stand abandoned with prejudice to applicant's right to reregister the same mark for the same goods or services.

602.02 Withdrawal by Respondent

602.02(a) Voluntary Surrender of Registration for Cancellation

37 CFR §2.134(a) After the commencement of a cancellation proceeding, if the respondent applies for cancellation of the involved registration under section 7(d) of the Act of 1946 without the written consent of every adverse party to the proceeding, judgment shall be entered against the respondent. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

37 CFR §2.172 Surrender for cancellation.
Upon application by the registrant, the Commissioner may permit any registration to be surrendered for cancellation. Application for such action must be signed by the registrant and must be accompanied by the original certificate of registration, if not lost or destroyed. When there is more than one class in a registration, one or more entire class but less than the total number of classes may be surrendered as to the specified class or classes. Deletion of less than all of the goods or services in a single class constitutes amendment of registration as to that class (see §2.173).

A registrant which wishes to voluntarily surrender its registration for cancellation may do so by filing in the PTO a written application therefor, signed by the registrant and accompanied by the original certificate of registration, or, if the original certificate of registration has been lost or destroyed, by a statement to that effect. See Section 7(e) of the Act, 15 U.S.C. §1057(e); 37 CFR §2.172; and TMEP §§1113.05(b) and 1607.01. There is no fee for a voluntary surrender for cancellation. See TMEP §1607.01.

However, after the commencement of a cancellation proceeding, if the respondent applies for cancellation of its subject registration under Section 7(e) of the Act without the written consent of every adverse party to the proceeding, judgment will be entered against the respondent. See 37 CFR §2.134(a). Cf. 37 CFR §2.135; Goodway Corp. v. International Marketing Group Inc., 15 USPQ2d 1749 (TTAB 1990); Grinnell Corp. v. Grinnell Concrete Pavingstones

OLD EDITION

Inc., 14 USPQ2d 2065 (TTAB 1990); and In re First National Bank of Boston, 199 USPQ 296 (TTAB 1978). The written consent of an adverse party may be signed by the adverse party itself, or by the adverse party's attorney or other authorized representative. See 37 CFR §2.134(a). For information concerning the effect of a judgment of this type, see TBMP §602.01, and cases cited therein.

In a cancellation proceeding against a registration having multiple classes, if the respondent files a request to amend the registration to delete a class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR §2.134(a).

An application for voluntary surrender of a registration which is the subject of a Board inter partes proceeding should be filed with the Board, and should bear at the top of its first page both the registration number, and the inter partes proceeding number and title. The application for voluntary surrender should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

If a registrant whose registration is the subject of a petition for cancellation files a voluntary surrender of the registration with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled. If the registrant files a voluntary surrender of the registration with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation, the petition for cancellation will be dismissed without prejudice, and the registration will be cancelled. If the registrant files a voluntary surrender of the registration with prejudice with the written consent of the petitioner, the petition for cancellation will be dismissed without prejudice (and the registration will be cancelled, such cancellation being with prejudice to registrant's right to reregister the same mark for the same goods or services), unless the parties specify otherwise in writing. If the registrant files a voluntary surrender of the registration with prejudice with the written consent of the petitioner, and the petitioner files a withdrawal of the petition for cancellation with prejudice with the written consent of the registrant, the petition for cancellation will be dismissed with prejudice, and the registration will be cancelled, such cancellation being with prejudice to registrant's right to reregister the same mark for the same goods or services.

OLD EDITION

602.02(b) Cancellation Under Section 8; Expiration Under Section 9

37 CFR §2.134(b) After the commencement of a cancellation proceeding, if it comes to the attention of the Trademark Trial and Appeal Board that the respondent has permitted his involved registration to be cancelled under section 8 of the Act of 1946 or has failed to renew his involved registration under section 9 of the Act of 1946, an order may be issued allowing respondent until a set time, not less than fifteen days, in which to show cause why such cancellation or failure to renew should not be deemed to be the equivalent of a cancellation by request of respondent without the consent of the adverse party and should not result in entry of judgment against respondent as provided by paragraph (a) of this section. In the absence of a showing of good and sufficient cause, judgment may be entered against respondent as provided by paragraph (a) of this section.

See Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989); C.H. Guenther & Son Inc. v. Whitewing Ranch Co., 8 USPQ2d 1450 (TTAB 1988); and Abraham's Seed v. John One Ten, 1 USPQ2d 1230 (TTAB 1986). Cf. In re Checkers of North America Inc., 23 USPQ2d 1451 (Comm'r 1992), and Global Maschinen GmbH v. Global Banking Systems, Inc., 227 USPQ 862 (TTAB 1985).

In a cancellation proceeding against a registration having multiple classes, if the respondent permits a class which is the subject of the cancellation proceeding to be cancelled under Section 8 of the Act, or fails to renew the registration under Section 9 of the Act with respect to that class, the cancellation or failure to renew with respect to that class is governed by 37 CFR §2.134(b).

An order to show cause under 37 CFR §2.134(b) may be issued by the Board upon motion by the petitioner, or (if the failure to file a Section 8 or Section 9 affidavit comes to the attention of the Board in another manner) upon the Board's own initiative. For information concerning motions for an order to show cause under 37 CFR §2.134(b), see TBMP §536.

The purpose of 37 CFR §2.134(b) is to prevent a cancellation proceeding respondent whose subject registration comes due, during the course of the proceeding, for a Section 8 or Section 9 affidavit, from being able to moot the proceeding, and avoid judgment, by deliberately failing to file the required affidavit of use under Section 8, or renewal application under Section 9. See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23126, and in the Official Gazette of June 21, 1983 at 1031

OLD EDITION

TMOG 13, 17; and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 277 (1984).

The Board's policy governing application of 37 CFR §2.134(b) is as follows:

> The paragraph has been modified to provide an opportunity for the respondent in such situation to "show cause" why judgment should not be entered against it. If respondent submits a showing that the cancellation or expiration was the result of an inadvertance or mistake, judgment will not be entered against it. If respondent submits a showing that the cancellation or expiration was occasioned by the fact that its registered mark had been abandoned and that such abandonment was not made for purposes of avoiding the proceeding but rather was the result, for example, of a two-year period of nonuse which commenced well before respondent learned of the existence of the proceeding, judgment will be entered against it only and specifically on the ground of abandonment.

OLD EDITION

See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23133, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 23. See also Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989); C.H. Guenther & Son Inc. v. Whitewing Ranch Co., 8 USPQ2d 1450 (TTAB 1988); Abraham's Seed v. John One Ten, 1 USPQ2d 1230 (TTAB 1986); and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 277 (1984).

If, in response to an order to show cause issued under 37 CFR §2.134(b), a respondent submits a showing that the cancellation of its registration under Section 8 of the Act, or failure to renew the registration under Section 9 of the Act, was the result of inadvertance or mistake, judgment will not be entered against it. See: Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23133, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 23; C.H. Guenther & Son Inc. v. Whitewing Ranch Co.,

8 USPQ2d 1450 (TTAB 1988); and Abraham's Seed v. John One Ten, 1 USPQ2d 1230 (TTAB 1986).

If respondent submits a showing that it permitted its registration to be cancelled under Section 8 of the Act, or failed to renew the registration under Section 9 of the Act, because its registered mark had been abandoned, and that the abandonment was not made for purposes of avoiding the proceeding, judgment will be entered against it only and specifically on the ground of abandonment (if abandonment has not been pleaded as a ground for cancellation, plaintiff will be allowed to amend its pleading appropriately). See: Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23133, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 23, and Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989).

In those cases where the Board finds that respondent has shown good and sufficient cause why judgment should not be entered against it under 37 CFR §2.134(b), petitioner will be given time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. See C.H. Guenther & Son Inc. v. Whitewing Ranch Co., 8 USPQ2d 1450 (TTAB 1988); and Abraham's Seed v. John One Ten, 1 USPQ2d 1230 (TTAB 1986). In those cases where the Board enters judgment against the respondent only and specifically on the ground of abandonment, petitioner will be given time in which to elect whether it wishes to go forward to obtain a determination of the remaining issues, or to have the cancellation proceeding dismissed without prejudice as to those issues. See Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989). Cf., with respect to the Board's election practice, United Rum Merchants Ltd. v. Distillers Corp. (S.A.), 9 USPQ2d 1481, 1484 (TTAB 1988); Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown, 220 USPQ 892 (TTAB 1984); and Daggett & Ramsdell, Inc. v. Procter & Gamble Co., 119 USPQ 350 (TTAB 1958), rev'd on other grounds, 275 F.2d 955, 125 USPQ 236 (CCPA 1960).

As noted above, the purpose of 37 CFR §2.134(b) is to prevent a cancellation proceeding respondent from being able to moot the proceeding, and avoid judgment, by deliberately failing to file a required affidavit of use under Section 8, or renewal application under Section 9. The rule provides not that an order to show cause "shall" be issued, but rather that an order "may" be issued. Normally, the Board, in the exercise of its discretion under the rule, does not issue a show cause order in those cases where the failure to file a required affidavit under

OLD EDITION

Section 8, or renewal application under Section 9, occurs after the filing of a petition for cancellation, but before respondent has been notified thereof by the Board. Rather, the Board issues an action notifying respondent of the filing of the proceeding, advising both parties that the registration has been cancelled under Section 8, or has expired, and allowing petitioner time in which to elect whether it wishes to go forward with the cancellation proceeding, or to have the cancellation proceeding dismissed without prejudice as moot. Cf. TBMP §602.01. However, a petitioner which believes that the respondent had knowledge of the filing of the petition to cancel (notwithstanding the fact that respondent had not been notified thereof by the Board), and that respondent deliberately failed to file a required affidavit of use under Section 8, or renewal application under Section 9, in an effort to moot the proceeding, and avoid judgment, may file a motion for an order to show cause under 37 CFR §2.134(b) (see TBMP §536), stating the reasons for its belief.

OLD EDITION

603 Withdrawal by Interference or Concurrent Use Applicant

37 CFR §2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

37 CFR §2.135 Abandonment of application or mark.
After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding, judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

After the commencement of an interference or concurrent use proceeding, if an applicant whose application is a subject of the proceeding files a written abandonment of its application or mark without the written consent of every

adverse party to the proceeding, judgment will be entered against the applicant. See 37 CFR §2.135.

If, after the commencement of a concurrent use proceeding involving two or more applicants, one of the applicants files an unconsented abandonment of its application, but not of its use of its mark, judgment will be entered against that applicant with respect to the registration sought by it. However, if the abandoning applicant is specified as an excepted concurrent user in any other application involved in the proceeding, the abandoning applicant will remain a party to the proceeding as a concurrent user, and every other applicant to the proceeding who, in its own application, has listed that party as an excepted user will retain the burden of proving its entitlement to registration in view of the acknowledged rights of the abandoning applicant. See Fleming Companies Inc. v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992), and Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984). Cf. 37 CFR §2.99(d)(3), and Precision Tune Inc. v. Precision Auto-Tune Inc., 4 USPQ2d 1095 (TTAB 1987). On the other hand, if a party to a concurrent use proceeding abandons all rights in its mark and in its application (if any), any remaining party which seeks concurrent registration may move to amend its application to delete the abandoning party as an excepted user. If the abandoning party is the only excepted user specified in a remaining party's application, the remaining party may move to amend its application to seek a geographically unrestricted registration. See Newsday, Inc. v. Paddock Publications, Inc., supra. If the motion is granted, the concurrent use proceeding will be dissolved without prejudice, and the application will be republished, for purposes of opposition, as an application for a geographically unrestricted registration.

If an application which is the subject of an interference or concurrent use proceeding has multiple classes, and the applicant files a request to amend the application to delete a class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR §2.135.

An abandonment of an application which is the subject of an interference or concurrent use proceeding should be filed with the Board, and should bear at the top of its first page both the application serial number, and the interference or concurrent use proceeding number and title. The abandonment should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

OLD EDITION

If, during the pendency of an interference or concurrent use proceeding, the Board grants a request by the Trademark Examining Attorney for remand under 37 CFR §2.130 (see TBMP §515), and the application thereafter becomes abandoned, by operation of law, for failure of the applicant to respond to an Office action issued by the Examining Attorney, or because a final refusal to register issued by the Examining Attorney is affirmed on appeal, judgment under 37 CFR §2.135 will not be entered against applicant in the interference, or in the concurrent use proceeding. Rule 2.135 comes into play only when there is a written abandonment by the applicant. If, after remand under 37 CFR §2.130, applicant files a written abandonment of its application without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant pursuant to 37 CFR §2.135.

604 Consent to Judgment

If a party to an inter partes proceeding before the Board does not wish to litigate the case, and is willing to accept entry of judgment against itself, the party may file a statement with the Board indicating that it consents to entry of judgment against itself. Upon receipt of such a statement, the Board will enter judgment against the filing party.

605 Settlement

605.01 In General

A substantial percentage of the inter partes cases filed with the Board are eventually settled. The Board encourages settlement, and several aspects of Board practice and procedure, including its liberal discovery practice (see TBMP chapter 400) and its usual willingness to suspend proceedings in pending cases while parties negotiate for settlement (see TBMP §§510.03 and 605.02), serve to facilitate the resolution of cases by agreement.

605.02 Suspension for Settlement Negotiations

OLD EDITION

Parties which are negotiating for settlement, and wish to defer further litigation of the case pending conclusion of their negotiations, should remember to file stipulations to extend or suspend the running of the time periods set in the case.

When the Board is notified that parties are negotiating for settlement, the Board may suspend proceedings for a period of up to six months, subject to the right of either party to request resumption at any time prior to the expiration of the suspension period. See TBMP §510.03. The suspension period may be further extended upon request, or upon notification to the Board that the parties are still engaged in their settlement negotiations.

OLD EDITION

605.03 Settlement Agreements

605.03(a) In General

When an inter partes proceeding before the Board is settled, the parties thereto should notify the Board of the settlement promptly. It is not necessary that the parties file a copy of their settlement agreement with the Board. Rather, they may simply file a stipulation stating the desired disposition of the proceeding (i.e., "It is hereby stipulated that the opposition be sustained," "It is hereby stipulated that the petition for cancellation be dismissed with prejudice," or whatever). If there is a counterclaim, the stipulation should also state the desired disposition of the counterclaim. If, in a proceeding with a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, but there is no stipulation to dispose of the counterclaim, and there is no withdrawal of the counterclaim, consent by one party to entry of judgment against itself on the counterclaim, etc., the counterclaim will go forward, notwithstanding the fact that judgment has been entered on the original claim. See TBMP §606.

If the proceeding is to be dismissed, the stipulation should specify whether the dismissal is to be with prejudice or without prejudice. If no specification is made, the Board, in its action dismissing the proceeding, will simply state that the proceeding is being dismissed "in accordance with the agreement of the parties." However, if the agreement itself also fails to indicate whether the dismissal is to be with or without prejudice, at some later time a dispute may arise between the parties as to whether they intended the dismissal to be with or

without prejudice. A clear specification in the stipulation will avoid any such future trouble.

A settlement stipulation which is not in accordance with the applicable rules and the statute will be given no effect by the Board.

A settlement agreement may simply call for a party to withdraw with, or without, prejudice, or with, or without, consent. In such a case, the parties need not file a settlement stipulation, because the withdrawal, when filed, will result in a final disposition of the proceeding.

605.03(b) With Amendment of Subject Application or Registration

If a settlement agreement is contingent upon the amendment of a defendant's subject application or registration, the request for amendment is governed by 37 CFR §2.133(a) (see TBMP §514), and should be filed with the Board. The request should bear at its top both the number of the subject application or registration, and the Board proceeding number and title. The request also should include proof of service thereof upon every other party to the proceeding. See 37 CFR §2.119(a), and TBMP §113.

A proposed amendment to a defendant's application or registration must comply with all applicable rules and statutory provisions. See TBMP §514.01. Thus, for example, a proposed amendment which materially alters the character of the defendant's subject mark cannot be appoved. See Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §§2.72 and 2.173. If a settlement agreement calls for an amendment which may amount to a material change in the defendant's mark, the parties may wish to also agree that if a request for amendment of the defendant's subject application or registration is denied by the Board, the defendant will abandon that application, or voluntarily surrender that registration, and file a new application for registration of the altered mark; and that the plaintiff will not oppose the new application or seek to cancel any registration that matures therefrom. The abandonment or voluntary surrender, if necessary, would, of course, be governed by 37 CFR §2.135 or 37 CFR §2.134(a), respectively. See TBMP §602.

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class, the request for

OLD EDITION

amendment is, in effect, an abandonment of the application with respect to that class, and is governed by 37 CFR §2.135. Similarly, in a cancellation proceeding against a registration having multiple classes, if the respondent files a request to amend the registration to delete a class sought to be cancelled, the request for amendment is, in effect, a voluntary surrender of the registration with respect to that class, and is governed by 37 CFR §2.134(a).

605.03(c) With Amendment of Plaintiff's Pending Application

The plaintiff in an inter partes proceeding before the Board may own a pending application for registration which has been rejected by the Trademark Examining Attorney in view of the defendant's subject registration, or which is going to be rejected by the Examining Attorney when and if defendant's subject application matures to registration. In such a case, a settlement agreement may be contingent upon the approval of an amendment to be filed in the plaintiff's application, or acceptance of a consent agreement to be filed therein, and the consequent approval of the application for publication.

The Board has no jurisdiction over a plaintiff's application which is still pending before the Trademark Examining Attorney. See Home Juice Co. v. Runglin Cos., 231 USPQ 897, 898, at fn.7 (TTAB 1986). Thus, when the plaintiff in an inter partes proceeding before the Board owns an application which is still pending before the Trademark Examining Attorney, and an amendment or consent agreement is filed in the application pursuant to a settlement agreement between the parties, the amendment should be filed with the Examining Attorney, not with the Board. The Examining Attorney can and should consider the amendment or agreement and take appropriate action with respect thereto (including, if the amendment or consent agreement puts the application in condition for publication, approving the application for publication), notwithstanding the fact that action on the application may previously have been suspended pending the final determination of the inter partes proceeding before the Board. Indeed, if settlement of the inter partes proceeding is contingent upon approval of the amendment, or acceptance of the consent agreement, by the Examining Attorney, proceedings before the Board may be suspended pending action by the Examining Attorney on the amendment or consent agreement.

OLD EDITION

605.03(d) Breach of Settlement Agreement

If an agreement settling an inter partes proceeding before the Board is breached by one of the parties thereto, an adverse party's remedy is by way of civil action. The Board has no jurisdiction to enforce such an agreement.

605.03(e) Effect of Judgment Based Upon Agreement

For information concerning the effect of agreements and judgments resulting therefrom, see Kimberly-Clark Corp. v. Fort Howard Paper Co., 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985); Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd., 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984); Wells Cargo, Inc. v. Wells Cargo, Inc., 606 F.2d 961, 203 USPQ 564 (CCPA 1979); Danskin, Inc. v. Dan River, Inc., 498 F.2d 1386, 182 USPQ 370 (CCPA 1974); United States Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984); and Marc A. Bergsman, TIPS FROM THE TTAB: The Effect of Board Decisions in Civil Actions; Claim Preclusion and Issue Preclusion in Board Proceedings, 80 Trademark Rep. 540 (1990). See also Epic Metals Corp. v. H.H. Robertson Co., 870 F.2d 1574, 10 USPQ2d 1296 (Fed. Cir. 1989), and Hartley v. Mentor Corp., 869 F.2d 1469, 10 USPQ2d 1138 (Fed. Cir. 1989).

605.03(f) Consent Orders

The Board will dismiss, sustain, etc., a Board inter partes proceeding, if the parties thereto so stipulate (see TBMP §605.03(a)), and will also enter judgment against a party which submits its written consent to entry of judgment against itself, or which concedes that its case is not well taken. Further, the Board encourages the use of stipulated evidence in Board inter partes proceedings. See 37 CFR §2.123(b), and TBMP §716. However, the Board does not issue advisory opinions. Nor does the Board issue consent orders. That is, the Board does not, based simply upon a joint request by the parties that it do so, enter, approve, or otherwise adopt as its own findings, as if on the merits, stipulated findings of fact and/or conclusions of law, without any consideration by the Board of evidence properly adduced during the course of the proceeding. Rather, the Board makes findings of fact, and conclusions of law, on the merits

OLD EDITION

of the case only as warranted by the evidence of record upon motion for summary judgment or at final hearing.

606 Effect on Counterclaim

If, prior to the determination of a counterclaim, the parties stipulate to the disposition of the claim against which the counterclaim was brought, or the original claim is withdrawn, dismissed for failure to prosecute, or otherwise disposed of, the counterclaim will nevertheless go forward, unless the parties stipulate to its disposition, or it is withdrawn by the counterclaimant, or one party consents to entry of judgment against itself on the counterclaim, etc. See, for example, Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 USPQ2d 1879 (TTAB 1990). Cf. TBMP §901.02(a).

OLD EDITION

CHAPTER 700 INTRODUCTION OF EVIDENCE

701 Time of Trial

702 Manner of Trial

703 Applications and Registrations

704 Statements and Things in Application or Registration

705 Exhibits to Pleadings or Briefs

706 Statements in Pleadings or Briefs

707 Official Records

708 Printed Publications

709 Discovery Depositions

710 Interrogatory Answers; Admissions

711 Produced Documents

712 Judicial Notice

713 Oral Depositions

714 Depositions Upon Written Questions

715 Testimony From Another Proceeding

716 Stipulated Evidence

717 Noncomplying Evidence

718 Objections to Evidence

OLD EDITION

701 Time of Trial

37 CF R §2.116(b) The opposer in an opposition proceeding or the petitioner in a cancellation proceeding shall be in the position of plaintiff, and the applicant in an opposition proceeding or the respondent in a cancellation proceeding shall be in the position of defendant. A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

(c) The opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.

(d) The assignment of testimony periods corresponds to setting a case for trial in court proceedings.

(e) The taking of depositions during the assigned testimony periods corresponds to the trial in court proceedings.

37 CF R §2.121 Assignment of times for taking testimony.
(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. The resetting of the closing date for discovery will result in the rescheduling of the testimony periods without action by any party. The resetting of a party's time to respond to an outstanding request for discovery will not result in the automatic rescheduling of the discovery and/or testimony periods; such dates will be rescheduled only upon stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board.

(2) The initial trial order will be mailed by the Board after issue is joined.

(b)(1) The Trademark Trial and Appeal Board will schedule a testimony period for the plaintiff to present its case in chief, a testimony period for the defendant to present its case and to meet the case of the plaintiff, and a testimony period for the plaintiff to present evidence in rebuttal.

OLD EDITION

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings. or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Board will schedule testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal.

(c) A testimony period which is solely for rebuttal will be set for fifteen days. All other testimony periods will be set for thirty days. The periods may be extended by stipulation of the parties approved by the Trademark Trial and Appeal Board, or upon motion granted by the Board, or by order of the Board.

When a defendant's answer to a complaint is received by the Board, the Board prepares and mails to the parties a trial order setting the closing date of the discovery period, and assigning each party's time for taking testimony and introducing other evidence. See 37 CFR §§2.120(a), 2.121(a)(1), and 2.121(a)(2), and TBMP §403.01. Specifically, the Board schedules a 30-day testimony period for the plaintiff to present its case in chief, a 30-day testimony period for the defendant to present its case and to meet the case of the plaintiff, and a 15-day testimony period for the plaintiff to present rebuttal evidence. See 37 CFR §§2.121(b)(1) and 2.121(c). The plaintiff's period for presenting its case in chief is scheduled to open 30 days after the close of the discovery period; the defendant's testimony period is scheduled to open 30 days after the close of the plaintiff's testimony period in chief; and the plaintiff's rebuttal testimony period is scheduled to open 30 days after the close of the defendant's testimony period. See Stagecoach Properties, Inc. v. Wells Fargo & Co., 199 USPQ 341, 356 (TTAB 1978), aff'd, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982).

If there is a counterclaim, or if proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or if there is an interference or a concurrent use registration proceeding involving more than two parties, the Board schedules testimony periods as specified in 37 CFR §2.121(b)(2), i.e., giving each plaintiff a period for presenting its case in chief as against each defendant, giving each defendant a period for presenting its case and meeting the case of each plaintiff,

OLD EDITION

and giving each plaintiff a period for rebuttal. The testimony periods are separated from the discovery period and from each other by 30-day intervals. See 37 CFR §§2.121(b)(2) and 2.121(c); Jan Bell Marketing Inc. v. Centennial Jewelers Inc., 19 USPQ2d 1636 (TTAB 1990) (example of a trial order, including a briefing schedule, in an opposition with a counterclaim); TBMP §1007 (example of a trial order, including a briefing schedule, in an interference proceeding); and TBMP §1108 (examples of trial orders, including briefing schedules, in concurrent use proceedings). In an interference or concurrent use proceeding, a junior party is in the position of plaintiff and a senior party is in the position of defendant. See 37 CFR §§2.96 and 2.99(e), and TBMP §§1005 and 1007.

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. See 37 CFR §2.121(a)(1). See also M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990); Maytag Co. v. Luskin's, Inc., 228 USPQ 747 (TTAB 1986); and Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861, 867 (TTAB 1979). Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

Testimony periods may be rescheduled, extended, or reopened by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §§2.121(a)(1) and 2.121(c); FRCP 6(b); and TBMP §§501 and 509. It is preferable, where an unconsented motion seeks an extension or a reopening of a testimony period or periods, or of the discovery period and testimony periods, that the motion request that the new period or periods be set to run from the date of the Board's decision on the motion. See TBMP §509.02.

The resetting of the closing date for discovery results in the automatic rescheduling of the testimony periods, without action by any party. However, the resetting of a party's time to respond to an outstanding request for discovery does not result in the automatic rescheduling of the discovery and/or testimony periods. When a party's time to respond to an outstanding request for discovery is reset, the discovery and/or testimony periods will be rescheduled only upon

OLD EDITION

stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a)(1).

In Board inter partes proceedings, the taking of testimony depositions during the assigned testimony periods corresponds to the trial in court proceedings, and the trial period commences with the opening of the first testimony period. See TBMP §504.01, and authorities cited therein. Cf. TBMP §528.02.

702 Manner of Trial

Because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. See Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988), and La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976). Cf. TBMP §§102.03 and 502.01. For example, proceedings before the Board are conducted in writing, and the Board's actions in a particular case are based upon the written record therein. See 37 CFR §1.2. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board. See Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991), and La Maur, Inc. v. Bagwells Enterprises, Inc., supra.

Depositions may be noticed for any reasonable place in the United States. See 37 CFR §2.123(c). As a result, parties do not have to travel to the offices of the Board, or to the geographical area surrounding the Board's offices, to take their testimony. A party to a proceeding before the Board need never come to the offices of the Board at all, unless the party wishes to argue its case at oral hearing (and an oral hearing is held only if requested by a party to the proceeding--see 37 CFR §2.129(a)).

For a discussion concerning the general nature of trials in proceedings before the Board, see Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861, 867 (TTAB 1979); La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976); and Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976).

OLD EDITION

The papers and other materials filed with the Board during the course of an inter partes proceeding are kept, during the course of the proceeding, in the physical possession of the Board. See TBMP §120. However, no paper, document, exhibit, etc. will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules. See 37 CFR §2.123(l), and TBMP §717. The provisions of those rules are described below.

703 Applications and Registrations

703.01 Subject of Proceeding

37 CFR 2.122(b) Application files. (1) The file of each application or registration specified in a declaration of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.

(2) The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.

The file of an application or registration which is the subject of a Board inter partes proceeding forms part of the record of the proceeding without any action by the parties, and reference may be made to the file by any party for any relevant and competent purpose. See 37 CFR §2.122(b)(1). See also Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984); Cleveland-Detroit Corp. v. Comco (Machinery) Ltd., 277 F.2d 958, 125 USPQ 586 (CCPA 1960); and Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

However, the fact that the subject application or registration file is automatically part of the record in a proceeding does not mean that the allegations made, and

OLD EDITION

the specimens, documents, exhibits, etc. filed, therein are evidence on behalf of the applicant or registrant in the inter partes proceeding. Allegations must be established by competent evidence properly adduced at trial, and the specimens, documents, exhibits, etc. in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period. See 37 CFR §2.122(b)(2). See also TBMP §704. For further information concerning the probative value of applications and registrations, see TBMP §§703.02 and 703.03.

703.02 Registration Not Subject of Proceeding

703.02(a) Registration Owned by Party

37 CFR §2.122(d) Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see §2.6(n).

(2) A registration owned by any party to a proceeding may be made of record in the proceeding by that party by appropriate identification and introduction during the taking of testimony or by filing a notice of reliance, which shall be accompanied by a copy of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party which owns a subsisting Federal registration of its mark, and wishes to rely upon the registration in an inter partes proceeding before the Board (the registration not being the subject of the proceeding), may make the registration of record by offering evidence sufficient to establish that the registration is still subsisting, and that it is owned by the party which seeks to rely upon it. See Alcan Aluminum Corp. v. Alcar Metals Inc., 200 USPQ 742 (TTAB 1978); Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977); and Peters Sportswear Co. v. Peter's Bag Corp., 187 USPQ 647 (TTAB 1975). This may be done in a number of different ways.

OLD EDITION

A Federal registration owned by the plaintiff in an opposition or cancellation proceeding, and pleaded by the plaintiff in its complaint, will be received in evidence and made part of the record in the proceeding if the complaint (either as originally filed or as amended) is accompanied by two copies of the registration prepared and issued by the PTO showing both the current status of and current title to the registration. See 37 CFR §2.122(d)(1). See also Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 USPQ2d 1487 (TTAB 1990); Floralife, Inc. v. Floraline International Inc., 225 USPQ 683 (TTAB 1984); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc., 213 USPQ 591 (TTAB 1980); Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144 (TTAB 1979); Vita-Pakt Citrus Products Co. v. Cerro, 195 USPQ 78 (TTAB 1977); Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977); Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976); American Manufacturing Co., v. Phase Industries, Inc., 192 USPQ 498 (TTAB 1976); West Point-Pepperell, Inc. v. Borlan Industries Inc., 191 USPQ 53 (TTAB 1976); O. M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976); Fort Howard Paper Co. v. Georgia-Pacific Corp., 189 USPQ 537 (TTAB 1975); Peters Sportswear Co. v. Peter's Bag Corp., 187 USPQ 647 (TTAB 1975); and A.R.A. Manufacturing Co. v. Equipment Co., 183 USPQ 558 (TTAB 1974). Cf. Hollister Inc. v. Downey, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977).

NOTE: Although some of the cases cited in this TBMP section indicate that a plaintiff may also make its pleaded registration of record by filing, with its complaint, an order for two status and title copies of the registration, that is no longer true. See 37 CFR §2.122(d); Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, and in the Patent and Trademark Office Official Gazette of June 21, 1983 at 1031 TMOG 13; and In re Inter-State Oil Co., 219 USPQ 1229 (TTAB 1983).

A Federal registration owned by any party to a Board inter partes proceeding will be received in evidence and made part of the record in the proceeding if that party files, during its testimony period, a notice of reliance on the registration, accompanied by a copy of the registration prepared and issued by the PTO showing both the current status of and current title to the registration. See 37 CFR §2.122(d)(2). See also Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Weyerhaeuser Co. v. Katz, 24

OLD EDITION

USPQ2d 1230 (TTAB 1992); Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992); Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990); Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530 (TTAB 1986); Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329 (TTAB 1979); Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979); and W. R. Grace & Co. v. Red Owl Stores, Inc., 181 USPQ 118 (TTAB 1973).

A party's submission, with a notice of reliance upon its registration, of an order for status and title copies of the registration is not sufficient to make the registration of record. The notice of reliance must be accompanied by the status and title copies themselves. See Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992). However, the status and title copies need not be certified. See 37 CFR §2.122(e).

The registration copies "prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration," as contemplated by 37 CFR §2.122(d), are printed copies of the registration in question whereon the PTO has entered the information it has in its records, at the time of the preparation and issuance of the status and title copies, pertaining to the current status and title of the registration, including information relating to renewal; cancellation; publication under Section 12(c) of the Act, 15 U.S.C. §1062(c); affidavits or declarations under Sections 8 and 15 of the Act, 15 U.S.C. §§1058 and 1065; and recorded documents transferring title. See Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983), and Peters Sportswear Co. v. Peter's Bag Corp., 187 USPQ 647 (TTAB 1975). Plain copies of the registration, and the electronic equivalent thereof, i.e., printouts of the registration from the electronic records of the PTO's trademark automated search system, known as "X-Search," are not sufficient for the purpose. See, for example, Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); and Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977).

Although the status and title copies need not be certified (see 37 CFR §2.122(e)), at present all status and title copies prepared and issued by the PTO are certified. For the cost of a copy of a registration showing status and title, see 37 CFR §2.6(b)(4).

OLD EDITION

The issuance date of status and title copies filed with a complaint must be reasonably contemporaneous with the filing date of the complaint. Status and title copies filed under a notice of reliance during the offering party's testimony period must have been issued at a time reasonably contemporaneous with the filing of the complaint, or thereafter. See Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992); Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 USPQ2d 1487 (TTAB 1990); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144 (TTAB 1979); Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979); and Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976). The fact that there have been no changes in the status and title of a party's registration since the date of its issuance does not mean that a plain photocopy thereof may be used by the party as a substitute for the status and title copy required by 37 CFR §2.122(d). See Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977); and Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976).

When it comes to the attention of the Board that there has been a PTO error in the preparation of a registration status and title copy made of record in an inter partes proceeding, that is, that the status and title copy does not accurately reflect the status and title information which the PTO has in its records, the Board will take judicial notice of the correct facts as shown by the records of the PTO. See Duffy-Mott Co. v. Borden, Inc., 201 USPQ 846 (TTAB 1978). Cf. Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979). Further, when a Federal registration owned by a party has been properly made of record in an inter partes proceeding, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board, in deciding the case, will take judicial notice of, and rely upon, the current status of the registration, as shown by the records of the PTO. See Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144 (TTAB 1979); Duffy-Mott Co. v. Borden, Inc., 201 USPQ 846 (TTAB 1978); and Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979).

A Federal registration owned by any party to a Board inter partes proceeding may be made of record by that party by appropriate identification and introduction during the taking of testimony, that is, by introducing a copy of the registration as an exhibit to testimony, made by a witness having knowledge of the current

OLD EDITION

status and title of the registration, establishing that the registration is still subsisting, and is owned by the offering party. See 37 CFR §2.122(d)(2). See also Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991); Floralife, Inc. v. Floraline International Inc., 225 USPQ 683 (TTAB 1984); Cadence Industries Corp. v. Kerr, 225 USPQ 331 (TTAB 1985); Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc., 213 USPQ 591 (TTAB 1980); Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329 (TTAB 1979); Alcan Aluminum Corp. v. Alcar Metals Inc., 200 USPQ 742 (TTAB 1978); Groveton Papers Co. v. Anaconda Co., 197 USPQ 576 (TTAB 1977); Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977); GAF Corp. v. Anatox Analytical Services, Inc., 192 USPQ 576 (TTAB 1976); American Manufacturing Co., v. Phase Industries, Inc., 192 USPQ 498 (TTAB 1976); and West Point-Pepperell, Inc. v. Borlan Industries Inc., 191 USPQ 53 (TTAB 1976).

A Federal registration owned by a plaintiff (including a counterclaimant) will be deemed by the Board to be of record in an inter partes proceeding if the defendant's answer to the complaint contains admissions sufficient for the purpose. See Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991), and Tiffany & Co. v. Columbia Industries, Inc., 455 F.2d 582, 173 USPQ 6 (CCPA 1972). Similarly, a registration owned by any party to the proceeding may be deemed by the Board to be of record in the proceeding, even though the registration was not properly introduced in accordance with the applicable rules, if the adverse party in its brief, or otherwise, treats the registration as being of record. See Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 USPQ 221 (CCPA 1974); Local Trademarks Inc. v. Handy Boys Inc., 16 USPQ2d 1156 (TTAB 1990); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); American Standard Inc. v. Scott & Fetzer Co., 200 USPQ 457 (TTAB 1978); Jockey International, Inc. v. Frantti, 196 USPQ 705 (TTAB 1977); Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976); and West Point-Pepperell, Inc. v. Borlan Industries Inc., 191 USPQ 53 (TTAB 1976). Finally, a registration owned by any party to the proceeding may be made of record in the proceeding by stipulation of the parties. See 37 CFR §2.123(b); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); and Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979).

When a subsisting registration upon the Principal Register has been properly made of record by its owner in a Board inter partes proceeding, the certificate of registration is entitled to certain statutory evidentiary presumptions. See, for

OLD EDITION

example, Section 7(b) of the Act, 15 U.S.C. §1057(b); CTS Corp. v. Cronstoms Manufacturing, Inc., 515 F.2d 780, 185 USPQ 773 (CCPA 1975); Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974); In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986); Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976); David Crystal, Inc. v. Glamorise Foundations, Inc., 189 USPQ 740 (TTAB 1975); Johnson & Johnson v. E. I. du Pont de Nemours & Co., 181 USPQ 790 (TTAB 1974); and Gates Rubber Co. v. Western Coupling Corp., 179 USPQ 186 (TTAB 1973). See also Section 7(c) of the Act, 15 U.S.C. §1057(c) (conferring, contingent on the registration of a mark on the Principal Register, and subject to certain specified exceptions, constructive use priority dating from the filing of the application for registration of the mark); Jimlar Corp. v. Army and Air Force Exchange Service, 24 USPQ2d 1216, at fn.5 (TTAB 1992); and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991)..

In contrast, a subsisting registration on the Supplemental Register, even when properly made of record by its owner, is not entitled to any statutory presumptions, and is not evidence of anything except that the registration issued. See McCormick & Co. v. Summers, 354 F.2d 668, 148 USPQ 272 (CCPA 1966); In re Medical Disposables Co., 25 USPQ2d 1801 (TTAB 1992); Copperweld Corp. v. Arcair Co., 200 USPQ 470 (TTAB 1978); Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976); Aloe Creme Laboratories, Inc. v. Johnson Products Co., 183 USPQ 447 (TTAB 1974); Nabisco, Inc. v. George Weston Ltd., 179 USPQ 503 (TTAB 1973); and Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc., 168 USPQ 246 (TTAB 1970).

Although an expired or cancelled registration may be made of record by any of the methods described above, such a registration is not evidence of anything except that the registration issued; it is not evidence of any presently existing rights in the mark shown in the registration, or that the mark was ever used. See Sunnen Products Co. v. Sunex International Inc., 1 USPQ2d 1744 (TTAB 1987); United States Shoe Corp. v. Kiddie Kobbler Ltd., 231 USPQ 815 (TTAB 1986); Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc., 191 USPQ 292 (TTAB 1976); Bonomo Culture Institute, Inc. v. Mini-Gym, Inc., 188 USPQ 415 (TTAB 1975); Borden, Inc. v. Kerr-McGee Chemical Corp., 179 USPQ 316 (TTAB 1973), aff'd without opinion, 500 F.2d 1407, 182 USPQ 307 (CCPA 1974); Unitec Industries, Inc. v. Cumberland Corp., 176 USPQ 62 (TTAB 1972); and Monocraft, Inc. v. Leading Jewelers Guild, 173 USPQ 506 (TTAB 1972).

OLD EDITION

A state registration owned by a party to a Board inter partes proceeding may be made of record therein by notice of reliance under 37 CFR §2.122(e) (see TBMP §707), or by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. However, a state registration (whether owned by a party, or not) is incompetent to establish that the mark shown therein has ever been used, or that the mark is entitled to Federal registration. See, for example, Faultless Starch Co. v. Sales Producers Associates, Inc., 530 F.2d 1400, 189 USPQ 141 (CCPA 1976); Kraft, Inc. v. Balin, 209 USPQ 877 (TTAB 1981); Plak-Shack, Inc. v. Continental Studios of Georgia, Inc., 204 USPQ 242 (TTAB 1979); Stagecoach Properties, Inc. v. Wells Fargo & Co., 199 USPQ 341, 356 (TTAB 1978), aff'd, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982); Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc., 199 USPQ 307 (TTAB 1978); Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976); State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc., 190 USPQ 25 (TTAB 1976); Old Dutch Foods, Inc. v. Old Dutch Country House, Inc., 180 USPQ 659 (TTAB 1973); and Philip Morris Inc. v. Liggett & Myers Tobacco Co., 139 USPQ 240 (TTAB 1963). Cf. In re Anania Associates, Inc., 223 USPQ 740 (TTAB 1984); In re Tilcon Warren, Inc., 221 USPQ 86 (TTAB 1984); and In re Illinois Bronze Powder & Paint Co., 188 USPQ 459 (TTAB 1975).

A foreign registration owned by a party to a Board inter partes proceeding may be made of record in the same manner as a state registration, but a foreign registration is not evidence of the use, registrability, or ownership of the subject mark in the United States. See Societe Anonyme Marne et Champagne v. Myers, 250 F.2d 374, 116 USPQ 153 (CCPA 1957); Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp., 6 USPQ2d 1610 (TTAB 1988); Nabisco, Inc. v. George Weston Ltd., 179 USPQ 503 (TTAB 1973); and Barash Co. v. Vitafoam Ltd., 155 USPQ 267 (TTAB 1967), aff'd, 427 F.2d 810, 166 USPQ 88 (CCPA 1970). Cf. In re Hag Aktiengesellschaft, 155 USPQ 598 (TTAB 1967).

NOTE: If a party to a Board inter partes proceeding owns a registration which is not the subject of the proceeding, and wishes to make of record the registration file history (rather than just the certificate of registration), or a portion thereof, the party may do so by filing, during its testimony period, a copy of the file history, or the portion thereof, together with a notice of reliance thereon pursuant to 37 CFR §2.122(e) (see TBMP §707); or by appropriate identification and introduction of a copy of the file history, or portion thereof, during the taking of

OLD EDITION

testimony; or by stipulation of the parties, accompanied by a copy of the file history, or portion thereof. The file history of a registration owned by another party, but not the subject of the proceeding, may be made of record in the same manner. See Harzfeld's, Inc. v. Joseph M. Feldman, Inc., 184 USPQ 692 (TTAB 1974). Copies of official records of the Patent and Trademark Office need not be certified. See 37 CFR §2.122(e).

703.02(b) Third-Party Registration

37 CFR §2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

A party to an inter partes proceeding before the Board may introduce, as part of its evidence in the case, a third-party registration, that is, a registration owned by a party not involved in the proceeding. See J. David Sams, TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings, 72 Trademark Rep. 297 (1982).

A party which wishes to make a third-party registration of record in a Board inter partes proceeding may do so by filing, during its testimony period, a plain copy of the registration together with a notice of reliance thereon specifying the registration and indicating generally its relevance. See 37 CFR §2.122(e). See also Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); W. R. Grace & Co. v. Herbert J. Meyer Industries,

OLD EDITION

Inc., 190 USPQ 308 (TTAB 1976); and J. David Sams, TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings, 72 Trademark Rep. 297, 301 (1982).

A party to a Board inter partes proceeding may also make a third-party registration of record by introducing a copy thereof as an exhibit to testimony, or by stipulation of the parties.

It is not necessary that the copy of the third-party registration submitted with a notice of reliance (or with testimony or a stipulation) be certified, nor need it be a current status and title copy prepared by the PTO; a plain copy (or legible photocopy) of the registration itself, or the electronic equivalent thereof, that is, a printout of the registration from the electronic records of the PTO's trademark automated search system, known as "X-Search," is all that is required. See 37 CFR §2.122(e); In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Interbank Card Ass'n v. United States National Bank of Oregon, 197 USPQ 123 (TTAB 1977); J. David Sams, TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings, 72 Trademark Rep. 297, 301 (1982); and Janet E. Rice, TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record, 67 Trademark Rep. 54 (1977). A current status and title copy prepared by the PTO (or other appropriate proof of current status and title) is necessary when the owner of a registration on the Principal Register seeks to make the registration of record for the purpose of relying on the presumptions accorded to a certificate of registration pursuant to Section 7(b) of the Act, 15 U.S.C. §1057(b). See TBMP §703.02(a). However, the Section 7(b) presumptions accorded to a registration on the Principal Register accrue only to the benefit of the owner of the registration, and hence come into play only when the registration is made of record by its owner, or when the registration is cited by a Trademark Examining Attorney (in an ex parte case) as a reference under Section 2(d) of the Act, 15 U.S.C. §1052(d), against a mark sought to be registered. See Section 7(b) of the Act; Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986); In re Phillips-Van Heusen Corp., 228 USPQ 949 (TTAB 1986); In re H & H Products, 228 USPQ 771 (TTAB 1986); Yamaha International Corp. v. Stevenson, 196 USPQ 701 (TTAB 1979); Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc., 174 USPQ 473 (TTAB 1972); and Joseph S. Finch & Co. v. E. Martinoni Co., 157 USPQ 394 (TTAB 1968). Thus, when third-party registrations are made of record, the Section 7(b) presumptions may not be relied upon by the party offering them; normally, third-party registrations are offered merely to show that they issued,

OLD EDITION

and a plain copy of the registration is sufficient for that purpose. See Hiram Walker & Sons, Inc. v. Milstone, 130 USPQ 274 (TTAB 1961), and Janet E. Rice, TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record, 67 Trademark Rep. 54 (1977).

On the other hand, a party may not make a third-party registration of record simply by introducing a list of third-party registrations wherein it appears; or by filing a trademark search report wherein the registration is mentioned; or by filing a printout, from a private company's data base, of information about the registration; or by filing a notice of reliance together with a reproduction of the mark as it appeared in the Official Gazette for purposes of publication; or by referring to the registration in its brief or pleading (the Board does not take judicial notice of registrations residing in the PTO). See, for example, In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994); Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212 (TTAB 1990); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530 (TTAB 1986); National Fidelity Life Insurance v. National Insurance Trust, 199 USPQ 691 (TTAB 1978); Wella Corp. v. California Concept Corp., 192 USPQ 158 (TTAB 1976), rev'd on other grounds, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976). See also Janet E. Rice, TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record, 67 Trademark Rep. 54 (1977). Cf. In re Pan-O-Gold Baking Co., 20 USPQ2d 1761 (TTAB 1991); In re Golden Griddle Pancake House Ltd., 17 USPQ2d 1074 (TTAB 1990); In re Classic Beverage Inc., 6 USPQ2d 1383 (TTAB 1988); In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983); In re National Presto Industries, Inc., 197 USPQ 188 (TTAB 1977); In re Certified Burglar Alarm Systems, 191 USPQ 47 (TTAB 1976); and In re Duofold, Inc., 184 USPQ 638 (TTAB 1974). Cf. also TBMP §528.05(d) (for purposes of responding to a summary judgment motion only, a copy of a trademark search report may be sufficient to raise a genuine issue of material fact as to the nature and extent of third-party use of a particular designation).

Even when a third-party (Federal) registration has been properly made of record, its probative value is limited, particularly when the issue to be determined is likelihood of confusion, and there is no evidence of actual use of the mark shown

OLD EDITION

in the registration. See, for example, Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992); Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 196 USPQ 289 (CCPA 1977); Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976); Conde Nast Publications, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 USPQ 422 (CCPA 1975); Spice Islands, Inc. v. Frank Tea and Spice Co., 505 F.2d 1293, 184 USPQ 35 (CCPA 1974); AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973); Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 USPQ2d 1404 (TTAB 1988); United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172 (TTAB 1987); Bottega Veneta, Inc. v. Volume Shoe Corp., 226 USPQ 964 (TTAB 1985); Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984); Mead Johnson & Co. v. Peter Eckes, 195 USPQ 187 (TTAB 1977); Cutter Laboratories, Inc. v. Air Products & Chemicals, Inc., 189 USPQ 108 (TTAB 1975); and J. David Sams, TIPS FROM THE TTAB: Third Party Registrations in TTAB Proceedings, 72 Trademark Rep. 297, 301 (1982). A state registration, whether or not owned by a party, has very little, if any, probative value in a proceeding before the Board. See Allstate Insurance Co. v. DeLibro, 6 USPQ2d 1220 (TTAB 1988), and TBMP §703.02(a) and cases cited therein.

OLD EDITION

703.03 Application Not Subject of Proceeding

37 CFR §2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

If a party to a proceeding before the Board wishes to introduce, as part of its evidence in the case, a copy of an application which is not the subject of the proceeding, the party may do so by filing, during its testimony period, a copy of the application, or of the portions thereof which it wishes to introduce, together with a notice of reliance thereon specifying the application and indicating generally its relevance. See 37 CFR §2.122(e); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979); and St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co., 196 USPQ 778 (TTAB 1977). It is not necessary that the copy of the application, or portions thereof, filed under a notice of reliance be certified. See 37 CFR §2.122(e).

An application which is not the subject of the proceeding may also be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties.

An application made of record in a Board inter partes proceeding, whether owned by a party or not, is generally of very limited probative value. See Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979); Allied Mills, Inc. v. Kal Kan Foods, Inc., 203 USPQ 390 (TTAB 1979); Lasek & Miller Associates v. Rubin, 201 USPQ 831 (TTAB 1978); St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co., 196 USPQ 778 (TTAB 1977); Continental Specialties Corp. v. Continental Connector Corp., 192 USPQ 449 (TTAB 1976); Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976); and TBMP §704. However, if the application is owned by a party to the proceeding, the allegations made and documents and things filed in the application may be used as evidence against the applicant, that is, as admissions against interest and the like. See TBMP §704, and cases cited therein.

OLD EDITION

704 Statements and Things in Application or Registration

37 CFR 2.122(b) Application files. (1) The file of each application or registration specified in a declaration of interference, of each application or registration specified in the notice of a concurrent use registration proceeding, of the application against which a notice of opposition is filed, or of each registration against which a petition or counterclaim for cancellation is filed

forms part of the record of the proceeding without any action by the parties and reference may be made to the file for any relevant and competent purpose.

(2) The allegation in an application for registration, or in a registration, of a date of use is not evidence on behalf of the applicant or registrant; a date of use of a mark must be established by competent evidence. Specimens in the file of an application for registration, or in the file of a registration, are not evidence on behalf of the applicant or registrant unless identified and introduced in evidence as exhibits during the period for the taking of testimony.

While the file of a particular application or registration may be of record in a Board inter partes proceeding, by operation of 37 CFR §2.122(b) (see TBMP §703.01) or otherwise, the allegations made, and documents and other things filed, in the application or registration are not evidence in the proceeding on behalf of the applicant or registrant. Allegations must be established by competent evidence properly adduced at trial, and the documents and other things in an application or registration file are not evidence, in an inter partes proceeding, on behalf of the applicant or registrant unless they are identified and introduced in evidence as exhibits during the testimony period. See: 37 CFR 2.122(b); British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989); Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530 (TTAB 1986); Omega SA v. Compucorp, 229 USPQ 191 (TTAB 1985); Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985); Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985); Sunbeam Corp. v. Battle Creek Equipment Co., 216 USPQ 1101 (TTAB 1982); Eikonix Corp. v. CGR Medical Corp., 209 USPQ 607 (TTAB 1981); Copperweld Corp. v. Arcair Co., 200 USPQ 470 (TTAB 1978); Dap, Inc. v. Century Industries Corp., 183 USPQ 122 (TTAB 1974); Textron Inc. v. Arctic Enterprises, Inc., 178 USPQ 315 (TTAB 1973); ILC Products Co. v. ILC, Inc., 175 USPQ 722 (TTAB 1972); Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc., 174 USPQ 473 (TTAB 1972); and W. T. Grant Co. v. Grant Avenue Fashions, Inc., 135 USPQ 273 (TTAB 1962). This is because the adverse party has a right to confront and cross-examine the person making the allegations, and to question the authenticity of the specimens, documents, exhibits, etc. See ILC Products Co. v. ILC, Inc., 175 USPQ 722 (TTAB 1972); Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc., 174 USPQ 473

OLD EDITION

(TTAB 1972); and W. T. Grant Co. v. Grant Avenue Fashions, Inc., 135 USPQ 273 (TTAB 1962).

Thus, for example, the allegation in an application or registration of a date of use is not evidence on behalf of the applicant or registrant in an inter partes proceeding; to be relied on by the applicant or registrant, a claimed date of use of a mark must be established by competent evidence. See 37 CFR §2.122(b)(2). See also Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993); Omega SA v. Compucorp, 229 USPQ 191 (TTAB 1985); Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985); and Textron Inc. v. Arctic Enterprises, Inc., 178 USPQ 315 (TTAB 1973). Similarly, the allegations of use in a third-party registration do not constitute evidence that the mark shown therein has actually been used. See 37 CFR §2.122(b)(2), and Alpha Industries, Inc. v. Alpha Microsystems, 223 USPQ 96 (TTAB 1984). See also, for example, Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989); Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986); and Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc., 224 USPQ 512 (TTAB 1984).

The specimens in the file of an application or registration are not evidence on behalf of the applicant or registrant, in an inter partes proceeding, unless they are identified and introduced in evidence as exhibits during the testimony period. See: 37 CFR 2.122(b)(2); Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985); Eikonix Corp. v. CGR Medical Corp., 209 USPQ 607 (TTAB 1981); and Dap, Inc. v. Century Industries Corp., 183 USPQ 122 (TTAB 1974).

Affidavits or declarations in an application or registration file cannot be relied upon by the applicant or registrant, in an inter partes proceeding, as evidence of the truth of the statements contained therein; the statements must be established by competent evidence at trial. See British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994); McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989), and Sunbeam Corp. v. Battle Creek Equipment Co., 216 USPQ 1101 (TTAB 1982). Similarly, statements made by counsel, and exhibits filed, in an application or registration do not constitute admissible evidence in the applicant's or registrant's behalf in an inter partes proceeding; the statements must be established by competent evidence, and the exhibits must be properly identified and introduced in evidence, at trial. See W. T. Grant Co. v. Grant Avenue Fashions, Inc., 135 USPQ 273 (TTAB 1962).

OLD EDITION

Further, the fact that the file of an application or registration which is the subject of a Board inter partes proceeding is automatically of record in that proceeding, does not mean that a registration claimed by applicant or registrant in the application or registration is also automatically of record. See Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530 (TTAB 1986); Allied Mills, Inc. v. Kal Kan Foods, Inc., 203 USPQ 390 (TTAB 1979); and Copperweld Corp. v. Arcair Co., 200 USPQ 470 (TTAB 1978).

Although the allegations made and documents and things filed in an application or registration are not evidence, in a Board inter partes proceeding, on behalf of the applicant or registrant (unless they are properly proved at trial), they may be used as evidence against the applicant or registrant, that is, as admissions against interest and the like. See Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985) (specimens and other materials in applicant's application used as evidence of meaning of applicant's recitation of services, and that those services are not "substantially identical" to goods in applicant's subsisting registration of mark), and Eikonix Corp. v. CGR Medical Corp., 209 USPQ 607 (TTAB 1981) (information in specimens in respondent's registration used as evidence of relationship between respondent's and petitioner's goods). See also, for example, Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987) (applicant which seeks to prove date of first use earlier than that stated in its application must do so by clear and convincing evidence, rather than by preponderance of the evidence, because of change of position from one "considered to have been made against interest at the time of filing of the application"); Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (statements in application file illustrate the variety of images that may be attributed to, and commercial impression projected by, applicant's mark); Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151 (CCPA 1978) (fact that party took position in its application inconsistent with its position in inter partes proceeding may be considered as evidence "illuminative of shade and tone in the total picture confronting the decision maker"); Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971) (specimens in application with typed drawing illustrate one form in which mark may be used); and American Rice, Inc. v. H.I.T. Corp., 231 USPQ 793 (TTAB 1986) (fact that party took position in its application inconsistent with its position in inter partes

OLD EDITION

proceeding may be considered as evidence, although earlier inconsistent position does not give rise to an estoppel).

705 Exhibits to Pleadings or Briefs

705.01 Exhibits to Pleadings

37 CFR §2.122(c) Exhibits to pleadings. Except as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached unless identified and introduced in evidence as an exhibit during the period for the taking of testimony.

37 CFR §2.122(d) Registrations. (1) A registration of the opposer or petitioner pleaded in an opposition or petition to cancel will be received in evidence and made part of the record if the opposition or petition is accompanied by two copies of the registration prepared and issued by the Patent and Trademark Office showing both the current status of and current title to the registration. For the cost of a copy of a registration showing status and title, see §2.6(n).

With one exception, exhibits attached to a pleading are not evidence on behalf of the party to whose pleading they are attached unless they are thereafter, during the time for taking testimony, properly identified and introduced in evidence as exhibits. See 37 CFR §2.122(c), and TBMP §313 and cases cited therein.

The one exception is a current status and title copy, prepared by the PTO, of a plaintiff's pleaded registration. When a plaintiff submits such a status and title copy of its pleaded registration as an exhibit to its complaint, the registration will be received in evidence and made part ot the record without any further action by plaintiff. See 37 CFR §§2.122(c) and (d)(1), and TBMP §703.02(a).

705.02 Exhibits to Briefs

Exhibits and other evidentiary materials attached to a party's brief on the case can be given no consideration unless they were properly made of record during the time for taking testimony. See, for example, Maytag Co. v. Luskin's, Inc., 228

OLD EDITION

USPQ 747 (TTAB 1986); Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984); BL Cars Ltd. v. Puma Industria de Veiculos S/A, 221 USPQ 1018 (TTAB 1983); Plus Products v. Physicians Formula Cosmetics, Inc., 198 USPQ 111 (TTAB 1978); Astec Industries, Inc. v. Barber-Greene Co., 196 USPQ 578 (TTAB 1977); Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976); L. Leichner (London) Ltd. v. Robbins, 189 USPQ 254 (TTAB 1975); American Crucible Products Co. v. Kenco Engineering Co., 188 USPQ 529 (TTAB 1975); Tektronix, Inc. v. Daktronics, Inc., 187 USPQ 588 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693 (CCPA 1976); Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 185 USPQ 61 (TTAB 1975), aff'd, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976); and Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973).

If, after the close of the time for taking testimony, a party discovers new evidence which it wishes to introduce in its behalf, the party may file a motion to reopen its testimony period. However, the moving party must show not only that the proposed evidence has been newly discovered, but also that it could not have been discovered earlier through the exercise of reasonable diligence. See TBMP §509.01, and cases cited therein.

OLD EDITION

706 Statements in Pleadings or Briefs

706.01 Statements in Pleadings

Statements made in pleadings cannot be considered as evidence in behalf of the party making them; such statements must be established by competent evidence during the time for taking testimony. See Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991), and Times Mirror Magazines, Inc. v. Sutcliff, 205 USPQ 656 (TTAB 1979).

However, statements in pleadings may have evidentiary value as admissions against interest by the party which made them. See Maremont Corp. v. Air Lift Co., 463 F.2d 1114, 174 USPQ 395 (CCPA 1972); Bakers Franchise Corp. v. Royal Crown Cola Co., 404 F.2d 985, 160 USPQ 192 (CCPA 1969); Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991); Litton Business Systems, Inc. v. J.

G. Furniture Co., 196 USPQ 711 (TTAB 1977); and Brown Co. v. American Stencil Manufacturing Co., 180 USPQ 344 (TTAB 1973).

706.02 Statements in Briefs

Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest. See, for example, Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992); BL Cars Ltd. v. Puma Industria de Veiculos S/A, 221 USPQ 1018 (TTAB 1983); Abbott Laboratories v. Tac Industries, Inc., 217 USPQ 819 (TTAB 1981); Hecon Corp. v. Magnetic Video Corp., 199 USPQ 502 (TTAB 1978); and Plus Products v. Physicians Formula Cosmetics, Inc., 198 USPQ 111 (TTAB 1978). Cf. Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993), and In re Simulations Publications, Inc., 521 F.2d 797, 187 USPQ 147 (CCPA 1975).

707 Official Records

37 CFR §2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

OLD EDITION

A party which wishes to introduce an official record in evidence in a Board inter partes proceeding may do so, if the official record is competent evidence and relevant to an issue in the proceeding, by filing a notice of reliance thereon during its testimony period. The notice must specify the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence. See 37 CFR §2.122(e). See also Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Questor Corp. v. Dan Robbins & Associates, Inc., 199 USPQ 358 (TTAB 1978), aff'd, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); Mack Trucks, Inc. v. California Business News, Inc., 223 USPQ 164 (TTAB 1984); Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979); Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979); and May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978). For information concerning establishing the authenticity, under the Federal Rules of Evidence, of an official record, see FRE 901(a), 901(b)(7), and 902(4) (the latter rule provides, in effect, that extrinsic evidence of authenticity as a condition precedent to admissibility is not required with respect to a properly certified copy of an official record, and describes the requirements for proper certification). A copy of an official record of the PTO need not be certified to be offered in evidence by notice of reliance. See 37 CFR §2.122(e).

In lieu of the actual "official record or a copy thereof," the notice of reliance may be accompanied by an electronically generated document (or a copy thereof) which is the equivalent of the official record, and whose authenticity is established under the Federal Rules of Evidence. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992). Cf. TBMP §708.

The term "official records," as used in 37 CFR §2.122(e), refers not to a party's company business records, but rather to the records of public offices or agencies, or records kept in the performance of duty by a public officer. See Black's Law Dictionary (Fifth Edition, 1979); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); and Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979). See also FRE 902(4). For examples of cases concerning the admissibility of specific documents, by notice of reliance, as "official records" under 37 CFR §2.122(e), see Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993) (trademark search report--no); Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992) (trademark search reports--no); Burns Philip Food Inc. v. Modern Products Inc., 24 USPQ2d 1157 (TTAB 1992), aff'd, 28 USPQ2d 1687 (Fed. Cir. 1993)

OLD EDITION

(trademark search report--no; third-party registrations--yes); Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985) (copy of cancellation proceeding file--yes; party's file copies of documents filed in the PTO--no); Cadence Industries Corp. v. Kerr, 225 USPQ 331 (TTAB 1985) (letters between counsel for parties, and list of party's licensees--no); Mack Trucks, Inc. v. California Business News, Inc., 223 USPQ 164 (TTAB 1984) (third-party registrations--yes); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983) (portions of an agreement between applicant and a third party, and a shipping document for applicant's product--no); Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979) (copy of letter from Amtrak to applicant congratulating applicant for having an appointment as an Amtrak agent, copy of a "Passenger Sales Agency Agreement" between the International Air Transport Association and applicant, etc.--no); Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979) (promotional literature--no); May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978) (certified copies of corporate records maintained by Secretary of State of Missouri--yes); Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc., 195 USPQ 658 (TTAB 1977) (plat plan, deed of realty, and confirmatory assignment--not admissible by notice of reliance as official record because not authenticated); Quaker Oats Co. v. Acme Feed Mills, Inc., 192 USPQ 653 (TTAB 1976) (third-party registrations--yes); Harzfeld's, Inc. v. Joseph M. Feldman, Inc., 184 USPQ 692 (TTAB 1974) (file history of party's registration--yes); Jetzon Tire & Rubber Corp. v. General Motors Corp., 177 USPQ 467 (TTAB 1973) (drawings from Federal trademark applications--yes); and American Optical Corp. v. American Olean Tile Co., 169 USPQ 123 (TTAB 1971) (certificate of good standing from a United States district court--yes).

Although official records may be made of record by notice of reliance under 37 CFR §2.122(e), it is not mandatory that they be introduced in this manner. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. See Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984); Hayes Microcomputer Products, Inc. v. Business Computer Corp., 219 USPQ 634 (TTAB 1983); and Regent Standard Forms, Inc. v. Textron Inc., 172 USPQ 379 (TTAB 1971). These latter two methods may also be used for the introduction of official records which are not admissible by notice of reliance under 37 CFR §2.122(e). See, for example, Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983). Cf. Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB

OLD EDITION

1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990), and Minnesota Mining & Manufacturing Co. v. Stryker Corp., 179 USPQ 433 (TTAB 1973).

For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP §§533 and 718.02.

Materials improperly offered under 37 CFR §2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object thereto, and/or itself treats the materials as being of record. See, for example, U.S. West Inc. v. BellSouth Corp., 18 USPQ2d 1307 (TTAB 1990) (improper subject matter); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (improper subject matter); Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717 (TTAB 1987) (improper subject matter, and advertisement not sufficiently identified); Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986) (improper subject matter, and improper rebuttal); Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984) (improper subject matter); Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979) (improper subject matter); and Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979) (untimely). Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

OLD EDITION

708 Printed Publications

37 CFR §2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need

not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

Certain types of printed publications may be introduced in evidence in a Board inter partes proceeding by notice of reliance. Specifically, printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, if the publication is competent evidence and relevant to an issue in the proceeding, may be introduced in evidence by filing a notice of reliance thereon during the testimony period of the offering party. The notice must specify the printed publication, including information sufficient to identify the source and the date of the publication, and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the printed publication or a copy of the relevant portion thereof. See 37 CFR §2.122(e). See also Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); Questor Corp. v. Dan Robbins & Associates, Inc., 199 USPQ 358 (TTAB 1978), aff'd, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717 (TTAB 1987); Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986); Mack Trucks, Inc. v. California Business News, Inc., 223 USPQ 164 (TTAB 1984); Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979); Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979); Chicken Delight, Inc. v. Delight Wholesale Co., 197 USPQ 630 (TTAB 1977); Wagner Electric Corp. v. Raygo Wagner, Inc., 192 USPQ 33 (TTAB 1976); Manpower, Inc. v. Manpower Information Inc., 190 USPQ 18 (TTAB 1976); and Jetzon Tire & Rubber Corp. v. General Motors Corp., 177 USPQ 467 (TTAB 1973).

In lieu of the actual "printed publication or a copy of the relevant portion thereof," the notice of reliance may be accompanied by an electronically generated document which is the equivalent of the printed publication or relevant portion thereof, as, for example, by a printout from Mead Data Central's Nexis computerized library of an article published in a newspaper or magazine of general circulation. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp., 226 USPQ 169 (TTAB 1985), and International Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp., 225 USPQ 940 (TTAB 1985), rev'd on other grounds, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986). Cf. TBMP §707, and In re Omaha National Corp., 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987).

OLD EDITION

In case of reasonable doubt as to whether printed publications submitted by notice of reliance under 37 CFR §2.122(e) are "available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue" in the proceeding, the burden of showing that they are so available lies with the offering party. See Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979).

For examples of cases concerning the admissibility of specific materials, by notice of reliance, as "printed publications" under 37 CFR §2.122(e), see Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992) (trademark search reports--no); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (annual reports--no); Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986) (conference papers, dissertations, and journal papers--no); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983) (press releases--no); Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984) (annual reports--no); Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767 (TTAB 1980) (annual report--no; magazine articles--yes); Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979) (promotional literature--no); Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979) (promotional literature--no); Wagner Electric Corp. v. Raygo Wagner, Inc., 192 USPQ 33 (TTAB 1976) (catalogs and other house publications--no); Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976) (annual reports, promotional brochures, price list, reprints of advertisements, and copies of advertising mats--no); Manpower, Inc. v. Manpower Information Inc., 190 USPQ 18 (TTAB 1976) (telephone directory pages, indexes from United States Code Annotated, and dictionary pages--yes); Litton Industries, Inc. v. Litronix, Inc., 188 USPQ 407 (TTAB 1975) (annual reports--no); Exxon Corp. v. Fill-R-Up Systems, Inc., 182 USPQ 443 (TTAB 1974) (credit card applications, handouts, and flyers--no; articles from trade publications and other magazines--yes); Minnesota Mining & Manufacturing Co. v. Stryker Corp., 179 USPQ 433 (TTAB 1973) (annual reports, product booklets, and product brochures--no); and Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973) (article from "Memoirs of the University of California"--no, since publication not shown to be available to the general public).

Printed publications made of record by notice of reliance under 37 CFR §2.122(e) are admissible, and probative, merely for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has

OLD EDITION

testified to the truth of such matters. See, for example, Gravel Cologne, Inc. v. Lawrence Palmer, Inc., 469 F.2d 1397, 176 USPQ 123 (CCPA 1972); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767 (TTAB 1980); Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 201 USPQ 404 (TTAB 1978); Food Producers, Inc. v. Swift & Co., 194 USPQ 299 (TTAB 1977); Wagner Electric Corp. v. Raygo Wagner, Inc., 192 USPQ 33 (TTAB 1976); Litton Industries, Inc. v. Litronix, Inc., 188 USPQ 407 (TTAB 1975); Otis Elevator Co. v. Echlin Manufacturing Co., 187 USPQ 310 (TTAB 1975); Exxon Corp. v. Fill-R-Up Systems, Inc., 182 USPQ 443 (TTAB 1974).

Although the types of printed publications described above may be made of record by notice of reliance under 37 CFR §2.122(e), it is not mandatory that they be introduced in this manner. They may, alternatively, be made of record by appropriate identification and introduction during the taking of testimony, or by stipulation of the parties. See Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984), and Hayes Microcomputer Products, Inc. v. Business Computer Corp., 219 USPQ 634 (TTAB 1983). These latter two methods may also be used for the introduction of printed publications which are not admissible by notice of reliance under 37 CFR §2.122(e). See, for example, Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983); and Minnesota Mining & Manufacturing Co. v. Stryker Corp., 179 USPQ 433 (TTAB 1973).

For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP §§533 and 718.02.

Materials improperly offered under 37 CFR §2.122(e) may nevertheless be considered by the Board if the adverse party (parties) does not object thereto, and/or itself treats the materials as being of record. See, for example, U.S. West Inc. v. BellSouth Corp., 18 USPQ2d 1307 (TTAB 1990) (improper subject matter); Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990) (improper subject matter); Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717 (TTAB 1987) (improper subject matter, and advertisement not sufficiently identified); Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986) (improper subject matter, and improper rebuttal);

OLD EDITION

Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984) (improper subject matter); Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979) (improper subject matter); and Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979) (untimely). Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979) (improper subject matter excluded, although no objection).

709 Discovery Depositions

37 CFR §2.120(j) Use of discovery deposition, answer to interrogatory, or admission. (1) The discovery deposition of a party or of anyone who at the time of taking the deposition was an officer, director or managing agent of a party, or a person designated by a party pursuant to Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, may be offered in evidence by an adverse party.

(2) Except as provided in paragrpah (j)(1) of this section, the discovery deposition of a witness, whether or not a party, shall not be offered in evidence unless the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or there is a stipulation by the parties; or upon a showing that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The use of a discovery deposition by any party under this paragraph will be allowed only by stipulation of the parties approved by the Trademark Trial and Appeal Board, or by order of the Board on motion, which shall be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion shall be filed promptly after the circumstances claimed to justify use of the deposition became known.

(3)(i) A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the

OLD EDITION

deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * *

(4) If only part of a discovery deposition is submitted and made part of the record by a party, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. A notice of reliance filed by an adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts.

* * *

(6) Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.

(7) When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(8) Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.

OLD EDITION

The discovery deposition of a party (or of anyone who, at the time of taking the depositioon, was an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31(a)(3) to testify on behalf of a party) may be offered in evidence by any adverse party. See 37 CFR §2.120(j)(1). See also Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992); First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628 (TTAB 1988); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987); Dynamark Corp. v. Weed Eaters, Inc., 207 USPQ 1026 (TTAB 1980); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); Johnson Publishing Co. v. Cavin & Tubiana OHG, 196 USPQ 383 (TTAB 1977); Ethicon, Inc. v. American Cyanamid Co., 192 USPQ 647 (TTAB 1976); Coca-Cola Co. v. Seven-Up Co., 175 USPQ 491 (Comm'r 1972); and Clairol Inc. v. Holland Hall Products, Inc., 165 USPQ 214 (TTAB 1970).

Otherwise, the discovery deposition of a witness, whether or not a party, may not be offered in evidence except in the following situations:

(1) By stipulation of the parties, approved by the Board. See 37 CFR §2.120(j)(2).

(2) By order of the Board, on motion showing that the person whose deposition was taken is, during the testimony period of the party offering the deposition, dead; or out of the United States (unless it appears that the absence of the witness was procured by the party offering the deposition); or unable to testify because of age, illness, infirmity, or imprisonment; or cannot be served with a subpoena to compel attendance at a testimonial deposition; or that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used. The motion must be filed at the time of the purported offer of the deposition in evidence, unless the motion is based upon a claim that such exceptional circumstances exist as to make it desirable, in the interest of justice, to allow the deposition to be used, in which case the motion must be filed promptly after the circumstances claimed to justify use of the deposition became known. See 37 CFR §2.120(j)(2). See also Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992); Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988); First International Services Corp. v. Chuckles Inc., 5

OLD EDITION

USPQ2d 1628 (TTAB 1988); Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987); Maytag Co. v. Luskin's, Inc., 228 USPQ 747 (TTAB 1986); Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc., 221 USPQ 354 (TTAB 1984); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); National Fidelity Life Insurance v. National Insurance Trust, 199 USPQ 691 (TTAB 1978); and Insta-Foam Products, Inc. v. Instapak Corp., 189 USPQ 793 (TTAB 1976).

(3) If only part of a discovery deposition is submitted and made part of the record by a party entitled to offer the deposition in evidence, an adverse party may introduce under a notice of reliance any other part of the deposition which should in fairness be considered so as to make not misleading what was offered by the submitting party. In such a case, the notice of reliance filed by the adverse party must be supported by a written statement explaining why the adverse party needs to rely upon each additional part listed in the adverse party's notice, failing which the Board, in its discretion, may refuse to consider the additional parts. See 37 CFR §2.120(j)(4). See also Wear-Guard Corp. v. Van Dyne-Crotty Inc., 18 USPQ2d 1804 (TTAB 1990), aff'd, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991); Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988); First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628 (TTAB 1988); Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986); Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954 (TTAB 1985); Dynamark Corp. v. Weed Eaters, Inc., 207 USPQ 1026 (TTAB 1980); Johnson Publishing Co. v. Cavin & Tubiana OHG, 196 USPQ 383 (TTAB 1977); and Rogers Corp. v. Fields Plastics & Chemicals, Inc., 172 USPQ 377 (TTAB 1972).

A discovery deposition which may be offered in evidence under the provisions of 37 CFR §2.120(j) may be made of record by filing, during the testimony period of the offering party, the deposition or any part thereof with any exhibit to the part that is filed, together with a notice of reliance thereon. See 37 CFR §2.120(j)(3)(i). See also BASF Wyandotte Corp. v. Polychrome Corp., 586 F.2d 238, 200 USPQ 20 (CCPA 1978); Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); Plus Products v. Don Hall Laboratories, 191 USPQ 584 (TTAB 1976); Ethicon, Inc. v. American Cyanamid Co., 192 USPQ 647 (TTAB 1976); Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495 (TTAB 1970); Clairol Inc. v. Holland Hall Products, Inc., 165 USPQ 214 (TTAB 1970); and American Skein & Foundry Co. v. Stein, 165 USPQ 85 (TTAB 1970). The notice of reliance

OLD EDITION

need not indicate the relevance of the deposition, or parts thereof, relied on. See 37 CFR §2.120(j)(3)(i). Cf. Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979). When only part of a deposition is relied on, the notice of reliance must specify the part or parts relied on. See Exxon Corp. v. Motorgas Oil & Refining Corp., 219 USPQ 440 (TTAB 1983).

When a discovery deposition has been made of record by one party in accordance with 37 CFR §2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. See 37 CFR §2.120(j)(7). See also Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954 (TTAB 1985); Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 USPQ 431 (TTAB 1985); Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984); and Miles Laboratories, Inc. v. SmithKline Corp., 189 USPQ 290 (TTAB 1975). If only part of a discovery deposition has been made of record pursuant to 37 CFR §2.120(j), that part only may be referred to by any party for any purpose permitted by the Federal Rules of evidence. If one party has filed a notice of reliance on a discovery deposition or part thereof and an adverse party has based its presentation of evidence on the belief that the deposition or the part thereof is of record, the notice of reliance may not later be withdrawn. See Exxon Corp. v. Motorgas Oil & Refining Corp., 219 USPQ 440 (TTAB 1983).

A discovery deposition not properly offered in evidence under 37 CFR §2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto, and/or treats the deposition as being of record, and/or improperly offers a discovery deposition in the same manner. See, for example, Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1990); Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc., 221 USPQ 354 (TTAB 1984); Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982); Pamex Foods, Inc. v. Clover Club Foods Co., 201 USPQ 308 (TTAB 1978); and Plus Products v. Don Hall Laboratories, 191 USPQ 584 (TTAB 1976).

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery; or (6) with the complaint, in the case of discovery requests, for later service upon

OLD EDITION

the defendant, by the Board, with defendant's copies of the complaint and proceeding notification letter. Discovery papers or materials filed under other circumstances may be returned by the Board. See 37 CFR §2.120(j)(8), and TBMP §413 and authorities cited therein.

Nothing in 37 CFR §2.120(j) will be interpreted to preclude the reading or the use of a discovery deposition as part of the examination or cross-examination of any witness during the testimony period of any party. See 37 CFR §2.120(j)(6). See also Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984). Cf. West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co., 2 USPQ2d 1306 (TTAB 1987).

For information concerning the taking of a discovery deposition, and the raising of objections thereto, see TBMP §§404, 405, 533, and 718.02.

NOTE: Some of the cases cited in this section were the predecessors to the cited provisions in current 37 CFR §2.120(j), or were decided under rules which were the predecessors to such provisions.

OLD EDITION

710 Interrogatory Answers; Admissions

37 CFR §2.120(j)(3)(i) A discovery deposition, an answer to an interrogatory, or an admission to a request for admission, which may be offered in evidence under the provisions of paragraph (j) of this section may be made of record in the case by filing the deposition or any part thereof with any exhibit to the part that is filed, or a copy of the interrogatory and answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance. The notice of reliance and the material submitted thereunder should be filed during the testimony period of the party which files the notice of reliance. An objection made at a discovery deposition by a party answering a question subject to the objection will be considered at final hearing.

* * *

(5) An answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party except that, if fewer than all of the answers to interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance filed by the responding party must be supported by a written statement explaining why the responding party needs to rely upon each of the additinal discovery responses listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses.

(6) Paragraph (j) of this section will not be interpreted to preclude the reading or the use of a discovery deposition, or answer to an interrogatory, or admission as part of the examination or cross-examination of any witness during the testimony period of any party.

(7) When a discovery deposition, or a part thereof, or an answer to an interrogatory, or an admission, has been made of record by one party in accordance with the provisions of paragraph (j)(3) of this section, it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence.

(8) Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted with a motion relating to discovery, or in support of or response to a motion for summary judgment, or under a notice of reliance during a party's testimony period. Papers or materials filed in violation of this paragraph may be returned by the Board.

Ordinarily, an answer to an interrogatory, or an admission to a request for admission, may be submitted and made part of the record by only the inquiring party. See 37 CFR §2.120(j)(5). See also Triumph Machinery Co. v. Kentmaster Manufacturing Co., 1 USPQ2d 1826 (TTAB 1987); Wilderness Group, Inc. v. Western Recreational Vehicles, Inc., 222 USPQ 1012 (TTAB 1984); Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949 (TTAB 1981); Safeway Stores, Inc. v. Captn's Pick, Inc., 203 USPQ 1025 (TTAB 1979); Jerrold Electronics Corp. v. Magnavox Co., 199 USPQ 751 (TTAB 1978); Cities Service Co. v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978);

OLD EDITION

General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690 (TTAB 1977); Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc., 195 USPQ 658 (TTAB 1977); A. H. Robins Co. v. Evsco Pharmaceutical Corp., 190 USPQ 340 (TTAB 1976); W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976); and Beecham Inc. v. Helene Curtis Industries, Inc., 189 USPQ 647 (TTAB 1976).

However, if fewer than all of the answers to a set of interrogatories, or fewer than all of the admissions, are offered in evidence by the inquiring party, the responding party may introduce under a notice of reliance any other answers to interrogatories, or any other admissions, which should in fairness be considered so as to make not misleading what was offered by the inquiring party. The notice of reliance must be supported by a written statement explaining why the responding party needs to rely upon each of the additional interrogatory answers, or admissions, listed in the responding party's notice, failing which the Board, in its discretion, may refuse to consider the additional responses. See 37 CFR §2.120(j)(5). See also Heaton Enterprises of Nevada Inc. v. Lang, 7 USPQ2d 1842 (TTAB 1988); Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Triumph Machinery Co. v. Kentmaster Manufacturing Co., 1 USPQ2d 1826 (TTAB 1987); Alabama Board of Trustees v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB 1986); Packaging Industries Group, Inc. v. Great American Marketing, Inc., 227 USPQ 734 (TTAB 1985); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949 (TTAB 1981); and Beecham Inc. v. Helene Curtis Industries, Inc., 189 USPQ 647 (TTAB 1976).

An interrogatory answer (including documents provided as all or part of an interrogatory answer), or an admission to a request for admission, which may be offered in evidence under the provisions of 37 CFR §2.120(j) may be made of record in the case by filing, during the testimony period of the offering party, a copy of the interrogatory and the answer thereto, with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto), together with a notice of reliance thereon. See 37 CFR §2.120(j)(3)(i); BASF Wyandotte Corp. v. Polychrome Corp., 586 F.2d 238, 200 USPQ 20 (CCPA 1978); M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990) (documents provided as interrogatory answer); Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986) (documents provided as interrogatory answer); Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982); May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978); Bausch & Lomb Inc. v.

OLD EDITION

Gentex Corp., 200 USPQ 117 (TTAB 1978); E. I. du Pont de Nemours & Co. v. G. C. Murphy Co., 199 USPQ 807 (TTAB 1978); Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), pet. to Comm'r den., 198 USPQ 485 (Comm'r 1977); Hollister Inc. v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976); Plus Products v. Don Hall Laboratories, 191 USPQ 584 (TTAB 1976); and A. H. Robins Co. v. Evsco Pharmaceutical Corp., 190 USPQ 340 (TTAB 1976). The notice of reliance need not indicate the relevance of the discovery responses relied on. See 37 CFR §2.120(j)(3)(i), and Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979). Offering interrogatory answers, or admissions, on the record during the taking of a testimony deposition is the equivalent of serving and filing a notice of reliance by mail. See Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp., 204 USPQ 945 (TTAB 1979).

An interrogatory answer, or an admission, may also be made of record by stipulation of the parties, accompanied by a copy of the interrogatory and the answer thereto with any exhibit made part of the answer, or a copy of the request for admission and any exhibit thereto and the admission (or a statement that the party from which an admission was requested failed to respond thereto). See Wilderness Group, Inc. v. Western Recreational Vehicles, Inc., 222 USPQ 1012 (TTAB 1984), and Wella Corp. v. California Concept Corp., 192 USPQ 158 (TTAB 1976), rev'd on other grounds, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977). See also Jerrold Electronics Corp. v. Magnavox Co., 199 USPQ 751 (TTAB 1978), and General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690 (TTAB 1977).

When an interrogatory answer, or an admission, has been made of record by one party in accordance with 37 CFR §2.120(j), it may be referred to by any party for any purpose permitted by the Federal Rules of Evidence. See 37 CFR §2.120(j)(7). See also Henry Siegel Co. v. M & R International Mfg. Co., 4 USPQ2d 1154 (TTAB 1987); Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984); and Beecham Inc. v. Helene Curtis Industries, Inc., 189 USPQ 647 (TTAB 1976).

An interrogatory answer, or an admission, not properly offered in evidence under 37 CFR §2.120(j) may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the answer, or admission, as being of record; and/or improperly offers an interrogatory answer, or an admission, in the same manner. See, for example, Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993); Heaton

OLD EDITION

Enterprises of Nevada Inc. v. Lang, 7 USPQ2d 1842 (TTAB 1988); Triumph Machinery Co. v. Kentmaster Manufacturing Co., 1 USPQ2d 1826 (TTAB 1987); Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979); Pamex Foods, Inc. v. Clover Club Foods Co., 201 USPQ 308 (TTAB 1978); Safeway Stores, Inc. v. Captn's Pick, Inc., 203 USPQ 1025 (TTAB 1979); Jerrold Electronics Corp. v. Magnavox Co., 199 USPQ 751 (TTAB 1978); General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690 (TTAB 1977); Plus Products v. Don Hall Laboratories, 191 USPQ 584 (TTAB 1976); and Plus Products v. Sterling Food Co., 188 USPQ 586 (TTAB 1975).

Requests for discovery, responses thereto, and materials or depositions obtained through the discovery process should not be filed with the Board except when submitted (1) with a motion relating to discovery; or (2) in support of or response to a motion for summary judgment; or (3) under a notice of reliance during a party's testimony period; or (4) as exhibits to a testimony deposition; or (5) in support of an objection to proffered evidence on the ground that the evidence should have been, but was not, provided in response to a request for discovery; or (6) with the complaint, in the case of discovery requests, for later service upon the defendant, by the Board, with defendant's copies of the complaint and proceeding notification letter. Discovery papers or materials filed under other circumstances may be returned by the Board. See 37 CFR §2.120(j)(8), and TBMP §413 and authorities cited therein.

Nothing in 37 CFR §2.120(j) will be interpreted to preclude the reading or the use of an interrogatory answer, or an admission, as part of the examination or cross-examination of any witness during the testimony period of any party. See 37 CFR §2.120(j)(6). See also West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co., 2 USPQ2d 1306 (TTAB 1987). Cf. Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984).

For information concerning the taking of discovery by way of interrogatories, see TBMP §§406 and 407. For information concerning the taking of discovery by way of requests for admission, see TBMP §§410 and 411. For information concerning the raising of objections to notices of reliance and materials filed thereunder, see TBMP §§533 and 718.02.

NOTE: Some of the cases cited in this section were the predecessors to the cited provisions in current 37 CFR §2.120(j), or were decided under rules which were the predecessors to such provisions.

OLD EDITION

711 Produced Documents

37 CFR §2.122(e) Printed publications and official records. Printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue, may be introduced in evidence by filing a notice of reliance on the material being offered. The notice shall specify the printed publication (including information sufficient to identify the source and the date of the publication) or the official record and the pages to be read; indicate generally the relevance of the material being offered; and be accompanied by the official record or a copy thereof whose authenticity is established under the Federal Rules of Evidence, or by the printed publication or a copy of the relevant portion thereof. A copy of an official record of the Patent and Trademark Office need not be certified to be offered in evidence. The notice of reliance shall be filed during the testimony period of the party that files the notice.

37 CFR §2.120(j)(3)(ii) A party which has obtained documents from another party under Rule 34 of the Federal Rules of Civil Procedure may not make the documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of §2.122(e).

In an inter partes proceeding before the Board, a party which has obtained documents from another party, under FRCP 34, may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under 37 CFR §2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding--see TBMP §§707 and 708). See 37 CFR §2.120(j)(3)(ii). See also, for example, M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990); Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986); Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985); Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984); BAF Industries v. Pro-Specialties, Inc., 206 USPQ 166 (TTAB 1980); Autac Inc. v. Viking Industries, Inc., 199 USPQ 367 (TTAB 1978);

OLD EDITION

Southwire Co. v. Kaiser Aluminum & Chemical Corp., 196 USPQ 566 (TTAB 1977); Dow Corning Corp. v. Doric Corp., 192 USPQ 106 (TTAB 1976); Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 USPQ 119 (TTAB 1976); MRI Systems Corp. v. Wesley-Jessen Inc., 189 USPQ 214 (TTAB 1975); and Janet E. Rice, TIPS FROM THE TTAB: Making Documents Obtained During Discovery and Third-Party Registrations of Record, 67 Trademark Rep. 54 (1977).

Listed below are a number of methods by which documents produced in response to a request for production of documents may be made of record:

(1) A party which has obtained documents under FRCP 34 may serve upon its adversary requests for admission of the authenticity of the documents, and then, during its testimony period, file a notice of reliance, under 37 CFR §2.120(j)(3)(i), on the requests for admission, the exhibits thereto, and its adversary's admissions (or a statement that its adversary failed to respond to the requests for admission). However, if a party wishes to have an opportunity to serve requests for admission after obtaining documents under FRCP 34, it must serve its request for production of documents early in the discovery period, so that when it obtains the produced documents, it will have time to prepare and serve requests for admission prior to the expiration of the discovery period. See TBMP §§403.05(a) and 403.05(c).

(2) A party which has obtained documents under FRCP 34 may offer them as exhibits in connection with the taking of its adversary's discovery deposition. Again, however, the request for production of documents must be served early in the discovery period, so that there will still be time remaining therein, after the requested documents have been produced, to notice and take a discovery deposition. See TBMP §§403.05(a) and 403.05(c).

(3) A party which has obtained documents under FRCP 34 may introduce them as exhibits during the cross-examination of its adversary's witness. See Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 USPQ 119 (TTAB 1976). This method is available only if the adversary takes testimony, and the obtained documents pertain to matters within the scope of the direct examination of the witness.

(4) A party which has obtained documents under FRCP 34 may, during its own testimony period, take the testimony of its adversary as an adverse witness,

OLD EDITION

and introduce the obtained documents as exhibits during direct examination. See Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 USPQ 119 (TTAB 1976).

(5) A party which has obtained documents under FRCP 34 may, during its own testimony period, make of record by notice of reliance, under 37 CFR §2.122(e), any of the documents which falls into the category of "printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in a proceeding, and official records, if the publication or official record is competent evidence and relevant to an issue" (see: TBMP sections 707 and 708). See 37 CFR §2.120(j)(3)(ii), and cases cited in the first paragraph of this section.

(6) A party which wishes to obtain documents under FRCP 34 may combine its request for production of documents with a notice of taking discovery deposition, and ask that the requested documents be produced at the deposition. However, the combined request for production and notice of deposition must be served well prior to the date set for the deposition, because a discovery deposition must be both noticed and taken prior to the close of the discovery period, and because FRCP 34(b) allows a party 30 days in which to respond to a request for production of documents (this period is lengthened to 35 days if service of the request is made by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), except that a defendant may serve responses either within 30 days (35 days) after service of the request, or within 45 days after service of the complaint upon it by the Board. See TBMP §§403.05(a) and 403.05(c).

(7) Documents obtained under FRCP 34 may be made of record by stipulation of the parties.

Documents obtained by request for production of documents under FRCP 34, and improperly offered in evidence, may nevertheless be considered by the Board if the nonoffering party (parties) does not object thereto; and/or treats the documents as being of record; and/or in the same manner improperly offers documents which it obtained under FRCP 34. See, for example, Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984); Autac Inc. v. Viking Industries, Inc., 199 USPQ 367 (TTAB 1978); Southwire Co. v. Kaiser Aluminum & Chemical Corp., 196 USPQ 566 (TTAB 1977); Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 USPQ 119 (TTAB 1976). Cf. Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985).

OLD EDITION

Further, documents provided as all or part of an answer to an interrogatory may be made of record, as an interrogatory answer, by notice of reliance filed in accordance with 37 CFR §§2.120(j)(3)(i) and 2.120(j)(5). See M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990), and Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986).

For information concerning the obtaining of discovery by way of a request for production of documents, see TBMP §§408 and 409.

NOTE: Most of the cases cited in this section preceded 37 CFR §2.120(j)(3)(ii).

OLD EDITION

712 Judicial Notice

37 CFR §2.122(a) Rules of Evidence. The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.

FRE 201. Judicial Notice of Adjudicative Facts
(a) Scope of rule. This rule governs only judicial notice of adjudicative facts.

(b) Kinds of facts. A judicially noticed fact must be one not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned.

(c) When discretionary. A court may take judicial notice, whether requested or not.

(d) When mandatory. A court shall take judicial notice if requested by a party and supplied with the necessary information.

(e) Opportunity to be heard. A party is entitled upon timely request to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken.

(f) Time of taking notice. Judicial notice may be taken at any stage of the proceeding.

In appropriate instances, the Board may take judicial notice of adjudicative facts. See 37 CFR §2.122(a) and FRE 201.

712.01 Kind of Fact Which May be Judicially Noticed

The only kind of fact which may be judicially noticed by the Board is a fact which is "not subject to reasonable dispute in that it is either (1) generally known within the territorial jurisdiction of the trial court or (2) capable of accurate and ready determination by resort to sources whose accuracy cannot reasonably be questioned." See FRE 201(b). See also, for example, B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); Omega SA v. Compucorp, 229 USPQ 191 (TTAB 1985); and United States National Bank of Oregon v. Midwest Savings and Loan Ass'n, 194 USPQ 232 (TTAB 1977).

For examples of decisions concerning whether particular facts are appropriate subject matter for judicial notice by the Board, see B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988) (dictionary definition of term as trademark--yes, indicates mark is reasonably famous; also, encyclopedias may be consulted); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977) (home cold permanent wave kits have for many years been sold directly to nonprofessional consumers through retail outlets--yes); Pinocchio's Pizza Inc. v. Sandra Inc., 11 USPQ2d 1227 (TTAB 1989) (Catonsville, Maryland is located between Baltimore, Maryland and Washington, D.C.--yes); Los Angeles Bonaventure Co. v. Bonaventure Associates, 4 USPQ2d 1882 (TTAB 1987) (whether other companies have expanded from restaurant services to hotel services under a single mark, and, if so, when--no); Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986) (files of applications and/or registrations, where no copies thereof are filed, and they are not the subject of the proceeding--no); Hertz System, Inc. v. A-Drive Corp., 222 USPQ2d 625 (TTAB 1984) (the numeral "1" is widely used to indicate superiority--yes); Abbott Laboratories v.

OLD EDITION

Tac Industries, Inc., 217 USPQ 819 (TTAB 1981) (use of antimicrobial agents in the floor covering industry--no); University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983) (dictionary definitions--yes); Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981) (dictionary definitions--yes); Sprague Electric Co. v. Electrical Utilities Co., 209 USPQ 88 (TTAB 1980) (standard reference works--yes); General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc., 204 USPQ 396 (TTAB 1979), aff'd, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981) (frequent use of famous marks on collateral products such as clothing, glassware, trash cans, etc.--yes); Cities Service Co. v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978) (third-party registrations and listings in trade directories, where no copies thereof are submitted--no); Quaker Oats Co. v. Acme Feed Mills, Inc., 192 USPQ 653 (TTAB 1976) (law of any jurisdiction, when a copy thereof is submitted under notice of reliance--yes); Plus Products v. Sterling Food Co., 188 USPQ 586 (TTAB 1975) (food supplements and fortifiers are commonly used in producing bakery products--yes); and Bristol-Myers Co. v. Texize Chemicals, Inc., 168 USPQ 670 (TTAB 1971) (operations of opposer and applicant--no).

OLD EDITION

712.02 When Discretionary

The Board, in its discretion, may take judicial notice of a fact not subject to reasonable dispute, as defined in FRE 201(b), whether or not it is requested to do so. See FRE 201(c). See also United States National Bank of Oregon v. Midwest Savings and Loan Ass'n, 194 USPQ 232 (TTAB 1977), and Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976).

712.03 When Mandatory

The Board will take judicial notice of a fact not subject to reasonable dispute, as defined in FRE 201(b), if a party (1) requests that the Board do so, and (2) supplies the necessary information. See FRE 201(d). See also United States National Bank of Oregon v. Midwest Savings and Loan Ass'n, 194 USPQ 232 (TTAB 1977), and Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976). The request should be made during the requesting

party's testimony period, by notice of reliance accompanied by the necessary information. See Litton Business Systems, Inc. v. J. G. Furniture Co., supra. See also Wright Line Inc. v. Data Safe Services Corp., 229 USPQ 769 (TTAB 1985), and Sprague Electric Co. v. Electrical Utilities Co., 209 USPQ 88 (TTAB 1980).

712.04 Opportunity to be Heard

A party to a proceeding before the Board is entitled, upon timely request, "to an opportunity to be heard as to the propriety of taking judicial notice and the tenor of the matter noticed. In the absence of prior notification, the request may be made after judicial notice has been taken." See FRE 201(e). See also Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976). This does not mean, however, that when judicial notice is taken without prior notification, a party is automatically entitled to a hearing upon request, even if it makes no offer to show that the taking of judicial notice was improper. See In re Sarkli, Ltd., 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983). See also Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981).

712.05 Time of Taking Notice

Judicial notice may be taken at any stage of a Board proceeding, even at the time of decision on appeal from the Board's decision therein. See, for example, FRE 201(f); B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988); Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); American Security Bank v. American Security and Trust Co., 571 F.2d 564, 197 USPQ 65 (CCPA 1978); Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977); and Food Specialty Co. v. Kal Kan Foods, Inc., 487 F.2d 1389, 180 USPQ 136 (CCPA 1973).

713 Oral Depositions

713.01 In General

OLD EDITION

A testimony deposition is a device used by a party to a Board inter partes proceeding to present evidence in support of its case. During a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness testifying (either willingly or under subpoena) in behalf of the party. See TBMP §404.02, and authorities cited therein.

Testimony depositions are the means by which a party may introduce into the record not only the testimony of its witnesses, but also those documents and other exhibits which may not be made of record by notice of reliance. See TBMP §§703 and 707-711, describing types of evidence admissible by notice of reliance. However, only evidence admissible under the applicable rules of evidence may properly be adduced during a testimony deposition; inadmissibility is a valid ground for objection. See 37 CFR §§2.122(a) and 2.123(k), and TBMP §718.03.

The Board does not preside at the taking of testimony. Rather, testimony is taken out of the presence of the Board, upon oral examination or written questions, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board. See TBMP §702. See also TBMP §502.01.

For a comparison of testimony depositions and discovery depositions, see TBMP §404.02.

OLD EDITION

713.02 Form of Testimony

37 CFR §2.123(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by §2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate what a particular witness would testify to if called, or the facts in the case of any party may be stipulated.

Ordinarily, the testimony of a witness may be taken either upon oral examination pursuant to 37 CFR §2.123, or by deposition upon written questions pursuant to 37 CFR §2.124. See 37 CFR §2.123(a)(1). For information concerning depositions upon written questions, see TBMP §714.

However, if a party serves notice of the taking of a testimony deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. See 37 CFR §2.123(a)(1). See also Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990); Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); and TBMP §532.

In addition, a testimony deposition taken in a foreign country must be taken by deposition upon written questions, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate. See 37 CFR §2.123(a)(2). See also TBMP §520. Cf. 37 CFR §2.120(c)(1); TBMP §404.03(c)(1); and Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989).

By agreement of the parties, the testimony of any witness or witnesses of any party may be submitted in the form of an affidavit by such witness or witnesses.

OLD EDITION

See 37 CFR §2.123(b). See also Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989); Chase Manhattan Bank, N.A. v. Life Care Services Corp., 227 USPQ 389 (TTAB 1985); Oxy Metal Industries Corp. v. Transene Co., 196 USPQ 845 (TTAB 1977); and National Distillers and Chemical Corp. v. Industrial Condenser Corp., 184 USPQ 757 (TTAB 1974). The parties may also stipulate the facts in the case of any party, or what a particular witness would testify to if called, or that a party may use a discovery deposition as testimony. See 37 CFR §2.123(b). See also Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990), and Oxy Metal Industries Corp. v. Transene Co., 196 USPQ 845 (TTAB 1977).

713.03 Time for Taking Testimony

A party which desires to take testimony may do so only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. See 37 CFR §2.121(a)(1). See also TBMP §701 and authorities cited therein.

For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP §§509 and 701.

713.04 Time and Place of Deposition

37 CFR §2.123(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by §2.124, unless the Board, upon

OLD EDITION

motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

* * *

(c) Notice of examination of witnesses. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.

A testimony deposition may be noticed for any reasonable time during the deposing party's testimony period. See 37 CFR §2.123(c). A testimony deposition may not be taken outside the deposing party's testimony period except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. See 37 CFR §2.121(a)(1). See also TBMP §701 and authorities cited therein. Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to the opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

A testimony deposition to be taken in the United States may be noticed for any reasonable place. See 37 CFR §2.123(c).

A deposition may not be noticed for a place in a foreign country, unless the deposition is to be taken upon written questions as provided by 37 CFR §2.124, or unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See 37 CFR §§2.123(a)(2) and 2.123(c). See also TBMP §713.02.

OLD EDITION

A party may not take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available. See 37 CFR §2.123(c).

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. See 37 CFR §2.123(b).

713.05 Notice of Deposition

37 CFR §2.123(c) Notice of examination of witnesses. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.

Before the oral depositions of witnesses may be taken by a party, the party must give due (i.e., reasonable) notice in writing to every adverse party. See 37 CFR §2.123(c). See also Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990); and Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982). Cf. TBMP §404.04.

The notice must specify the time and place the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be examined. If the name of a witness is not known, the notice must include a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation. See 37 CFR §2.123(c). See also Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3

OLD EDITION

USPQ2d 1708 (TTAB 1984); O. M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976); and Allstate Life Insurance Co. v. Cuna International, Inc., 169 USPQ 313 (TTAB 1971), aff'd without opinion, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973). Cf. TBMP §404.04.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. See 37 CFR §2.123(b).

Ordinarily, a notice of oral deposition need not be filed with the Board, except as part of the completed deposition. See Rany L. Simms, TIPS FROM THE TTAB: Whether and When to File Papers During Trademark Proceedings, 67 Trademark Rep. 175 (1977), and 37 CFR §2.123(f). However, if a certified copy of the notice of deposition is, for some reason, required for use before a Federal district court, the notice of deposition must be filed with the Board for purposes of certification. See TBMP §§123 and 713.06(b).

For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see 37 CFR §2.123(e)(3) and TBMP §534.01.

OLD EDITION

713.06 Securing Attendance of Unwilling Witness

713.06(a) In General

Normally, during a party's testimony period, testimony depositions are taken, by or on behalf of the party, of the party himself or herself (if the party is an individual), or of an official or employee of the party, or of some other witness who is willing to appear voluntarily to testify on behalf of the party. These testimony depositions may be taken, at least in the United States, on notice alone.

However, where a party wishes to take the testimony of an adverse party or nonparty, or an official or employee of an adverse party or nonparty, and the proposed witness is not willing to appear voluntarily to testify, the deposition may not be taken on notice alone. Rather, the party which wishes to take the deposition must take steps, discussed below, to compel the attendance of the witness. If the witness resides in a foreign country, the party may not be able to

take the deposition. See Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 396-397 (1985); Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985); and TBMP §§713.06(b), 713.06(c), and 713.07. See also Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52 (TTAB 1983), aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984).

713.06(b) Unwilling Witness Residing in United States

If a party wishes to take the trial testimony of an adverse party or nonparty (or an official or employee of an adverse party or nonparty) residing in the United States, and the proposed witness is not willing to appear voluntarily to testify, the party wishing to take the testimony must secure the attendance of the witness by subpoena. See Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). Cf. TBMP §404.03(b)(2).

The subpoena must be issued, pursuant to 35 U.S.C. §24 and FRCP 45, from the United States district court in the Federal judicial district where the witness resides or is regularly employed. If, for any reason, a certified copy of the notice of deposition is required in connection with the subpoena, such as for purposes of a motion to quash the subpoena, or a motion to enforce the subpoena, the interested party should contact the clerk of the court to determine whether the court will require a formal certified copy (i.e., a certified copy bearing a PTO seal) of the notice, or will accept a Board verification letter (see TBMP §123.03). A certified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and certified by the PTO as being a true copy of the notice of deposition filed in the proceeding before the Board. A verified copy of a notice of deposition is a copy prepared by the party noticing the deposition, and verified by the Board as being a true copy of the notice of deposition filed in the Board proceeding. A copy of a notice of deposition cannot be certified by the PTO, or

OLD EDITION

verified by the Board, unless it has been filed in the Board proceeding. See Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985), and TBMP §123. For further information relating to PTO certification or Board verification of a notice of deposition, see TBMP §123.

If a person named in a subpoena compelling attendance at a testimony deposition fails to attend the deposition, or refuses to answer a question propounded at the deposition, the deposing party must seek enforcement from the United States district court which issued the subpoena. Similarly, any request to quash a subpoena must be directed to the United States district court which issued the subpoena. The Board has no jurisdiction over depositions by subpoena. See, for example, Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987); In re Johnson & Johnson, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973); PRD Electronics Inc. v. Pacific Roller Die Co., 169 USPQ 318 (TTAB 1971); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 396-397 (1985); and Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985).

OLD EDITIONS

713.06(c) Unwilling Witness Residing in Foreign Country

There is no certain procedure for obtaining, in a Board inter partes proceeding, the trial testimony deposition of a witness who resides in a foreign country, is an adverse party or a nonparty (or an official or employee of an adverse party or nonparty), and is not willing to appear voluntarily to testify. However, the deposing party may be able to obtain the testimony deposition of such a witness through the letter rogatory procedure or the Hague Convention letter of request procedure. See Rany L. Simms, TIPS FROM THE TTAB: Compelling the Attendance of a Witness in Proceedings Before the Board, 75 Trademark Rep. 296 (1985). For information concerning these procedures, see TBMP §404.03(c)(2).

713.07 Persons Before Whom Depositions May be Taken

37 CFR §2.123(d) Persons before whom depositions may be taken. Depositions may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure.

FRCP 28. Persons Before Whom Depositions May Be Taken
(a) Within the United States. Within the United States or within a territory or insular possession subject to the jurisdiction of the United States, depositions shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the examination is held, or before a person appointed by the court in which the action is pending. A person so appointed has power to administer oaths and take testimony. The term officer as used in Rules 30, 31 and 32 includes a person appointed by the court or designated by the parties under Rule 29.

(b) In Foreign Countries. Depositions may be taken in a foreign country (1) pursuant to any applicable treaty or convention, or (2) pursuant to a letter of request (whether or not captioned a letter rogatory), or (3) on notice before a person authorized to administer oaths in the place where the examination is held, either by the law thereof or by the law of the United States, or (4) before a person commissioned by the court, and a person so commissioned shall have the power by virtue of the commission to administer any necessary oath and take testimony. A commission or a letter of request shall be issued on application and notice and on terms that are just and appropriate. It is not requisite to the issuance of a commission or a letter of request that the taking of the deposition in any other manner is impracticable or inconvenient; and both a commission and a letter of request may be issued in proper cases. A notice of commission may designate the person before whom the deposition is to be taken either by name or descriptive title. A letter of request may be addressed "To the Appropriate Authority in [here name the country]." When a letter of request or any other device is used pursuant to any applicable treaty or convention, it shall be captioned in the form prescribed by that treaty or convention. Evidence obtained in response to a letter of request need not be excluded merely because it is not a verbatim transcript, because the testimony was not taken under oath, or because of any similar departure from the requirements for depositions taken within the United States under these rules.

(c) Disqualification for Interest. No deposition shall be taken before a person who is a relative or employee or attorney or counsel of any of the parties, or is a relative or employee of such attorney or counsel, or is financially interested in the action.

OLD EDITION

Depositions in Board inter partes proceedings may be taken before the persons described in FRCP 28. See 37 CFR §2.123(d).

Thus, in the United States (or in any territory or insular possession subject to the jurisdiction of the United States) a Board proceeding testimony deposition "shall be taken before an officer authorized to administer oaths by the laws of the United States or of the place where the deposition is held, or before a person appointed by the court in which the action is pending." See FRCP 28(a). As a practical matter, Board proceeding depositions taken in the United States are usually taken before a court reporter who is authorized to administer oaths in the jurisdiction where the deposition is taken.

In a foreign country, a Board proceeding testimony deposition may be taken pursuant to FRCP 28(b). This means, for example, that a Board proceeding testimony deposition taken of a willing witness in a foreign country usually may be taken on notice before a United States consular official, or before anyone authorized by the law of the foreign country to administer oaths therein. Some countries, however, may prohibit the taking of testimony within their boundaries for use in any other country, including the United States, even though the witness is willing; or may permit the taking of testimony only if certain procedures are followed. See Wright & Miller, Federal Practice and Procedure: Civil §2083 (1970). A party which wishes to take a testimony deposition in a foreign country should first consult with local counsel in the foreign country, and/or with the Office of Citizens Consular Services, Department of State, in order to determine whether the taking of the deposition will be permitted by the foreign country, and, if so, what procedure must be followed. The testimony of an unwilling adverse party or nonparty witness may be taken in a foreign country, if at all, only by the letter rogatory procedure, or by the letter of request procedure provided under the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters, or by any other procedure provided for the purpose by any future treaty into which the United States may enter. Cf. TBMP §§404.03(c)(2) and 713.06(c).

If the parties so stipulate in writing (and if permitted by the laws of the foreign country, in the case of a deposition to be taken in a foreign country), a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. See 37 CFR §2.123(b).

OLD EDITION

713.08 Examination of Witnesses

37 CFR §2.123(e) Examination of witnesses. (1) Each witness before testifying shall be duly sworn according to law by the officer before whom his deposition is to be taken.

(2) The deposition shall be taken in answer to questions, with the questions and answers recorded in their regular order by the officer, or by some other person (who shall be subject to the provisions of Rule 28 of the Federal Rules of Civil Procedure) in the presence of the officer except when the officer's presence is waived on the record by agreement of the parties. The testimony shall be taken stenographically and transcribed, unless the parties present agree otherwise. In the absence of all opposition parties and their attorneys or other authorized representatives, depositions may be taken in longhand, typewriting, or stenographically. Exhibits which are marked and identified at the deposition will be deemed to have been offered into evidence, without any formal offer thereof, unless the intention of the party marking the exhibits is clearly to the contrary.

(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

OLD EDITION

FRCP 30(b)(7) The parties may stipulate in writing or the court may upon motion order that a deposition be taken by telephone or other remote electronic means. For the purposes of this rule and Rules 28(a), 37(a)(1), and 37(b)(1) a deposition taken by such means is taken in the district and at the place where the deponent is to answer questions.

Before testifying, a witness whose testimony deposition is being taken for use in a Board inter partes proceeding must be duly sworn, according to law, by the officer before whom the deposition is to be taken. See 37 CFR §2.123(e)(1). See also TBMP §713.07.

The deposition is taken in answer to questions, and the questions and answers are recorded in order by the officer, or by some other person (who is subject to the provisions of FRCP 28) in the presence of the officer, except when the officer's presence is waived on the record by agreement of the parties. The testimony is taken stenographically and transcribed, unless the parties present agree otherwise. If no adverse party, or its attorney or other authorized representative, attends the deposition, the testimony may be taken in longhand, typewriting, or stenographically. See 37 CFR §2.123(e)(2).

The Board does not accept videotape depositions. A deposition must be submitted to the Board in written form. However, a videotape of a commercial, demonstration, etc., may be submitted as an exhibit to the testimony of a witness.

Upon stipulation of the parties, or upon motion granted by the Board, a deposition may be taken or attended by telephone. See FRCP 30(b)(7), and Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991). A deposition taken by telephone is taken in the district and at the place where the witness is to answer the questions propounded to him or her.

Exhibits which are marked and identified at the deposition will be deemed to have been offered in evidence, even if no formal offer thereof is made, unless the intention of the party marking the exhibits is clearly to the contrary. See 37 CFR 2.123(e)(2). See also Tiffany & Co. v. Classic Motor Carriages Inc., 10 USPQ2d 1835 (TTAB 1989) (decided just prior to adoption of the present rule).

If exhibits are large, bulky, valuable, or breakable, the Board strongly prefers that they be photographed (or, in the case of documents, photocopied), and that the photographs (or photocopies) be filed with the Board in lieu of the originals. The originals should, of course, be shown to every adverse party. If an original

OLD EDITION

exhibit does not photograph (or photocopy) well, and one of the parties intends to request that an oral hearing be held on the case, the parties may agree that the original be carried to the oral hearing and given to the Board at that time. See Gary D. Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980). The Board cannot be responsible for the safekeeping and/or safe return of original exhibits which are large, bulky, valuable, or breakable.

Every adverse party must be given a full opportunity to cross-examine the witness. If the notice of deposition served by a party is improper or inadequate with respect to the witness, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. See 37 CFR §2.123(e)(3). For information concerning the raising of an objection to a testimony deposition on the ground of improper or inadequate notice, see 37 CFR §2.123(e)(3), and TBMP §§534.02 and 718.03(b).

All objections made at the time of the taking of a testimony deposition as to the qualifications of the officer taking the deposition, the manner of taking the deposition, the evidence presented, the conduct of any party, or any other objection to the proceedings, are noted by the officer upon the deposition. Evidence objected to is taken subject to the objections. See 37 CFR §2.123(e)(4). See also TBMP §718.03.

Questions to which an objection is made ordinarily should be answered subject to the objection, but a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. See TBMP §404.02, and authorities cited therein. For information concerning the propounding party's recourse if a witness not only objects to, but also refuses to answer, a particular question, see TBMP §§404.02 and 718.03(d), and authorities cited therein.

For further information concerning the raising of objections to testimony depositions, see TBMP §§534 and 718.03, and authorities cited therein.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like any other deposition. See 37 CFR §2.123(b).

OLD EDITION

713.09 Form of Deposition

37 CF R §2.123(g) F orm of deposition. (1) The pages of each deposition must be numbered consecutively, and the name of the witness plainly and conspicuously written at the top of each page. The deposition may be written on legal-size or letter-size paper, with a wide margin on the left hand side of the page, and with the writing on one side only of the sheet. The questions propounded to each witness must be consecutively numbered unless paper with numbered lines is used, and each question must be followed by its answer.

(2) Exhibits must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit. Entry and consideration may be refused to improperly marked exhibits.

(3) Each deposition must contain an index of the names of the witnesses, giving the pages where their examination and cross-examination begin, and an index of the exhibits, briefly describing their nature and giving the pages at which they are introduced and offered in evidence.

37 CF R §2.125(d) Each transcript shall comply with §2.123(g) with respect to arrangement, indexing and form.

A deposition must be submitted to the Board in written form. The Board does not accept videotape depositions.

The particular requirements for the form of a written deposition are specified in 37 CFR §2.123(g).

Although 37 CFR §2.123(g)(1) provides, inter alia, that a deposition may be written on either legal-size or letter-size paper, letter-size is recommended, because the case may ultimately be appealed to a Federal court which requires letter-size paper.

Exhibits must be marked as specified in 37 CFR §2.123(g)(2). The Board, in its discretion, may refuse to enter and consider improperly marked exhibits. See 37 CFR §2.123(g)(2); Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984); and G. Douglas Hohein, TIPS FROM THE TTAB: Potpourri, 71 Trademark Rep. 163 (1981).

OLD EDITION

For information concerning deposition objections based on errors or irregularities in form, see TBMP §718.03(c).

713.10 Signature of Deposition by Witness

37 CFR §2.123(e)(5) When the deposition has been transcribed, the deposition shall be carefully read over by the witness or by the officer to him, and shall then be signed by the witness in the presence of any officer authorized to administer oaths unless the reading and the signature be waived on the record by agreement of all parties.

The signature of a deposition by the witness is governed by 37 CFR §2.123(e)(5). The deposition does not have to be signed in the presence of the officer before whom the deposition was taken. It may be signed in the presence of any officer authorized to administer oaths.

Reading and signature cannot be waived by mere agreement of the witness; the agreement of every party is required. See 37 CFR §2.123(e)(5), and Gary D. Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980).

OLD EDITION

713.11 Certification and Filing of Deposition by Officer

37 CFR §2.123(f) Certification and filing by officer. The officer shall annex to the deposition his certificate showing:

(1) Due administration of the oath by the officer to the witness before the commencement of his deposition;

(2) The name of the person by whom the deposition was taken down, and whether, if not taken down by the officer, it was taken down in his presence;

(3) The presence or absence of the adverse party;

(4) The place, day, and hour of commencing and taking the deposition;

(5) The fact that the officer was not disqualified as specified in Rule 28 of the Federal Rules of Civil Procedure.

If any of the foregoing requirements are waived, the certificate shall so state. The officer shall sign the certificate and affix thereto his seal of office, if he has such a seal. Unless waived on the record by an agreement, he shall then, without delay, securely seal in an envelope all the evidence, notices, and paper exhibits, inscribe upon the envelope a certificate giving the number and title of the case, the name of each witness, and the date of sealing, address the package, and forward the same to the Commissioner of Patents and Trademarks. If the weight or bulk of an exhibit shall exclude it from the envelope, it shall, unless waived on the record by agreement of all parties, be authenticated by the officer and transmitted in a separate package marked and addressed as provided in this section.

37 CFR §2.125 Filing and service of testimony.
(a) One copy of the transcript of testimony taken in accordance with §2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

* * *

(c) One certified transcript and exhibits shall be filed promptly with the Trademark Trial and Appeal Board. Notice of such filing shall be served on each adverse party and a copy of each notice shall be filed with the Board.

The certification and filing of a deposition are governed by 37 CFR §2.123(f). The certified transcript, with exhibits, should be sent to the Board at its mailing address for papers not accompanied by a fee, i.e., BOX TTAB NO FEE, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

The certified transcript and exhibits must be filed promptly with the Board. See 37 CFR §2.125(c), and Hewlett-Packard Co. v. Human Performance

OLD EDITION

Measurement, Inc., 23 USPQ2d 1390 (TTAB 1991). A notice of reliance thereon need not (and should not) be filed. See, for example, Paramount Pictures Corp. v. Romulan Invasions, 7 USPQ2d 1897 (TTAB 1988), and Entex Industries, Inc. v. Milton Bradley Co., 213 USPQ 1116 (TTAB 1982). However, notice of the filing of the certified transcript, and accompanying exhibits, with the Board must be served on each adverse party. A copy of each such notice must also be filed with the Board. See 37 CFR §2.125(c). In addition, one copy of the deposition transcript, together with copies, duplicates, or photographs of the exhibits thereto, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. See 37 CFR 2.125(a). For information concerning the remedy which an adverse party may have if it is not timely served with a copy of the deposition and exhibits, see TBMP §713.13.

If a party which took a deposition discovers that the officer has inadvertently failed to send the certified transcript, with exhibits, to the Board, the party should contact the officer and arrange for the immediate filing of the deposition with the Board. See Gary D. Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980).

If the officer, by mistake, sends the certified deposition and exhibits to the party which took the deposition, or its attorney or other authorized representative, rather than to the Board, the party, or its attorney or other authorized representative, should, without delay, forward them to the Board, or return them to the officer for immediate transmittal to the Board.

OLD EDITION

713.12 Testimony Deposition Must be Filed

37 CFR §2.123(h) Depositions must be filed. All depositions which are taken must be duly filed in the Patent and Trademark Office. On refusal to file, the Office at its discretion will not further hear or consider the contestant with whom the refusal lies; and the Office may, at its discretion, receive and consider a copy of the withheld deposition, attested by such evidence as is procurable.

All trial testimony depositions that are taken in a Board inter partes proceeding must be filed with the Board, and, when filed, automatically constitute part of the evidentiary record in the proceeding. See 37 CFR §2.123(h). See also, for example, Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23

USPQ2d 1390 (TTAB 1991); Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984); and An Evening at the Trotters, Inc. v. A Nite at the Races, Inc., 214 USPQ 737 (TTAB 1982). If a party which took a testimony deposition refuses to file it, the Board, in its discretion, may refuse to further hear or consider the party, or may receive and consider a copy of the withheld deposition, attested by such evidence as is procurable. See 37 CFR §2.123(h).

713.13 Service of Deposition

37 CFR §2.125 Filing and service of testimony.
(a) One copy of the transcript of testimony taken in accordance with §2.123, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be served on each adverse party within thirty days after completion of the taking of that testimony. If the transcript with exhibits is not served on each adverse party within thirty days or within an extension of time for the purpose, any adverse party which was not served may have remedy by way of a motion to the Trademark Trial and Appeal Board to reset such adverse party's testimony and/or briefing periods, as may be appropriate. If the deposing party fails to serve a copy of the transcript with exhibits on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may strike the deposition, or enter judgment as by default against the deposing party, or take any such other action as may be deemed appropriate.

One copy of the transcript of trial testimony, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, must be served on each adverse party within 30 days after completion of the taking of the testimony, or within an extension of time for the purpose. See 37 CFR §2.125(a).

The requirement that a copy of the transcript, with exhibits, be served upon every adverse party within the time specified in 37 CFR §2.125(a) is intended to ensure that each adverse party will have the testimony before it has to offer its own evidence, or, if the testimony in question is rebuttal testimony, to ensure that each adverse party will have the testimony before it has to prepare its brief on the case. See Techex, Ltd. v. Dvorkovitz, 220 USPQ 81 (TTAB 1983), and S. S. Kresge Co. v. J-Mart Industries, Inc., 178 USPQ 124 (TTAB 1973). If a copy of the transcript, with exhibits, is not served on each adverse party within that time, any

OLD EDITION

adverse party which was not served may have remedy by way of a motion to the Board to reset its testimony and/or briefing periods, as may be appropriate. See 37 CFR 2.125(a), and Techex, Ltd. v. Dvorkovitz, supra.

If a party which took a deposition fails to serve a copy of the transcript, with exhibits, on an adverse party after having been ordered to do so by the Board, the Board, in its discretion, may take any of the actions mentioned in 37 CFR §2.125(a).

713.14 Correction of Errors in Deposition

37 CFR §2.125(b) The party who takes testimony is responsible for having all typographical errors in the transcript and all errors of arrangement, indexing and form of the transcript corrected, on notice to each adverse party, prior to the filing of one certified transcript with the Trademark Trial and Appeal Board. The party who takes testimony is responsible for serving on each adverse party one copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served.

A party which takes testimony is responsible for having any errors in the transcript corrected, on notice to each adverse party, prior to the filing of the certified transcript with the Board. See 37 CFR §2.125(b), and Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23 USPQ2d 1390 (TTAB 1991).

If the witness, upon reading the transcript, discovers that typographical or editorial corrections need to be made, or that other corrections are necessary to make the transcript an accurate record of what the witness actually said during the taking of his or her testimony, the witness should make a list of all such corrections and forward the list to the officer before whom the deposition was taken. The officer, in turn, should correct the transcript by redoing the involved pages. Alternatively, if there are not many corrections to be made, the witness may correct the transcript by writing each correction above the original text which it corrects, and initialing the correction. Although parties sometimes attempt to correct errors in transcripts by simply inserting a list of corrections at the end of the transcript, this is not an effective method of correction. The Board does not enter corrections for litigants, and the list of corrections is likely to be overlooked and/or disregarded.

OLD EDITION

If corrections are necessary, the party which took the deposition must serve on every adverse party a copy of the corrected transcript or, if reasonably feasible, corrected pages to be inserted into the transcript previously served. See 37 CFR §2.125(b). See also Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23 USPQ2d 1390 (TTAB 1991).

If errors are discovered after the transcript has been filed with the Board, a list of corrections, signed by the witness, should be submitted to the Board (and served upon every adverse party), together with a request for leave to correct the errors. Alternatively, the parties may stipulate that specified corrections may be made. If the request is granted, or if the parties so stipulate, the party which took the deposition should send a representative to the offices of the Board to make the listed corrections by writing them above the original text in the transcript. See: Gary D. Krugman, TIPS FROM THE TTAB: Testimony Depositions, 70 Trademark Rep. 353 (1980).

While typographical and editorial corrections may be made in a transcript, as well as other corrections necessary to make the transcript an accurate record of what the witness said during the taking of his or her testimony, material changes in the text are not permitted--the transcript may not be altered to change the testimony of the witness after the fact. See Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992); Cadence Industries Corp. v. Kerr, 225 USPQ 331 (TTAB 1985); Entex Industries, Inc. v. Milton Bradley Co., 213 USPQ 1116 (TTAB 1982).

OLD EDITION

713.15 Objections to Testimony Depositions

For information concerning objections to testimony depositions, see TBMP §718.03. See also TBMP §534.

713.16 Confidential or Trade Secret Material

37 CFR 2.125(e) Upon motion by any party, for good cause, the Trademark Trial and Appeal Board may order that any part of a deposition transcript or any exhibits that directly disclose any trade secret or other confidential research, development, or commercial information may be filed under seal and kept

confidential under the provisions of §2.27(e). If any party or any attorney or agent of a party fails to comply with an order made under this paragraph, the Board may impose any of the sanctions authorized by §2.120(g).

Cf. 37 CFR §2.120(f), and TBMP §§120.03, 416, 526, and 527.01.

714 Depositions Upon Written Questions

714.01 When Available

714.01(a) For Testimony

37 CFR §2.123(a)(1) The testimony of witnesses in inter partes cases may be taken by depositions upon oral examination as provided by this section or by depositions upon written questions as provided by §2.124. If a party serves notice of the taking of a testimonial deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States or any territory which is under the control and jurisdiction of the United States, any adverse party may, within fifteen days from the date of service of the notice, file a motion with the Trademark Trial and Appeal Board, for good cause, for an order that the deposition be taken by oral examination.

(2) A testimonial deposition taken in a foreign country shall be taken by deposition upon written questions as provided by §2.124, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate.

(b) Stipulations. If the parties so stipulate in writing, depositions may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner, and when so taken may be used like other depositions. By agreement of the parties, the testimony of any witness or witnesses of any party, may be submitted in the form of an affidavit by such witness or witnesses. The parties may stipulate what a particular witness would testify to if called, or the facts in the case of any party may be stipulated.

Ordinarily, the testimony of a witness may be taken either upon oral examination pursuant to 37 CFR §2.123, or by deposition upon written questions pursuant to

OLD EDITION

37 CFR §2.124. See 37 CFR §2.123(a)(1). For information concerning depositions upon oral examination, see TBMP §713.

However, if a party serves notice of the taking of a testimony deposition upon written questions of a witness who is, or will be at the time of the deposition, present within the United States (or any territory which is under the control and jurisdiction of the United States), any adverse party may, within 15 days from the date of service of the notice (20 days if service of the notice was by first-class mail, "Express Mail," or overnight courier--see 37 CFR §2.119(c)), file a motion with the Board, for good cause, for an order that the deposition be taken by oral examination. See 37 CFR §2.123(a)(1), and TBMP §713.02 and cases cited therein.

In addition, a testimony deposition taken in a foreign country must be taken by deposition upon written questions, unless the Board, upon motion for good cause, orders that the deposition be taken by oral examination, or the parties so stipulate. See 37 CFR §2.123(a)(2), and TBMP §713.02 and cases cited therein.

OLD EDITION

714.01(b) For Discovery

37 CFR §2.120(c) Discovery deposition in foreign countries.
(1) The discovery deposition of a natural person residing in a foreign country who is a party or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Rule 30(b)(6) or Rule 31(a) of the Federal Rules of Civil Procedure, shall, if taken in a foreign country, be taken in the manner prescribed by §2.124 unless the Trademark Trial and Appeal Board, upon motion for good cause, orders or the parties stipulate, that the deposition be taken by oral examination.

(2) Whenever a foreign party is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, such party may be deposed by oral examination upon notice by the party seeking discovery. Whenever a foreign party has or will have, during a time set for discovery, an officer, director, managing agent, or other person who consents to testify on its behalf, present within the United States or any territory which is under the control and jurisdiction of the United States, such officer, director, managing agent, or other person who consents to testify in its behalf may be deposed by oral examination upon notice by the party

seeking discovery. The party seeking discovery may have one or more officers, directors, managing agents, or other persons who consent to testify on behalf of the adverse party, designated under Rule 30(b)(6) of the Federal Rules of Civil Procedure. The deposition of a person under this paragraph shall be taken in the Federal judicial district where the witness resides or is regularly employed, or, if the witness neither resides nor is regularly employed in a Federal judicial district, where the witness is at the time of the deposition. This paragraph does not preclude the taking of a discovery deposition of a foreign party by any other procedure provided by paragraph (c)(1) of this section.

Ordinarily, a discovery deposition may be taken either upon oral examination or upon written questions. See FRCP 26(a). See also TBMP §404.02.

However, the discovery deposition of a natural person who resides in a foreign country, and who is a party (or who, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or FRCP 31 (a) to testify on behalf of a party), may be taken in a foreign country only upon written questions, in the manner described in 37 CFR §2.124, unless the Board, upon motion for good cause, orders, or the parties stipulate, that the deposition be taken by oral examination. See 37 CFR §2.120(c)(1). See also TBMP §404.03(c)(1) and authorities cited therein.

If a natural person who is a foreign party (or an officer, director, or managing agent of a foreign party, or some other person who consents to testify on a foreign party's behalf) is or will be, during a time set for discovery, present within the United States or any territory which is under the control and jurisdiction of the United States, the party, officer, director, managing agent, or other person may be deposed, while in the United States, by oral examination upon notice by the party seeking discovery. See 37 CFR §2.120(c)(2). See also TBMP §404.03(c)(1) and authorities cited therein. However, the Board will not order a natural person residing in a foreign country to come to the United States for the taking of his or her deposition. See TBMP §404.03(c)(1) and cases cited therein.

The discovery deposition of a natural person who resides in a foreign country, and is not a party (or an officer, director, or managing agent of a party, or a person designated under FRCP 30(b)(6) or 31 (a) to testify on behalf of a party), but is willing to appear voluntarily to be deposed, may be taken in the same manner as the discovery deposition of a natural person who resides in a foreign

OLD EDITION

country and who is a party. See TBMP §404.03(c)(2). If such a person is not willing to appear voluntarily to be deposed, his or her discovery deposition may be obtained, if at all, only through the letter rogatory procedure or the Hague Convention letter of request procedure. See TBMP §404.03(c)(2).

714.02 Persons Before Whom Depositions May be Taken

37 CFR §2.124(a) A deposition upon written questions may be taken before any person before whom depositions may be taken as provided by Rule 28 of the Federal Rules of Civil Procedure.

A deposition upon written questions, like a deposition upon oral examination, may be taken before the persons described in FRCP 28. See 37 CFR §2.124(a). For further information, see TBMP §713.07.

714.03 Securing Attendance of Unwilling Witness

For information concerning securing the attendance of an unwilling witness, see TBMP §404.03 (for discovery deposition) and 713.06 (for testimony deposition).

714.04 Time for Taking Deposition

37 CFR §2.121 Assignment of times for taking testimony.
(a)(1) The Trademark Trial and Appeal Board will issue a trial order assigning to each party the time for taking testimony. No testimony shall be taken except during the times assigned, unless by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. Testimony periods may be rescheduled by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. ...

37 CFR §2.124(b)(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the

OLD EDITION

notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

* * *

(d)(2) ... Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.

A party which desires to take testimony may do so only during its assigned testimony period, except by stipulation of the parties approved by the Board, or, upon motion, by order of the Board. See 37 CFR §2.121(a)(1), and TBMP §701 and authorities cited therein. For information concerning the assignment of testimony periods, and the rescheduling, extension, and reopening thereof, see TBMP §§509 and 701.

A party which desires to take a testimony deposition upon written questions must serve notice thereof upon each adverse party within 10 days from the opening date of the deposing party's testimony period, as originally set or as reset. See 37 CFR §2.124(b)(1), and Marshall Field & Co. v. Mrs. Field's Cookies, 17 USPQ2d 1652 (TTAB 1990).

Upon receipt of written notice that one or more testimony depositions are to be taken upon written questions, the Board will suspend or reschedule other proceedings in the case to allow for the orderly completion of the depositions upon written questions. See 37 CFR §2.124(d)(2). See also Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990), and Marshall Field & Co. v. Mrs. Field's Cookies, 17 USPQ2d 1652 (TTAB 1990).

For information concerning the time for taking a discovery deposition, see TBMP §404.01.

OLD EDITION

714.05 Place of Deposition

A testimony deposition upon written questions may be taken at any reasonable place. Cf. 37 CFR §2.123(c), and TBMP §713.04. An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating

(its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR §2.124(d)(1)), but rather merely for the purpose of observing.

For information concerning the place where a discovery deposition upon written questions is taken, see TBMP §§404.03(b), 404.03(c), and 404.04.

714.06 Notice of Deposition

37 CFR §2.124(b)(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

* * *

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. ...

A party which desires to take a testimony deposition upon written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof upon each adverse party. See 37 CFR §2.124(b)(1). See also Marshall Field & Co. v. Mrs. Field's Cookies, 17 USPQ2d 1652 (TTAB 1990).

The notice must state the name and address of the witness; and must be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken, and by the written questions to be propounded on behalf of the deposing party. See 37 CFR §§2.124(b)(1), 2.124(c), and 2.124(d)(1). A copy of the notice, but not of the questions, must be filed with the Board. See 37 CFR §2.124(b)(1).

OLD EDITION

For information concerning the notice of deposition in the case of a discovery deposition upon written questions, see TBMP §404.04.

714.07 Examination of Witness

37 CFR §2.124(b)(1) A party desiring to take a testimonial deposition upon written questions shall serve notice thereof upon each adverse party within ten days from the opening date of the testimony period of the party who serves the notice. The notice shall state the name and address of the witness. A copy of the notice, but not copies of the questions, shall be filed with the Trademark Trial and Appeal Board.

* * *

(c) Every notice given under the provisions of paragraph (b) of this section shall be accompanied by the name or descriptive title of the officer before whom the deposition is to be taken.

(d)(1) Every notice served on any adverse party under the provisions of paragraph (b) of this section shall be accompanied by the written questions to be propounded on behalf of the party who proposes to take the deposition. Within twenty days from the date of service of the notice, any adverse party may serve cross questions upon the party who proposes to take the deposition; any party who serves cross questions shall also serve every other adverse party. Within ten days from the date of service of the cross questions, the party who proposes to take the deposition may serve redirect questions on every adverse party. Within ten days from the date of service of the redirect questions, any party who served cross questions may serve recross questions upon the party who proposes to take the deposition; any party who serves recross questions shall also serve every other adverse party. Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

OLD EDITION

(d)(2) Upon motion for good cause by any party, or upon its own initiative, the Trademark Trial and Appeal Board may extend any of the time periods provided by paragraph (d)(1) of this section. Upon receipt of written notice that one or more testimonial depositions are to be taken upon written questions, the Trademark Trial and Appeal Board shall suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written question.

(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

A party which desires to take a testimony deposition upon written questions must, within 10 days from the opening date of its testimony period, as originally set or as reset, serve notice thereof upon each adverse party. See 37 CFR §2.124(b)(1). See also TBMP §714.06.

The notice must be accompanied by the written questions to be propounded on behalf of the deposing party. See 37 CFR §§2.124(b)(1), 2.124(c), and 2.124(d)(1). A copy of the notice, but not of the questions, must be filed with the Board. See 37 CFR §2.124(b)(1).

Within 20 days from the date of service of the notice (25 days, if service of the notice and accompanying questions was made by first-class mail, "Express Mail," or overnight courier--see: 37 CFR §2.119(c)), any adverse party may serve cross questions upon the deposing party. A party which serves cross questions upon the deposing party must also serve copies thereof upon every other adverse party. Within 10 days from the date of service of the cross questions (15 days, if service of the cross questions was made by first-class mail, "Express Mail," or overnight courier), the deposing party may serve redirect questions on every adverse party. Within 10 days from the date of service of the redirect questions (15 days, if service of the redirect questions was made by first-class mail, "Express Mail," or overnight courier), any party which served cross questions may serve recross questions upon the deposing party. A party which serves recross questions upon

OLD EDITION

the deposing party must also serve copies thereof upon every other adverse party. See 37 CFR §2.124(d)(1). See also Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979).

Written objections to questions may be served on the party which propounded the questions. A party which serves objections on a propounding party must also serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within 10 days from the date of service of the objections (15 days, if service of the objections was made by first-class mail, "Express Mail," or overnight courier). The substitute questions must also be served upon every other adverse party. See 37 CFR §2.124(d)(1). See also Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990).

Upon motion for good cause filed by any party, or upon its own initiative, the Board may extend any of the time periods specified in 37 CFR §2.124(d)(1), that is, the time periods for serving cross questions, redirect questions, recross questions, objections, and substitute questions. Further, upon receipt of written notice that one or more testimony depositions are to be taken upon written questions, the Board will suspend or reschedule other proceedings in the matter to allow for the orderly completion of the depositions upon written questions. See 37 CFR §2.124(d)(2). See also TBMP §714.04 and cases cited therein.

Within 10 days after the last date when questions, objections, or substitute questions may be served, the deposing party must mail a copy of the notice and copies of all the questions to the officer designated in the notice. A copy of the notice and of all the questions mailed to the officer must also be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions, and shall record each answer immediately after the corresponding question. See 37 CFR §2.124(e).

An adverse party may attend the taking of the deposition if it so desires, not for the purpose of participating (its participation will have occurred previously, through its service of cross questions, recross questions, and objections, if any, pursuant to 37 CFR §2.124(d)(1)), but rather merely for the purpose of observing.

If the parties so stipulate in writing, a deposition may be taken before any person authorized to administer oaths, at any place, upon any notice, and in any manner,

OLD EDITION

and when so taken may be used like any other deposition. See 37 CFR §2.123(b).

714.08 Form of Deposition

The officer before whom a deposition upon written questions is taken shall record each answer immediately after the corresponding question. See 37 CFR §2.124(e).

For further information concerning the form for a deposition taken in an inter partes proceeding before the Board, see 37 CFR §2.123(g), and TBMP §713.09.

714.09 Signature of Deposition by Witness

For information concerning signature of a deposition taken in an inter partes porceeding before the Board, see 37 CFR §2.123(e)(5), and TBMP §713.10.

714.10 Certification of Deposition

37 CFR §2.124(e) Within ten days after the last date when questions, objections, or substitute questions may be served, the party who proposes to take the deposition shall mail a copy of the notice and copies of all the questions to the officer designated in the notice; a copy of the notice and of all the questions mailed to the officer shall be served on every adverse party. The officer designated in the notice shall take the testimony of the witness in response to the questions and shall record each answer immediately after the corresponding question. The officer shall then certify the transcript and mail the transcript and exhibits to the party who took the deposition.

After a deposition upon written questions has been taken by the officer designated in the notice of deposition, the transcript of the deposition must be certified by the officer. See 37 CFR §2.124(e). For information concerning certification of a deposition taken in an inter partes proceeding before the Board, see 37 CFR §2.123(f), and TBMP §713.11.

OLD EDITION

When the transcript has been certified, the officer should mail the transcript and exhibits to the party which took the deposition. See 37 CFR §2.124(e).

714.11 Service, Correction, and Filing of Deposition

37 CFR §2.124(f) The party who took the deposition shall promptly serve a copy of the transcript, copies of documentary exhibits, and duplicates or photographs of physical exhibits on every adverse party. It is the responsibility of the party who takes the deposition to assure that the transcript is correct (see §2.125(b)). If the deposition is a discovery deposition, it may be made of record as provided by §2.120(j). If the deposition is a testimonial deposition, the original, together with copies of documentary exhibits and duplicates or photographs of physical exhibits, shall be filed promptly with the Trademark Trial and Appeal Board.

The party which took the deposition upon written questions must promptly serve a copy of the transcript, with exhibits, on every adverse party. See 37 CFR §2.124(f). See also TBMP §713.13.

The party which took the deposition must also assure that the transcript is correct. See 37 CFR §2.124(f) and 2.125(b). For information concerning correction of errors in a deposition taken in a Board inter partes proceeding, see TBMP §713.14.

If the deposition is a discovery deposition, it may be made of record as provided by 37 CFR §2.120(j). See 37 CFR §2.124(f). See also, with respect to making a discovery deposition of record, TBMP §709.

If the deposition is a testimony deposition, the original, with exhibits, must be filed promptly with the Board. See 37 CFR §2.124(f).

714.12 Testimony Deposition Must be Filed

While the offering of a discovery deposition in evidence is voluntary, all trial testimony depositions that are taken in a Board inter partes proceeding must be

OLD EDITION

filed in the PTO, and, when filed, automatically constitute part of the evidentiary record in the proceeding. See 37 CFR §2.123(h), and TBMP §713.12.

714.13 Objections to Deposition

37 CFR §2.124(d)(1) ... Written objections to questions may be served on a party propounding questions; any party who objects shall serve a copy of the objections on every other adverse party. In response to objections, substitute questions may be served on the objecting party within ten days of the date of service of the objections; substitute questions shall be served on every other adverse party.

* * *

(g) Objections to questions and answers in depositions upon written questions may be considered at final hearing.

Written objections to questions propounded for a deposition upon written questions may be served on the party which propounded the questions. Any party which serves written objections upon a propounding party must also serve a copy of the objections upon every other adverse party. See 37 CFR §2.124(d)(1). See also TBMP §714.07.

Objections to questions and answers in depositions upon written questions generally are considered by the Board (unless waived) at final hearing. See 37 CFR §2.124(g), and Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990).

For further information concerning the raising of objections to discovery depositions, see TBMP §405. For information concerning the raising of objections to a notice of reliance on a discovery deposition, see TBMP §§718.02 and 533.

For further information concerning the raising of objections to trial testimony depositions, see TBMP §§718.03 and 534.

OLD EDITION

714.14 Confidential or Trade Secret Material

For information concerning the protection of confidential or trade secret material forming part of a deposition transcript or exhibits thereto, see 37 CFR §2.125(e), and TBMP §713.16.

714.15 Utility

A deposition upon written questions is a cumbersome, time-consuming procedure. It requires that cross questions, redirect questions, recross questions, and objections all be framed and served before the questions upon direct examination have even been answered. Moreover, it deprives an adverse party of the right to confront the witness and ask follow-up questions on cross examination. See 37 CFR §2.124(d)(1); TBMP §714.07; Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990); Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989); Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 397 (1985).

Nevertheless, it has some utility. It may be the only means by which a deposition may be taken in a foreign country. See 37 CFR §§2.120(c)(1) and 2.123(a)(2), and TBMP §§404.03(c), 713.02, and 714.01. Moreover, the deposition upon written questions is generally less expensive than the deposition upon oral examination, and is usually more convenient for the witness. Thus, even for a deposition to be taken in the United States, a deposing party may prefer to use the deposition upon written questions, particularly in those cases where the testimony will be short, simple, straight-forward, and not likely to be disputed, such as, to establish for the record examples of third-party usage. Cf. Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980).

715 Testimony From Another Proceeding

OLD EDITION

37 CFR §2.122(f) Testimony from other proceedings. By order of the Trademark Trial and Appeal Board, on motion, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or those in privity may be used in a proceeding, so far as relevant and material, subject, however, to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony.

Upon motion granted by the Board, testimony taken in another proceeding, or testimony taken in a suit or action in a court, between the same parties or their privies, may be used in a pending Board inter partes proceeding, to the extent that the testimony is relevant and material, subject "to the right of any adverse party to recall or demand the recall for examination or cross-examination of any witness whose prior testimony has been offered and to rebut the testimony." See 37 CFR §2.122(f). See also Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992); Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 9 USPQ2d 1061 (TTAB 1988), rev'd on other grounds, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989); MarCon Ltd. v. Avon Products Inc., 4 USPQ2d 1474 (TTAB 1987); Philip Morris Inc. v. Brown & Williamson Tobacco Corp., 230 USPQ 172, 182 (TTAB 1986); Oxy Metal Industries Corp. v. Technic, Inc., 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976); and Izod, Ltd. v. La Chemise Lacoste, 178 USPQ 440 (TTAB 1973).

The Board has construed the term "testimony," as used in 37 CFR §2.122(f), as meaning only trial testimony (see Philip Morris Inc. v. Brown & Williamson Tobacco Corp., 230 USPQ 172, 182 (TTAB 1986)), or a discovery deposition which was used, by agreement of the parties, as trial testimony in the other proceeding.

Testimony from another proceeding between the parties or their privies may be used, upon motion granted by the Board, as evidence in connection with a motion for summary judgment, or as evidence on the case, or both. See, for example: Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 9 USPQ2d 1061 (TTAB 1988), rev'd on other grounds, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (evidence on the case), and Oxy Metal Industries Corp. v. Technic, Inc., 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976) (summary judgment evidence). However, when the Board allows testimony of this nature to be used in connection with a motion for summary judgment, the testimony (and any testimony taken upon recall of the same

OLD EDITION

witness for examination or cross-examination, or in rebuttal thereof) is of record only for purposes of the motion; it will not be considered at final hearing if the case goes to trial, unless it is reintroduced, upon motion granted by the Board, during the appropriate trial period. See TBMP §§528.05(a) and 528.05(e).

For information concerning the filing of a motion for leave to use testimony from another proceeding, see TBMP §531.

A testimony deposition from another proceeding may also be made of record in a Board proceeding by stipulation of the parties approved by the Board. The same is true of a discovery deposition.

716 Stipulated Evidence

Subject to the approval of the Board, parties may enter into a wide variety of stipulations concerning the admission of specified matter into evidence.

For example, parties may stipulate that a party may rely upon specified responses to requests for discovery, or upon other specified documents or exhibits; or that the testimony of a witness may be submitted in the form of an affidavit by the witness; or what a particular witness would testify to if called; or to the facts in the case of any party; or that a discovery deposition may be used as testimony; or that evidence from another proceeding may be used as evidence in the proceeding in which the stipulation is filed. See, for example, 37 CFR §2.123(b), and TBMP §§707-711 and 713.02.

The use of stipulated evidence normally results in savings of time and expense for all concerned. However, it is usually advisable that a party reserve the right to object to stipulated evidence on the grounds of competency, relevance, and materiality. See Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 397-398 (1985).

717 Noncomplying Evidence

OLD EDITION

37 CFR 2.123(l) Evidence not considered. Evidence not obtained and filed in compliance with these sections will not be considered.

Evidence not obtained and filed in compliance with the rules of practice governing inter proceedings before the Board will not be considered by the Board. See 37 CFR §2.123(l). See also Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984); Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983); Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976); Plus Products v. General Mills, Inc., 188 USPQ 520 (TTAB 1975); American Skein & Foundry Co. v. Stein, 165 USPQ 85 (TTAB 1970); and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 393 (1985).

OLD EDITION

718 Objections to Evidence

718.01 In General

37 CFR §2.122(a) Rules of Evidence. The rules of evidence for proceedings before the Trademark Trial and Appeal Board are the Federal Rules of Evidence, the relevant provisions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the provisions of this Part of Title 37 of the Code of Federal Regulations.

The introduction of evidence in inter partes proceedings before the Board is governed by the Federal Rules of Evidence, the relevant portions of the Federal Rules of Civil Procedure, the relevant provisions of Title 28 of the United States Code, and the rules of practice in trademark cases (i.e., the provisions of Part 2 of Title 37 of the Code of Federal Regulations). See 37 CFR §2.122(a). Cf. TBMP §§101.01 and 101.02.

A party to a Board inter partes proceeding which believes that evidence proffered therein by another party should, under the foregoing rules, be excluded from consideration, may, if it so desires, raise an objection thereto. The procedure for raising an objection to proffered evidence depends upon the nature of the evidence and the ground for objection.

718.02 Objections to Notices of Reliance

718.02(a) On Ground of Untimeliness

During its testimony period, a party may make certain specified types of evidence of record by filing a notice of reliance thereon, accompanied by the evidence being offered. Rule 2.120(j), 37 CFR §2.120(j), provides for the introduction, by notice of reliance, of a discovery deposition, answer to interrogatory, or admission; but specifically states that documents obtained by production under FRCP 34 may not be made of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under the provisions of 37 CFR §2.122(e). Rule 2.122(d)(2), 37 CFR §2.122(d)(2), provides for the introduction, by notice of reliance, of a registration owned by a party to a proceeding. Rule 2.122(e), 37 CFR §2.122(e), provides for the introduction, by notice of reliance, of certain specified types of printed publications and official records. See also TBMP §§703.02(a), 703.02(b), 703.03, and 707-711.

When a notice of reliance under any of the aforementioned rules is filed after the close of the offering party's testimony period, an adverse party may file a motion to strike the notice of reliance (and, thus, the evidence submitted thereunder), in its entirety, as untimely. Alternatively, an adverse party may raise this ground for objection in its brief on the case. See, for example, Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990); May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978); Questor Corp. v. Dan Robbins & Associates, Inc., 199 USPQ 358 (TTAB 1978), aff'd, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979); and Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), pet. to Comm'r den., 198 USPQ 485 (Comm'r 1977). Cf. Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991) (where opposer's testimony deposition was taken two days prior to opening of opposer's testimony period, and applicant first raised an untimeliness objection in its brief on the case, objection held waived, since the premature taking of the deposition could have been corrected upon seasonable objection).

For information concerning motions to strike notices of reliance, see TBMP §533.

OLD EDITION

718.02(b) On Other Procedural Grounds

An adverse party may object to a notice of reliance, in whole or in part, on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted, as, for example, that a 37 CFR §2.122(e) notice of reliance on a printed publication does not include a copy of the printed publication, or does not indicate the general relevance thereof. See, for example, Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990); Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987); Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954 (TTAB 1985); Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949 (TTAB 1981); Johnson & Johnson v. American Hospital Supply Corp., 187 USPQ 478 (TTAB 1975); Rogers Corp. v. Fields Plastics & Chemicals, Inc., 172 USPQ 377 (TTAB 1972); and American Optical Corp. v. American Olean Tile Co., 169 USPQ 123 (TTAB 1971). For information concerning objection on the ground of untimeliness, see TBMP §718.02(a).

Ordinarily, a procedural objection to a notice of reliance should be raised promptly, preferably by motion to strike. However, if the ground for the objection is one which could not be cured even if raised promptly, the adverse party may wait and raise the procedural objection in its brief on the case. See, for example, Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986) (defect could have been cured); Alabama Board of Trustees v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB 1986) (defect could have been cured); Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983) (objection raised in brief sustained); Quaker Oats Co. v. Acme Feed Mills, Inc., 192 USPQ 653 (TTAB 1976) (defect could have been cured); and Manpower, Inc. v. Manpower Information Inc., 190 USPQ 18 (TTAB 1976) (defect could have been cured). See also Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), pet. to Comm'r den., 198 USPQ 485 (Comm'r 1977), and TBMP §718.02(a). For information concerning motions to strike notices of reliance, see TBMP §533.

When, upon motion to strike a notice of reliance on the ground that it does not meet the procedural requirements of the rule under which it was filed, the Board finds that the notice is defective, but that the defect is curable, the Board may allow the party which filed the notice of reliance time in which to cure the defect, failing which the notice will stand stricken. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992); M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070

OLD EDITION

(TTAB 1990); and Heaton Enterprises of Nevada Inc. v. Lang, 7 USPQ2d 1842 (TTAB 1988).

If a motion to strike a notice of reliance raises objections which cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992), and M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990). When determination of a motion to strike a notice of reliance is deferred until final hearing, the parties should argue the matter alternatively in their briefs on the case.

OLD EDITION

718.02(c) On Substantive Grounds

An adverse party may object to a notice of reliance on substantive grounds, such as that evidence offered under the notice constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial. Objections of this nature normally should be raised in the objecting party's brief on the case, rather than by motion to strike, unless the ground for objection is one which could be cured if raised promptly by motion to strike. See, in this regard, 37 CFR §2.123(k), and FRCP 32(d)(3)(A). See also Louise E. Fruge', TIPS FROM THE TTAB: An "Object" Lesson, 72 Trademark Rep. 211 (1982). Cf. TBMP §§718.02(b) and 718.03(c). This is because it is the policy of the Board not to read trial testimony or examine other trial evidence prior to final decision. See TBMP §502.01, and authorities cited therein. If a motion to strike a notice of reliance raises objections which cannot be resolved simply by reviewing the face of the notice of reliance (and attached documents), determination of the motion will be deferred by the Board until final hearing. See Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992), and M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990).

Evidence timely and properly introduced by notice of reliance under the applicable trademark rules generally will not be stricken, but the Board will consider any outstanding objections thereto in its evaluation of the probative value of the evidence at final hearing. See, for example, Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990); Jetzon Tire & Rubber Corp. v. General Motors Corp., 177 USPQ 467 (TTAB 1973); and American Optical Corp. v. American Olean Tile Co., 169 USPQ 123 (TTAB 1971). Cf. TBMP §718.03(c).

Because the parties to an inter partes Board proceeding generally will not know until final decision whether a substantive objection to a notice of reliance has been sustained, they should argue the matter alternatively in their briefs on the case.

718.03 Objections to Trial Testimony Depositions

718.03(a) On Ground of Untimeliness

A party may not take testimony outside of its assigned testimony period, except by stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board. See 37 CFR §2.121(a), and TBMP §701.

When there is no such approved stipulation, or granted motion, or Board order, and a testimony deposition is taken after the close of the deposing party's testimony period, an adverse party may file a motion to strike the deposition, in its entirety, as untimely. See TBMP §534.01, and authorities cited therein. Alternatively, an adverse party may raise this ground for objection in its brief on the case. Cf. TBMP §718.02(a), and cases cited therein.

On the other hand, when a testimony deposition is noticed for a date prior to the opening of the deposing party's testimony period, an adverse party which fails to promptly object to the scheduled deposition, on the ground of untimeliness, may be found to have waived this ground for objection, because the premature scheduling of a deposition is an error which can be corrected upon seasonable objection. See Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991).

718.03(b) On Ground of Improper or Inadequate Notice

37 CFR §2.123(c) Notice of examination of witnesses. Before the depositions of witnesses shall be taken by a party, due notice in writing shall be given to the opposing party or parties, as provided in §2.119(b), of the time when and place where the depositions will be taken, of the cause or matter in which they are to be used, and the name and address of each witness to be examined; if the name

OLD EDITION

of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead. Depositions may be noticed for any reasonable time and place in the United States. A deposition may not be noticed for a place in a foreign country except as provided in paragraph (a)(2) of this section. No party shall take depositions in more than one place at the same time, nor so nearly at the same time that reasonable opportunity for travel from one place of examination to the other is not available.

* * *

(e)(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

Before testimony depositions upon oral examination may be taken by a party, the party must give every adverse party due notice in writing of the time when and place where the depositions will be taken, the cause or matter in which they are to be used, and the name and address of each witness to be deposed (or, if the name of a witness is not known, a general description sufficient to identify the witness or the particular class or group to which the witness belongs, together with a satisfactory explanation, may be given instead). See 37 CFR §2.123(c). See also TBMP §713.05. Cf. FRCP 30(b)(1).

If the notice of examination of witnesses served by a party is improper or inadequate with respect to any witness, such as, does not give due (i.e., reasonable) notice, or does not identify a witness whose deposition is taken, an adverse party may cross-examine the witness under protest while reserving the right to object to the receipt of the testimony in evidence. However, promptly after the deposition is completed, the adverse party, if it wishes to preserve the objection, must move to strike the testimony from the record. See 37 CFR §2.123(e)(3), and TBMP §534.02 and cases cited therein.

OLD EDITION

A motion to strike a testimony deposition for improper or inadequate notice must request the exclusion of the entire deposition, not just a part thereof. The motion will be decided on the basis of all the relevant circumstances. See 37 CFR §2.123(e)(3).

For further information concerning the motion to strike a testimony deposition for improper or inadequate notice, see TBMP §534.02.

718.03(c) On Other Grounds

37 CFR §2.123(e)(3) Every adverse party shall have full opportunity to cross-examine each witness. If the notice of examination of witnesses which is served pursuant to paragraph (c) of this section is improper or inadequate with respect to any witness, an adverse party may cross-examine that witness under protest while reserving the right to object to the receipt of the testimony in evidence. Promptly after the testimony is completed, the adverse party, if he wishes to preserve the objection, shall move to strike the testimony from the record, which motion will be decided on the basis of all the relevant circumstances. A motion to strike the testimony of a witness for lack of proper or adequate notice of examination must request the exclusion of the entire testimony of that witness and not only a part of that testimony.

(4) All objections made at the time of the examination to the qualifications of the officer taking the deposition, or to the manner of taking it, or to the evidence presented, or to the conduct of any party, and any other objection to the proceedings, shall be noted by the officer upon the deposition. Evidence objected to shall be taken subject to the objections.

* * *

(j) Effect of errors and irregularities in depositions. Rule 32(d)(1), (2), and (3)(A) and (B) of the Federal Rules of Civil Procedure shall apply to errors and irregularities in depositions. Notice will not be taken of merely formal or technical objections which shall not appear to have wrought a substantial injury to the party raising them; and in case of such injury it must be made to appear that the objection was raised at the time specified in said rule.

OLD EDITION

(k) Objections to admissibility. Subject to the provisions of paragraph (j) of this section, objection may be made to receiving in evidence any deposition, or part thereof, or any other evidence, for any reason which would require the exclusion of the evidence from consideration. Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony must be raised at the time specified in Rule 32(d)(3)(A) of the Federal Rules of Civil Procedure. Such objections will not be considered until final hearing.

FRCP 32(d) Effect of Errors and Irregularities in Depositions.
(1) As to Notice. All errors and irregularities in the notice for taking a deposition are waived unless written objection is promptly served upon the party giving the notice.

(2) As to Disqualification of Officer. Objection to taking a deposition because of disqualification of the officer before whom it is to be taken is waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence.

(3) As to Taking of Deposition.
(A) Objections to the competency of a witness or to the competency, relevancy, or materiality of testimony are not waived by failure to make them before or during the taking of the deposition, unless the ground of the objection is one which might have been obviated or removed if presented at that time.

(B) Errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented, are waived unless seasonable objection thereto is made at the taking of the deposition.

An adverse party may object to a testimony deposition not only on the grounds of untimeliness (see TBMP §718.03(a)) and improper or inadequate notice (see TBMP §718.03(b)), but also on the ground that the deposing party has not complied with one or more of the other procedural requirements specified in the rules governing the taking of testimony in Board inter partes proceedings. In addition, objection may be made to a testimony deposition on one or more substantive grounds, such as that the witness is incompetent to testify, or that the testimony is irrelevant or constitutes hearsay or improper rebuttal. The time and procedure for raising these objections is described below.

OLD EDITION

Some objections to testimony depositions must be raised promptly, failing which they are waived. The objections which are waived unless raised promptly are basically procedural in nature. They include objections to errors and irregularities in the notice for taking a deposition (waived unless written objection is promptly served upon the party giving the notice; in the case of an objection based upon improper or inadequate notice, waived unless the provisions of 37 CFR §2.123(e)(3) are followed--see TBMP §718.03(b)); objections to taking a deposition because of disqualification of the officer before whom the deposition is to be taken (waived unless made before the taking of the deposition begins or as soon thereafter as the disqualification becomes known or could be discovered with reasonable diligence); and objections based on errors and irregularities occurring at the oral examination in the manner of taking the deposition, in the form of the questions or answers, in the oath or affirmation, or in the conduct of parties, and errors of any kind which might be obviated, removed, or cured if promptly presented (waived unless seasonable objection thereto is made at the taking of the deposition). See 37 CFR §§2.123(e)(3) and 2.123(j), and FRCP 32(d)(1),(2), and (3)(A) and (B). See also Chase Manhattan Bank, N.A. v. Life Care Services Corp., 227 USPQ 389 (TTAB 1985); Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984); and TBMP §718.03(a). Cf. TBMP §718.02(b), and Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), pet. to Comm'r den., 198 USPQ 485 (Comm'r 1977).

Moreover, notice will not be taken of merely formal or technical objections, unless they were timely raised, and appear to have wrought a substantial injury to the party raising them. See 37 CFR §2.123(j); Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986); and Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984). See also FRCP 61. This applies not only to errors and irregularities in the taking of a deposition, but also in the form of a deposition transcript (such as, improperly numbered pages or questions, improperly marked exhibits, etc.). See FRCP 61, and Pass & Seymour, Inc. v. Syrelec, supra.

Other objections to testimony depositions are not waived for failure to make them during or before the taking of the deposition, provided that the ground for objection is not one which might have been obviated or removed if presented at that time. These objections, which are basically substantive in nature, include objections (1) to the competency of a witness, or (2) to the competency, relevance, or materiality of testimony, or (3) that the testimony constitutes hearsay or improper rebuttal. See 37 CFR §2.123(k); FRCP 32(d)(3)(A); Beech

OLD EDITION

Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986); and Wright Line Inc. v. Data Safe Services Corp., 229 USPQ 769 (TTAB 1985). When an objection of this type could not have been obviated or removed if presented at the deposition, it will be considered by the Board even if the objection is raised for the first time in a party's brief on the case. See Louise E. Fruge', TIPS FROM THE TTAB: An "Object" Lesson, 72 Trademark Rep. 211 (1982). Cf. Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992).

Substantive objections to testimony (that is, objections going to such matters as the competency of a witness, or the competency, relevance, or materiality of testimony, or the asserted hearsay or improper rebuttal nature of the testimony) are not considered by the Board prior to final hearing. See, for example, Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305 (TTAB 1979); Primal Feeling Center of New England, Inc. v. Janov, 201 USPQ 44 (TTAB 1978); and Globe-Union Inc. v. Raven Laboratories Inc., 180 USPQ 469 (TTAB 1973). Cf. TBMP §718.02(c). This is because depositions are taken out of the presence of the Board, and it is the policy of the Board not to read trial testimony, or examine other trial evidence offered by the parties, prior to final decision. See TBMP §502.01, and authorities cited therein. Further, testimony regularly taken in accordance with the applicable rules ordinarily will not be stricken on the basis of a substantive objection; rather, any such objection (unless waived) will be considered by the Board in its evaluation of the probative value of the testimony at final hearing. See Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992); Liqwacon Corp. v. Browning-Ferris Industries, Inc., supra; Primal Feeling Center of New England, Inc. v. Janov, supra; and Globe-Union Inc. v. Raven Laboratories Inc., supra. Cf. TBMP §718.02(c).

Similarly, if the propriety of a procedural (i.e., technical or formal) objection to a testimony deposition cannot be determined without reading the deposition, or examining other trial evidence, it generally will not be considered by the Board until final hearing. Cf. TBMP §718.02(b); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993); and M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990).

For the foregoing reasons, the objections described in this section (as opposed to the objection to testimony as late-taken, which may be raised by motion to strike--see TBMP §§534.01 and 718.03(a); and the objection based upon improper or inadequate notice of the taking of a deposition, which is the subject of the motion

OLD EDITION

to strike procedure described in 37 CFR §2.123(e)(3) and TBMP §534.02 and 718.03(b)), generally should not be raised by motion to strike. Rather, the objections should simply be made in writing at the time specified in the rules cited above, or orally "on the record" at the taking of the deposition, as appropriate. These objections, if properly asserted and not waived or rendered moot, normally will be considered by the Board in its determination of the case at final hearing. See 37 CFR §2.123(k). Cf. TBMP §718.02(c).

When a deposition is taken upon written questions pursuant to 37 CFR §2.124, written objections to questions (that is, the direct questions, cross questions, redirect questions, and recross questions) may be served upon the party propounding the subject questions. A party which serves written objections upon a propounding party must also serve a copy of the objections upon every other adverse party. See 37 CFR §2.124(d)(1), and TBMP §714.07. Objections to questions and answers in depositions upon written questions generally are considered by the Board (unless waived) at final hearing. See TBMP §714.13.

Because parties which have raised objections to testimony depositions generally will not know the disposition thereof until final decision, they should argue the matters alternatively in their briefs on the case.

OLD EDITION

718.03(d) Refusal to Answer Deposition Question

When an objection is made to a question propounded during a testimony deposition, the question ordinarily should be answered subject to the objection. However, a witness may properly refuse to answer a question asking for information which is, for example, privileged or confidential. See TBMP §404.02, and authorities cited therein.

If a witness not only objects to, but also refuses to answer, a particular question, the propounding party may obtain an immediate ruling on the propriety of the objection only by the unwieldy process of adjourning the deposition and applying, under 35 U.S.C. §24, to the Federal district court, in the jurisdiction where the deposition is being taken, for an order compelling the witness to answer. See TBMP §404.02, and authorities cited therein.

There is no mechanism for obtaining from the Board, prior to final hearing, a ruling on the propriety of an objection to a question propounded during a testimony deposition. See TBMP §§404.02 and 718.03(c), and authorities cited therein. Accordingly, where the witness in a testimony deposition refuses to answer a particular question; no court action is sought; and the Board finds at final hearing that the objection was not well taken, the Board may presume that the answer would have been unfavorable to the position of the party whose witness refused to answer, or may find that the refusal to answer reduces the probative value of the witness's testimony. See Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990); Seligman & Latz, Inc. v. Merit Mercantile Corp., 222 USPQ 720 (TTAB 1984); Ferro Corp. v. SCM Corp., 219 USPQ 346 (TTAB 1983); Entex Industries, Inc. v. Milton Bradley Co., 213 USPQ 1116 (TTAB 1982); Data Packaging Corp. v. Morning Star, Inc., 212 USPQ 109 (TTAB 1981); Donut Shops Management Corp. v. Mace, 209 USPQ 615 (TTAB 1981); S. Rudofker's Sons, Inc. v. "42" Products, Ltd., 161 USPQ 499 (TTAB 1969); and Bordenkircher v. Solis Entrialgo y Cia., S. A., 100 USPQ 268, 276-278 (Comm'r 1953). Cf. Land v. Regan, 342 F.2d 92, 144 USPQ 661 (CCPA 1965). But see University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 217 USPQ 505, 510 (Fed. Cir. 1983).

For information concerning refusal to answer a discovery deposition question, see: TBMP sections 404.02, 404.03(b)(2), 405.03, 415.03, and 523.

OLD EDITION

718.04 Waiver of Objection

A party may waive an objection to evidence by failing to raise the objection at the appropriate time. See 37 CFR §§2.123(e)(3), 2.123(j), and 2.123(k); FRCP 32(d)(1),(2), and (3)(A) and (B); and TBMP §§718.02 and 718.03.

For example, an objection to a notice of reliance on the ground that the notice does not comply with the procedural requirements of the particular rule under which it was submitted generally should be raised promptly. If a party fails to raise an objection of this nature promptly, the objection may be deemed waived, unless the ground for objection is one which could not have been cured even if raised promptly. See TBMP §§718.02(a) and 718.02(b), and authorities cited therein.

Similarly, an objection to a testimony deposition on the ground that it does not comply with the applicable procedural rules generally is waived if not raised promptly, unless the ground for objection is one which could not have been cured even if raised promptly. See TBMP §§718.03(a), 718.03(b), and 718.03(c), and authorities cited therein.

On the other hand, objections to a notice of reliance, or to a testimony deposition, on substantive grounds, such as, that the proffered evidence constitutes hearsay or improper rebuttal, or is incompetent, irrelevant, or immaterial, generally are not waived for failure to raise them promptly, unless the ground for objection is one which could have been cured if raised promptly. See TBMP §§718.02(c) and 718.03(c), and authorities cited therein.

If testimony is submitted in affidavit form by stipulation of the parties pursuant to 37 CFR §2.123(b), any objection which is waived if not made at deposition must be raised promptly after receipt of the affidavit submission, failing which it is waived. See Chase Manhattan Bank, N.A. v. Life Care Services Corp., 227 USPQ 389 (TTAB 1985).

If a party fails to attend a testimony deposition, any objection which is waived if not made at the deposition, is waived. See Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, at 23132, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, at 22; Wright Line Inc. v. Data Safe Services Corp., 229 USPQ 769 (TTAB 1985); Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984); and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 274 (1984).

Additionally, a party may waive an objection which was seasonably raised at trial, by failing to preserve the objection in its brief on the case. See Reflange, Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990); United Rum Merchants Ltd. v. Fregal, Inc., 216 USPQ 217 (TTAB 1982); Medtronic, Inc. v. Medical Devices, Inc., 204 USPQ 317 (TTAB 1979); Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979); Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979); and Copperweld Corp. v. Astralloy-Vulcan Corp., 196 USPQ 585 (TTAB 1977).

OLD EDITION

CHAPTER 800 BRIEFS ON CASE, ORAL HEARING, FINAL DECISION

801 Briefs on the Case

802 Oral Hearing

803 Final Decision

804 Request for Reconsideration of Final Decision

805 Final Decision Remand to Examining Attorney

806 Termination of Proceeding

807 Status of Application After Proceeding

OLD EDITION

801 Briefs on the Case

801.01 In General

After the close of all testimony periods in an inter partes proceeding before the Board, the parties are allowed time in which to file briefs on the case. The brief is a party's "opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts in light of the law," its strongest affirmative arguments, and a rebuttal of its adversary's arguments. See David J. Kera, TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board, 66 Trademark Rep. 141, 141 (1976).

Subject to FRCP 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. However, the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence. See TBMP §§705.02 and 706.02, and authorities cited therein.

OLD EDITION

801.02 Time for Filing

37 CFR §2.128(a)(1) The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.

(2) When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.

(3) When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in

which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that he has lost interest in the case, judgment may be entered against plaintiff.

801.02(a) Plaintiff's Main Brief

The main brief of the party in the position of plaintiff is due not later than 60 days after the date set for the close of the rebuttal testimony period. See 37 CFR §2.128(a)(1).

If a party in the position of plaintiff fails to file a main brief, the Board may issue an order allowing plaintiff until a set time, not less than 15 days, in which to show cause why its failure to file a main brief should not be treated as a concession of the case. If the plaintiff fails to file a response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff. See 37 CFR §2.128(a)(3). The purpose of this order to show cause procedure is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board thereof, or where the plaintiff has lost interest in the case. It is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief on the case, where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case. See TBMP §537, and authorities cited therein.

For further information concerning the 37 CFR §2.128(a)(3) order to show cause procedure, see TBMP §537.

OLD EDITION

801.02(b) Defendant's Main Brief

The filing of a brief on the case is not mandatory for a party in the position of defendant. See 37 CFR §2.128(a)(1); Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, 23132, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13, 22; and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 275 (1984).

However, if a party in the position of defendant wishes to file a brief on the case, the brief is due not later than 30 days after the due date of the plaintiff's main brief. See 37 CFR §2.128(a)(1). See also Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd., 175 USPQ 25 (TTAB 1972).

801.02(c) Plaintiff's Reply Brief

The filing of a reply brief is not mandatory for a party in the position of plaintiff. See 37 CFR §2.128(a)(1), and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269, 275 (1984).

However, if a party in the position of plaintiff wishes to file a reply brief, the brief is due not later than 15 days after the due date of the defendant's main brief. See 37 CFR §2.128(a)(1).

801.02(d) Reply Brief for Defendant Not Permitted

There is no provision for the filing of a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant. If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board. See TBMP §540, and cases cited therein.

However, if a defendant has counterclaimed to cancel a registration owned by the plaintiff, the defendant, as plaintiff in the counterclaim, may file a reply brief directed to the counterclaim.

801.02(e) Special Situations

In certain special situations, the Board will set, by written action, the due dates for the filing of briefs on the case. This occurs when (1) there is a counterclaim, or (2) proceedings have been consolidated, and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in

OLD EDITION

another of them, or (3) there is an interference or a concurrent use registration proceeding involving more than two parties. See 37 CFR §2.128(a)(2).

For example, if there is a counterclaim, the Board will issue a written action setting the due dates for plaintiff's main brief in the original proceeding (due the 60th day after the date set for the close of rebuttal testimony); defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim (due the 30th day after the due date of the plaintiff's main brief); plaintiff's combined reply brief in the original proceeding and its brief as defendant in the counterclaim (due the 30th day after the due date of defendant's brief as defendant in the original proceeding and as plaintiff in the counterclaim); and defendant's reply brief as plaintiff in the counterclaim (due the 15th day after the due date of plaintiff's combined reply brief in the original proceeding and brief as defendant in the counterclaim). See Jan Bell Marketing Inc. v. Centennial Jewelers Inc., 19 USPQ2d 1636 (TTAB 1990) (example of a briefing schedule in an opposition with a counterclaim).

In an interference or concurrent use registration proceeding, the Board will schedule briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief in which it may meet the brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. See TBMP §1007 (example of a briefing schedule in an interference proceeding), and TBMP §1108 (example of a briefing schedule in a concurrent use proceeding). Cf. 37 CFR §2.121(b)(2).

OLD EDITION

801.03 Form and Contents of Brief

37 CFR §2.128(b) Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Each brief shall contain an alphabetical index of cases cited therein. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Three legible copies, on good quality paper, of each brief shall be filed.

A brief on the case must comply with the requirements of 37 CFR §2.128(b). See also, with respect to briefs on the case, David J. Kera, TIPS FROM THE TTAB: Preparing and Filing Briefs With the Trademark Trial and Appeal Board, 66 Trademark Rep. 141 (1976).

The description of the record should comprise a list of the evidence properly introduced by the parties, such as, "The evidence of record consists of opposer's Registration No. 1,234,567; applicant's answers to opposer's interrogatories; the discovery deposition of Mr. X; and the testimony depositions of opposer's witnesses, Mr. Y and Ms. Z." The recitation of facts should include, for each significant fact recited, a citation to the portion of the evidentiary record where supporting evidence may be found.

Without prior leave of the Board, a main brief on the case may not exceed 55 pages in length in its entirety, and a reply brief may not exceed 25 pages in its entirety. See 37 CFR §2.128(b). See also United Foods Inc. v. United Air Lines Inc., 33 USPQ2d 1542 (TTAB 1994), and Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc., 23 USPQ2d 1894 (TTAB 1992). The parts of the brief which fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. Extensive single-spaced footnotes may not be used as a subterfuge to avoid the page limit. See Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc., supra. Exhibits or appendices to a brief, not being part of the brief itself, are not included within the limit. See 37 CFR §2.128(b), and Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34895, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 33-34. Cf. American Optical Corp. v. Atwood Oceanics, Inc., 177 USPQ 585 (Comm'r 1973) (case decided under earlier version of 37 CFR 2.128(b)). For information concerning motions for leave to file a brief exceeding the page limit, see TBMP §538.

When cases are cited in a brief, the case citation should include a citation to The United States Patent Quarterly, if the case has appeared in that publication. If the case has not been published in The United States Patent Quarterly, it is recommended that a copy of the case be submitted with the brief.

If a mark which is the subject of, or is pleaded in, a proceeding includes stylization or a design feature, a picture of the mark should be included in the brief on the case.

OLD EDITION

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief.

801.04 Amicus Briefs

The Board may, in its discretion, entertain an amicus brief. See TBMP §539, and authorities cited therein. An entity which wishes to file an amicus brief should file a motion with the Board for leave to do so. For information concerning motions for leave to file an amicus brief, see TBMP §539.

801.05 Motion to Strike Brief on Case

A party may move to strike a brief on the case on a variety of grounds, including that the brief was untimely filed, exceeds the page limit for a brief on the case, violates the format requirements for such a brief, is a brief not provided for by the applicable rules (i.e., is a reply brief filed by the defendant, for example), etc. In addition, a party may move to strike evidentiary matter attached to a brief where the evidentiary matter was not properly made of record during the time for taking testimony. For information concerning motions to strike a brief on the case, or matter attached to such a brief, see TBMP §540, and cases cited therein.

OLD EDITION

802 Oral Hearing

37 CFR §2.129(a) If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.

(b) The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives.

802.01 In General

The oral hearing on the case in an inter partes proceeding before the Board corresponds to the oral summation in court proceedings after all the evidence is in. See 37 CFR §2.116(f).

An oral hearing is not mandatory, but rather is scheduled only if a timely request therefor is filed by a party to the proceeding. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary's arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff's reply brief. For information concerning situations in which it may be advisable to request an oral hearing on a case, see Saul Lefkowitz, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977).

Subject to FRCP 11, a party is entitled to offer at oral hearing any argument it feels will be to its advantage. However, the facts recited and arguments made at oral hearing must be based on the evidence offered at trial. An oral hearing may not be used as a vehicle for the introduction of evidence. See 37 CFR §2.123(l); TBMP §717; and Saul Lefkowitz, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977). Cf. TBMP §801.01.

OLD EDITION

802.02 Request for Oral Hearing

A party which wishes to have an oral hearing on the case must file a request therefor, by separate paper (not as part of its brief on the case), not later than 10 days after the due date for the filing of the last reply brief in the proceeding. See 37 CFR §2.129(a). A hearing may be requested by any party to the proceeding.

If an oral hearing is not requested, the case will be decided in due course after the due date for the filing of the last reply brief on the case.

802.03 Time and Place of Hearing

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing, and sends each party a notice of hearing specifying the date, time, and location of the hearing. See 37 CFR §2.129(a). It is the normal practice of the Board, in setting an oral hearing, to telephone the parties, or their attorneys or other authorized representatives, to determine a convenient date and time for the hearing, following which the written notice formally scheduling the hearing is mailed. Oral hearings are held at the offices of the Board.

Attendance at a scheduled oral hearing is voluntary, not mandatory. If any party appears at the specified time, the party will be heard, whether or not the party which appears is the one which requested the hearing. See 37 CFR §2.129(a). If a party elects not to attend a scheduled hearing, the party should notify the Board, well in advance of the scheduled hearing date, that it will not attend the hearing.

If a party which requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of nonappearance, the failure to appear will be construed by the Board as a withdrawal of the request for an oral hearing, and any new request for an oral hearing will be granted only upon a showing that the failure to appear was occasioned by extraordinary circumstances.

If the Board is prevented from hearing the case at the time specified in the notice of hearing, a new hearing date will be set. See 37 CFR §2.129(a). The date or time of a hearing may also be reset, so far as is convenient and proper, at the request of the parties and their attorneys or other authorized representatives. See 37 CFR §2.129(b). For information concerning requests to reset an oral hearing, see TBMP §542.01. However, parties should not file repeated requests to reset an oral hearing.

802.04 Before Whom Held

OLD EDITION

An oral hearing is held before a panel of at least three members (i.e., administrative trademark judges) of the Board. See 37 CFR §2.129(a). Cf. Section 17 of the Act, 15 U.S.C. §1067; Knickerbocker Toy Co. v. Faultless Starch Co., 467 F.2d 501, 175 USPQ 417 (CCPA 1972); and 37 CFR §2.142(e)(1). Normally, an oral hearing panel consists of only three Board members. If a member of a panel of three before which an oral hearing was held is, for some reason, unable to participate in the final decision, another Board member may be substituted at final decision for the missing member, even though the substituted member was not present at the oral hearing; no new oral hearing is necessary. See In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985), and Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982). Cf. Plus Products v. Medical Modalities Associates, Inc., 217 USPQ 464 (TTAB 1983) (final decision rendered by only two Board members invalid); Ronson Corp. v. Ronco Teleproducts, Inc., 197 USPQ 492 (Comm'r 1978) (final decision rendered by only two Board members invalid); and Ethicon, Inc. v. American Cyanamid Co., 193 USPQ 374 (Comm'r 1977) (alleged invalid appointment to Board of one panel member).

The Board may, in its discretion, use an augmented panel to hear a case. See TBMP §541, and cases cited therein. A decision by the Board to use an augmented panel may be made either upon the Board's own initiative, or upon motion filed by a party to the proceeding. For information concerning motions for an augmented panel hearing, see TBMP §541. For further information concerning the constitution of Board panels, see In re Alappat, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

OLD EDITION

802.05 Length of Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral arguments. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal. See 37 CFR §2.129(a). If there is a counterclaim, the defendant, as the plaintiff in the counterclaim, may also reserve part of its 30 minutes for rebuttal on the counterclaim.

There is no requirement that a party use all of its allotted 30 minutes for oral argument. Often, a case is of such nature that a party's oral arguments thereon may be presented in considerably less than 30 minutes.

On the other hand, if a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. See 37 CFR §2.129(a), and TBMP §542.02. Cf. 37 CFR §2.128(b), and TBMP §538. For information concerning requests for additional time for oral argument, see TBMP §542.02. If the request is granted, each party will be allowed the same amount of time for oral argument.

802.06 Audiotaping

Upon motion showing good cause, the Board will usually permit a party to make an audiotape recording of an oral hearing. Such a recording, when permitted by the Board, is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding. For information concerrning motions for leave to audiotape an oral hearing, see TBMP §543.

If permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audiotaping equipment in an unobtrusive manner. A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be videotaped. See TBMP §543.

OLD EDITION

802.07 Visual Aids, etc.

The Board will generally allow certain types of materials, such as graphs, large depictions of marks, schedules, charts, etc., to be used at oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record. See Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990).

A party may also bring to the oral hearing any materials introduced as exhibits at trial, including audiotapes or videotapes of commercials or demonstrations. A party which introduced an audiotape or videotape as an exhibit at trial, and wishes to play it at the oral hearing, should notify the Board in advance. In addition, a party which wishes to play such a tape at oral hearing is responsible

for furnishing, operating, and removing the necessary equipment in an unobtrusive manner.

A party may not, however, use an oral hearing for the purpose of offering new evidence, whether in the form of charts, graphs, exhibits, or other such materials. See TBMP §802.01, and authorities cited therein. Nor may a party submit in writing the text of its oral argument; to allow such a practice would be to permit a party, in effect, to file an additional brief on the case. See Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990).

802.08 Nature of Hearing

Prior to an oral hearing, the Board panel members read the briefs on the case and, if necessary, examine the case files. Thus, persons presenting oral arguments should not read from the briefs on the case, except to emphasize an admission contained in an adversary's brief.

Normally, an oral hearing case is not assigned to a particular Board member for the drafting of a final decision until some time after the oral hearing. Thus, the Board member who sits in the middle of the panel of three is not necessarily the person to whom the case will be assigned for decision; rather, the middle panel member is usually (but not always) the senior panel member.

A person presenting oral arguments should be prepared to answer questions from Board panel members at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the Board panel. Further, a person presenting oral arguments should never interrupt the oral arguments of the adversary.

For further information on how to argue a case before the Board, see Saul Lefkowitz, TIPS FROM THE TTAB: Presentation of an Oral Hearing Before the Trademark Trial and Appeal Board, 67 Trademark Rep. 283 (1977).

803 Final Decision

OLD EDITION

After an oral hearing has been held in a Board inter partes proceeding, the case is set down for final decision. If no oral hearing is requested, the case is set down for final decision after the due date for the filing of the last reply brief on the case.

The final decision is rendered by a panel of at least three Board members. See Section 17 of the Act, 15. U.S.C. §1067; Knickerbocker Toy Co. v. Faultless Starch Co., 467 F.2d 501, 175 USPQ 417 (CCPA 1972); Plus Products v. Medical Modalities Associates, Inc., 217 USPQ 464 (TTAB 1983); and Ronson Corp. v. Ronco Teleproducts, Inc., 197 USPQ 492 (Comm'r 1978). Cf. 37 CFR §§2.129(a) and 2.142(e)(1); In re Bose Corp., 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985); Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982); and Ethicon, Inc. v. American Cyanamid Co., 193 USPQ 374 (Comm'r 1977). When there has been an oral hearing in a case, the final decision normally is rendered by the panel before which the oral hearing was held. If a member of a panel of three before which an oral hearing was held is unable to participate in the final decision, another Board member may be substituted at final decision for the missing member. See TBMP §802.04, and cases cited therein.

The Board may use an augmented panel at final decision. For information concerning the use of an augmented panel, see TBMP §541. For further information concerning the constitution of Board panels, see In re Alappat, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994).

The evidentiary record in a case is not read by every member of the panel assigned to decide the case. Rather, one panel member is assigned to read the testimony and examine the other evidence of record, discuss the case with the other panel members, and then draft a decision and supporting opinion. The draft is circulated to the other panel members for their approval and signature. A panel member who does not agree with the decision may write a dissent. A panel member who agrees with the decision, but disagrees with the reasoning expressed in the opinion supporting the decision, or wishes to express addtional reasons, may write a concurring opinion.

When a final decision has been signed by the members of the panel rendering the decision, a copy thereof is mailed to every party to the proceeding.

OLD EDITION

804 Request for Reconsideration of Final Decision

A party may file a request for rehearing, reconsideration, or modification of a decision issued after final hearing. See 37 CFR §2.129(c). For information concerning requests for rehearing, reconsideration, or modification of a decision issued after final hearing, see TBMP §544.

805 Final Decision Remand to Examining Attorney

37 CFR §2.131 Remand after decision in inter partes proceeding.
If, during an inter partes proceeding, facts are disclosed which appear to render the mark of an applicant unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may refer the application to the examiner for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon receiving the application, the examiner shall withhold registration pending reexamination of the application in the light of the reference by the Boad. If, upon reexamination, the examiner finally refuses registration to the applicant, an appeal may be taken as provided by §§2.141 and 2.142.

If, during the course of an opposition, concurrent use, or interference proceeding, facts are disclosed which appear to render the subject mark of an involved applicant unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to FRCP 15(b), the Board, in its decision in the proceeding, may, in addition to determining the pleaded matters, remand the application to the Trademark Examining Attorney for further examination in light of the disclosed facts. That is, the Board may include in its decision a recommendation that in the event applicant ultimately prevails in the inter partes proceeding, the Examining Attorney reexamine the application in light of the disclosed facts. See 37 CFR §2.131, and TBMP §515 and cases cited therein. Cf. TBMP §1217.

If a party to an opposition, concurrent use, or interference proceeding believes that the facts disclosed therein appear to render the subject mark of an involved application unregistrable, but the matter was not pleaded or tried by the express

OLD EDITION

or implied consent of the parties pursuant to FRCP 15(b), the party may request that the Board include, in its decision in the proceeding, a 37 CFR §2.131 remand to the Examining Attorney. The request may be made in the party's brief on the case, or by separate motion.

806 Termination of Proceeding

When an inter partes proceeding before the Board has been finally determined (that is, when the time for filing an appeal from a decision of the Board determining the case has expired, and no appeal has been filed, or when any appeals filed have been determined), the Board takes certain further steps, based on the judgment entered therein, to close out the proceeding file and give effect to the judgment. See Notice of Final Rulemaking published in the Federal Register on August 22, 1989 at 54 FR 34886, 34896, and in the Official Gazette of September 12, 1989 at 1106 TMOG 26, 34. The same is true when a proceeding ends by stipulation of the parties, or by a voluntary withdrawal or consent to judgment by one party.

For example, when a decision of the Board dismissing an opposition becomes final (that is, the time for filing an appeal has expired, and no appeal has been filed), or the opposition is dismissed pursuant to a stipulation of the parties or as the result of a withdrawal by opposer, the Board normally takes the following steps, inter alia:

(1) The testimony depositions, any discovery depositions made of record in the case, and one copy of each brief on the case (that is, materials which, because of their bulkiness, would not have been kept by the Board in the proceeding file--see TBMP §120.01), are all placed on the prongs in the proceeding file. The two extra copies of each brief are discarded.

(2) The word "TERMINATED" is stamped on the proceeding file.

(3) The proceeding file is sent to the PTO warehouse where terminated proceeding files are stored.

(4) Exhibits which, because of their size, were too bulky to put in the proceeding file, and therefore were stored separately by the Board (see TBMP §120.02), are returned to the party which filed them.

(5) Confidential materials filed under protective order are returned to the party which filed them.

(6) The applicant's subject application is sent to the appropriate section of the PTO for further appropriate action, such as, issuance of a notice of allowance

OLD EDITION

under 37 CFR §2.81(b), in an intent-to-use application for which no amendment to allege use under 37 CFR §2.76 has been submitted and accepted; issuance of a registration pursuant to 37 CFR §2.81(a); republication, if necessary for some reason; or reexamination by the Trademark Examining Attorney pursuant to a 37 CFR §2.131 remand (see TBMP §805). Alternatively, if the applicant's subject application has been abandoned by the applicant, the abandoned application is sent to the PTO warehouse where newly abandoned applications are stored (pending their destruction approximately two years after abandonment).

When a decision of the Board granting a petition for cancellation becomes final, the first five steps listed above are taken, and the subject registration is cancelled by separate order of the Commissioner. When a decision of the Board dismissing a petition for cancellation becomes final, the first five steps are taken, and the file of the registration is returned to the PTO warehouse where "live" (subsisting) registrations are stored.

Because the Board will take the termination steps described above when a decision of the Board determining a case appears, from the records of the PTO, to have become final, a party which commences a civil action, pursuant to Section 21(b) of the Act, 15. U.S.C. §1071(b), seeking review of the Board's decision should file written notice thereof in the PTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action. See 37 CFR §2.145(c)(4). If a party files a civil action seeking review of a Board's decision determining a proceeding, but fails to notify the Board thereof, the Board, believing that its decision has become final, will terminate the proceeding. As a result, a registration may be issued or cancelled prematurely, while the civil action seeking review of the Board's decision is still pending.

OLD EDITION

807 Status of Application After Proceeding

37 CFR §2.136 Status of application on termination of proceeding.
On termination of a proceeding involving an application, the application, if the judgment is not adverse, returns to the status it had before the institution of the proceedings. If the judgment is adverse to the applicant, the application stands refused without further action and all proceedings thereon are considered terminated.

When an opposition, concurrent use or interference proceeding ends with a judgment which is not adverse to an involved applicant, the application returns to the status it had before commencement of the proceeding, unless the Board indicates in its decision that the application must be republished for some reason, or includes in its decision a 37 CFR §2.131 remand to the Trademark Examining Attorney (see TBMP §805). See 37 CFR §2.136.

If the proceeding ends with a judgment which is adverse to the applicant, the application stands refused, the file thereof is stamped "ABANDONED," and all proceedings thereon are considered terminated. See 37 CFR §2.136; In re Vesper Corp., 8 USPQ2d 1788 (Comm'r 1988) (Commissioner refuses to reopen application after adverse final judgment in opposition); and National Patent Development Corp. v. Hercules Inc., 192 USPQ 491 (Comm'r 1976) (Commissioner refuses to reopen application after adverse final judgment in opposition).

OLD EDITION

CHAPTER 900 REVIEW OF DECISION OF BOARD

901 Appeals--In General

902 Appeal to Court of Appeals for the Federal Circuit

903 Appeal by Civil Action

904 Access to Record During Appeal

905 Petition to Commissioner

OLD EDITION

901 Appeals--In General

15 U.S.C. §1071(a)(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Commissioner, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

(3) The Commissioner shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Commissioner forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Commissioner shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Commissioner and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Commissioner, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under

OLD EDITION

section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

(b)(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

(2) The Commissioner shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not

OLD EDITION

embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

37 CFR §2.145 Appeal to court and civil acton.
(a) Appeal to U.S. Court of Appeals for the Federal Circuit. An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Commissioner (§§2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

(1) In the Patent and Trademark Office give written notice of appeal to the Commissioner (see paragraphs (b) and (d) of this section);

(2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.

(b) Notice of appeal. (1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Commissioner, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) In inter partes proceedings, the notice must be served as provided in §2.119.

(3) The notice, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

(c) Civil Action. (1) Any person who may appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (a) of this section), may have remedy by civil action under section 21(b) of the Act. Such civil action must be commenced within the time specified in paragraph (d) of this section.

OLD EDITION

(2) Any applicant or registrant in an ex parte case who takes an appeal to the U.S. Court of Appeals for the Federal Circuit waives any right to proceed under section 21(b) of the Act.

(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in §2.119.

(4) A party to a proceeding before the Trademark Trial and Appeal Board which commences a civil action, pursuant to Section 21(b) of the Act, seeking review of a decision of the Board should file written notice thereof in the Patent and Trademark Office, addressed to the Board, within one month after the expiration of the time for appeal or civil action, in order to avoid premature termination of the Board proceeding.

(d) Time for appeal or civil action. (1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§2.127(b), 2.129(c) or §2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, whichever is later.

(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

OLD EDITION

(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

(e) Extensions of time to commence judicial review. The Commissioner may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

OLD EDITION

901.01 Avenues of Appeal

A party to a Board proceeding who is dissatisfied with the decision of the Board is provided, under the Act, with two possible (mutually exclusive) remedies. The dissatisfied party may either:

(1) Appeal to the United States Court of Appeals for the Federal Circuit, which will review the decision from which the appeal is taken on the record before the PTO, or

(2) Have remedy by civil action (in a United States District Court), in which the court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear."

See Section 21 of the Act, 15 U.S.C. §1071, and 37 CFR §2.145. See also Spraying Systems Co. v. Delavan Inc., 975 F.2d 387, 24 USPQ2d 1181 (7th Cir. 1992), and Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

In an inter partes proceeding, if a dissatisfied party chooses to file an appeal to the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file notice that it elects to have the appeal dismissed, and to have further proceedings conducted instead by way of civil action. See Section 21(a)(1) of the Act, and 37 CFR §2.145(c)(3). Within 30 days after the filing of a notice of election by an adverse party, the appellant must commence a civil

action for review of the Board's decision, failing which the Board's decision will govern further proceedings in the case. See Section 21(a)(1) of the Act, and 37 CFR §2.145(d)(3).

For a discussion of forum selection considerations, see Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 400-405 (1985).

901.02 What May be Appealed

901.02(a) Final Decision Versus Interlocutory Decision

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a final dispositive ruling that ends litigation on the merits before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. See Copelands' Enterprises Inc. v. CNV Inc., 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989). See also Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); Parker Brothers v. Tuxedo Monopoly, Inc., 757 F.2d 254, 226 USPQ 11 (Fed. Cir. 1985); and Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel, 1 USPQ2d 1424 (Comm'r 1986).

Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. See, for example, Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991) (decision on 37 CFR §2.132(a) motion to dismiss); Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990) (decision on motion for summary judgment); Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (decision on motion for summary judgment); Stanspec Co. v. American Chain & Cable Co., 531 F.2d 563, 189 USPQ 420 (CCPA 1976) (decision on motion to dismiss); and Williams v. Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975) (decision on FRCP 60(b) motion to vacate).

On the other hand, if the Board resolves a merits issue prior to final hearing, but other merits issues remain, that is, the litigation is still before the Board as a

OLD EDITION

whole, the Board's decision on the merits issue is interlocutory, rather than final, for purposes of judicial review. For example, in a case in which there is a counterclaim, if the Board grants summary judgment only as to the counterclaim, the case is not ripe for appeal until there has been a final decision with respect to the original claim; similarly, if the Board grants summary judgment only as to the original claim, the case is not ripe for appeal until there has been a final decision with respect to the counterclaim. See Interlocutory Decisions by the Trademark Trial and Appeal Board, 1123 TMOG 36 (February 19, 1991), and Procter & Gamble Co. v. Sentry Chemical Co., 22 USPQ2d 1589 (TTAB 1992). See also Copelands' Enterprises Inc. v. CNV Inc., 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989). When the Board, prior to final hearing, issues a decision resolving one or more, but not all, of the merits issues in a case before it, it is the usual practice of the Board to include in its decision the following statement: "This decision is interlocutory in nature. Appeal may be taken within two months after the entry of a final decision in the case." See, for example, Interlocutory Decisions by the Trademark Trial and Appeal Board, supra, and Procter & Gamble Co. v. Sentry Chemical Co., supra.

When an appeal is taken from a decision of the Board, it is the court to which an appeal is taken, not the Board, which determines whether the involved decision is appealable, that is, whether the court has jurisdiction to entertain the appeal. See R.G. Barry Corp. v. Mushroom Makers, Inc., 609 F.2d 1002, 204 USPQ 195 (CCPA 1979) (Board's attempted "certification" of interlocutory decision as appealable given no effect in Court's determination of whether it had jurisdiction over the appeal), and Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel, 1 USPQ2d 1424 (Comm'r 1986) (Commissioner has no statutory authority to "certify" interlocutory orders of the Board for appeal). See also, with respect to jurisdiction to entertain an appeal, Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991).

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. See Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 202 USPQ 100 (CCPA 1979), and Palisades Pageants, Inc. v. Miss America Pageant, 442 F.2d 1385, 169 USPQ 790 (CCPA 1971), cert. denied, 404 U.S. 938, 171 USPQ 641 (1971).

A party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board),

OLD EDITION

and does not put an end to the litigation before the Board, by timely petition to the Commissioner. See TBMP §905, and authorities cited therein. A party may also file a request with the Board for reconsideration of such an order or decision. See TBMP §518.

The mandamus procedure may not be used as a substitute for the appeal procedure specified in Section 21 of the Act. See Formica Corp. v. Lefkowitz, 590 F.2d 915, 200 USPQ 641 (CCPA 1979), cert. denied, 442 U.S. 917, 202 USPQ 159 (1979).

901.02(b) Judgment Subject to Establishment of Constructive Use

In an inter partes proceeding before the Board, no final judgment will be entered in favor of an applicant under Section 1(b) of the Act, 15 U.S.C. §1051(b), before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to Section 7(c) of the Act, 15 U.S.C. §1057(c). See Sections 21(a)(4) and 21(b)(1) of the Act. Rather, in those cases where the Board finds that a Section 1(b) applicant is entitled to prevail only if it establishes constructive use, the Board will enter judgment in favor of that applicant, subject to the applicant's establishment of constructive use. See 37 CFR §2.129(d), and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991). If, after entry of that judgment, the Section 1(b) applicant files an acceptable statement of use, and obtains a registration, thus establishing its constructive use, final judgment will be entered in behalf of the Section 1(b) applicant. If, on the other hand, the Section 1(b) applicant fails to establish constructive use, that is, fails to file an acceptable statement of use and obtain a registration, judgment will instead be entered in favor of the adverse party.

When the Board enters judgment in favor of a Section 1(b) applicant subject to that party's establishment of constructive use, the time for filing an appeal or commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. See 37 CFR §2.129(d), and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991).

OLD EDITION

902 Appeal to Court of Appeals for the Federal Circiut

902.01 Notice of Appeal

15 U.S.C. §1071(a)(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

37 CFR §2.145 Appeal to court and civil acton.
(a) Appeal to U.S. Court of Appeals for the Federal Circuit. An applicant for registration, or any party to an interference, opposition, or cancellation proceeding or any party to an application to register as a concurrent user, hereinafter referred to as inter partes proceedings, who is dissatisfied with the decision of the Trademark Trial and Appeal Board and any registrant who has filed an affidavit or declaration under section 8 of the Act or who has filed an application for renewal and is dissatisfied with the decision of the Commissioner (§§2.165, 2.184), may appeal to the U.S. Court of Appeals for the Federal Circuit. The appellant must take the following steps in such an appeal:

(1) In the Patent and Trademark Office give written notice of appeal to the Commissioner (see paragraphs (b) and (d) of this section);

(2) In the court, file a copy of the notice of appeal and pay the fee for appeal, as provided by the rules of the Court.

(b) Notice of appeal. (1) When an appeal is taken to the U.S. Court of Appeals for the Federal Circuit, the appellant shall give notice thereof in writing to the Commissioner, which notice shall be filed in the Patent and Trademark Office, within the time specified in paragraph (d) of this section. The notice shall specify the party or parties taking the appeal and shall designate the decision or part thereof appealed from.

(2) In inter partes proceedings, the notice must be served as provided in §2.119.

(3) The notice, if mailed to the Office, shall be addressed as follows: Box 8, Commissioner of Patents and Trademarks, Washington, DC 20231.

A party taking an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board must give written notice thereof both to the Commissioner and to the Court of Appeals for the Federal Circuit, and pay to the

OLD EDITION

Court the fee required by the Court's rules. See 37 CFR §§2.145(a) and 2.145(b).

Specifically, the original notice of appeal must be filed in the PTO, within the time required by 37 CFR §2.145(d) (see TBMP §902.02). See Section 21(a)(2) of the Act, 15 U.S.C. §1071(a)(2); 37 CFR §§2.145(a) and 2.145(b)(1); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for filing a notice of appeal. The notice must specify the party or parties taking the appeal and designate the decision or part thereof appealed from. However, reasons for appeal need not be given. See 37 CFR §2.145(b)(1), and Appeals to the Federal Circuit From PTO, supra. A copy of the decision being appealed, and a copy of any decision on reconsideration thereof, should be attached to the notice of appeal. See Appeals to the Federal Circuit From PTO, supra. If the appeal is taken from a decision of the Board in an inter partes proceeding, a copy of the notice must be served upon every other party to the proceeding, in the manner prescribed in 37 CFR §2.119 (see TBMP §113). See 37 CFR §2.145(b)(2).

For information concerning the ways (i.e., by hand delivery, first-class mail, etc.) in which a notice of appeal may be filed in the PTO, the filing date of a notice of appeal, and the address to be used on a notice of appeal mailed to the PTO, see 37 CFR §§1.6, 1.8, 1.10, and 2.145(b)(3); Waiver of Certificate of Mailing Requirement Under 37 CFR 1.10, 1174 TMOG 92 (May 16, 1995); Filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit in the Patent and Trademark Office, 1113 TMOG 29 (April 17, 1990); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990) (NOTE: the two 1990 Official Gazette notices must be read in light of subsequent rule amendments--for example, the 37 CFR §1.8 certificate procedures are now applicable to a notice of appeal from a decision of the Board, but were not in 1990). For further information concerning how to file a notice of appeal, contact the Office of the Solicitor in the PTO.

Three copies of the notice of appeal must be filed in the Court of Appeals for the Federal Circuit (NOTE: while 37 CFR §2.145(a) requires the filing of only one copy of the notice with the Federal Circuit, Federal Circuit Rule 15(a)(1) requires that three copies of the notice be filed with the Federal Circuit), and the appeal fee required by the rules of the Court must be paid to the Court. See 37 CFR §2.145(a). A copy of the decision being appealed, and a copy of any decision on

OLD EDITION

reconsideration thereof, should be attached to the copy of the notice. See Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990).

902.02 Time for Filing Notice of Appeal, Cross-Appeal

15 U.S.C. §1071(a)(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Commissioner, within such time after the date of the decision from which the appeal is taken as the Commissioner prescribes, but in no case less than 60 days after that date.

37 CFR §2.145(d) Time for appeal or civil action. (1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§2.127(b), 2.129(c) or §2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, whichever is later.

(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil action thereafter is

OLD EDITION

specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

37 CFR §2.145(e) Extensions of time to commence judicial review. The Commissioner may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

The time for filing a notice of appeal to the United States Court of Appeals for the Federal Circuit is two months from the date of the Board decision which is the subject of the appeal. See Section 21(a)(2) of the Act, 15 U.S.C. §1071(a)(2); 37 CFR §2.145(d)(1); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. §1051(b), applicant subject to that party's establishment of constructive use (see TBMP §901.02(b)), the time for filing an appeal runs from the date of the entry of judgment subject to establishment of constructive use. See 37 CFR §2.129(d), and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for filing an appeal expires two months after action on the request. See 37 CFR §2.145(d)(1).

In an inter partes case, the time for filing a notice of cross-appeal expires (1) 14 days after service of the notice of appeal, or (2) two months from the date of the Board decision which is the subject of the appeal, whichever is later. See 37 CFR §2.145(d)(1), and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990).

The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for filing a notice of appeal or a notice of cross-appeal.

If a written request to extend the time for appeal is filed before the expiration of the appeal period, the Commissioner may grant the request upon a showing of good cause. If the request is not filed until after the expiration of the appeal

OLD EDITION

period, the Commissioner may grant the request only upon a showing that the failure to act was the result of excusable neglect. See 37 CFR §2.145(e), and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor. See Appeals to the Federal Circuit From PTO, supra.

It is the Commissioner, not the Board, who determines whether a notice of appeal has been timely filed. If the Commissioner determines that a notice of appeal was not timely, the Commissioner notifies the Clerk of the Federal Circuit thereof. The Clerk in turn issues an order to the appellant to show cause why the appeal should not be dismissed, and refers appellant's response to the Court. See Federal Circuit Rule 15(b)(1), and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990).

An appellant which has received an order to show cause from the Clerk of the Federal Circuit may file a request under 37 CFR §2.145(e) for an extension of time to file an appeal, accompanied by a showing that the late filing of the notice of appeal was the result of excusable neglect. The request should be filed in the Office of the Solicitor, which will notify the Clerk of the Commissioner's decision on the request. A decision by the Commissioner granting the request will discharge the order to show cause. See Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990).

OLD EDITION

902.03 Appeal to Federal Circuit Waives Appeal by Civil Action

A party which takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board thereby waives its right to have remedy by way of civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b). See Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act), and 37 CFR §2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act). Cf. Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1) (party dissatisfied with decision of Board may, unless appeal has been taken to the Federal Circuit, have remedy by civil action), and TBMP §903.05.

However, in an inter partes case, if an adverse party, in response to the notice of appeal to the Federal Circuit, files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. See TBMP §§901.01 and 902.04.

902.04 Notice of Election to Have Review by Civil Action

15 U.S.C. §1071(a)(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8, or an applicant for renewal, who is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Commissioner, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b), of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

37 CFR §2.145(c)(3) Any adverse party to an appeal taken to the U.S. Court of Appeals for the Federal Circuit by a defeated party in an inter partes proceeding may file a notice with the Commissioner within twenty days after the filing of the defeated party's notice of appeal to the court (paragraph (b) of this section), electing to have all further proceedings conducted as provided in section 21(b) of the Act. The notice of election must be served as provided in §2.119.

37 CFR §2.145(d)(3) If a party to an inter partes proceeding has taken an appeal to the U.S. Court of Appeals for the Federal Circuit and an adverse party has filed notice under section 21(a)(1) of the Act electing to have all further proceedings conducted under section 21(b) of the Act, the time for filing a civil

OLD EDITION

action thereafter is specified in section 21(a)(1) of the Act. The time for filing a cross-action expires 14 days after service of the summons and complaint.

When a defeated party in an inter partes proceeding before the Board takes an appeal to the United States Court of Appeals for the Federal Circuit, any adverse party may, within 20 days after the filing of the notice of appeal, file a notice with the Commissioner electing to have all further proceedings conducted by way of civil action, under Section 21(b) of the Act, 15. U.S.C. §1071(b), seeking review of the decision which was the subject of the appeal. See Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1), and 37 CFR §2.145(c)(3). The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for filing a notice of election. A copy of the notice must be served upon every other party to the proceeding, in the manner prescribed in 37 CFR §2.119 (see TBMP §113). See 37 CFR §2.145(c)(3). A copy of the notice must also be filed with the Federal Circuit. See Federal Circuit Rule 15(e).

If an adverse party files a notice electing to have further proceedings conducted by way of civil action under Section 21(b) of the Act, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. See Section 21(a)(1) of the Act, and 37 CFR §2.145(d)(3). Any cross-action must be filed within 14 days after service of the summons and complaint in the civil action. See 37 CFR §2.145(d)(3).

OLD EDITION

902.05 Information Concerning Times Specified in 37 §CFR 2.145

37 CFR §2.145(d)(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR §2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times

specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for filing an appeal falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for filing an appeal is extended to the next day which is not a Saturday, Sunday, or Federal holiday. See 37 CFR §2.145(d)(2).

902.06 Certified List

When notice is filed in the PTO of an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the Commissioner sends to the Federal Circuit a statement indicating whether the notice of appeal was considered timely filed, and a certified list of the documents comprising the record in the PTO, i.e., a certified copy of the list of docket entries on the file jacket containing the PTO record of the proceeding (cf. TBMP §120.01), accompanied by a copy of the decision appealed.. See Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3); Federal Circuit Rules 15(b)(1) and 17(b)(1); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). A copy of the certified list is mailed by the PTO to every party to the proceeding. See Federal Circuit Rule 17(c) and Appeals to the Federal Circuit From PTO, supra.

When the Federal Circuit receives the notice of appeal and the certified list, the Court dockets the appeal, and gives notice to all parties of the date of docketing. See Federal Circuit Rule 15(b)(1), and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). The appellant's time in which to file its initial brief runs from the date of service of the certified list or the date of docketing the appeal, whichever is later. Because an appeal is not docketed until after the certified list is served in appeals from Board decisions, the appellant's time for filing its brief normally runs from the date of docketing. See Federal Circuit Rule 31(a), and Appeals to the Federal Circuit From PTO, supra.

902.07 Appeal Briefs, Appendix, etc.

For information concerning other matters of practice and procedure during an appeal to the United States Court of Appeals for the Federal Circuit from a Board decision, including information concerning motions, briefs, the appendix to the

OLD EDITION

briefs, oral argument, etc., see Federal Circuit Rules, and Appeals to the Federal Circuit From PTO, 1120 TMOG 22 (November 13, 1990). For information concerning the appendix, in particular, see Federal Circuit Rules 30 and 32, and Appeals to the Federal Circuit From PTO, supra, at page 25.

902.08 Special Provisions for Ex Parte Cases

If an applicant in an ex parte case takes an appeal to the United States Court of Appeals for the Federal Circuit from a decision of the Board, the applicant thereby waives its right to proceed by way of civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b). See Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1), and 37 CFR §2.145(c)(2).

On appeal to the Federal Circuit in an ex parte case, the Commissioner files a brief in support of the Board's decision. See Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3).

OLD EDITION

903 Appeal by Civil Action

903.01 Notice of Civil Action

37 CFR §2.145(c)(4) A party to a proceeding before the Trademark Trial and Appeal Board which commences a civil action, pursuant to Section 21(b) of the Act, seeking review of a decision of the Board should file written notice thereof in the Patent and Trademark Office, addressed to the Board, within one month after the expiration of the time for appeal or civil action, in order to avoid premature termination of the Board proceeding.

A party which commences a civil action, under Section 21(b) of the Act, 15 U.S.C. §1071(b) seeking review of a decision of the Board should file written notice thereof in the PTO, addressed to the Board, within one month after the expiration of the time for appeal or civil action. Failure to notify the Board of the commencement of the civil action may result in premature termination of the proceeding by the PTO. See 37 CFR §2.145(c)(4). That is, the PTO, being unaware of the commencement of the civil action, will treat the Board's decision as governing further proceedings in the case, and will take steps, based on the

judgment entered in that decision, to close out the proceeding file and give effect to the judgment. See TBMP §806.

903.02 Parties to Civil Action

15 U.S.C. §1071(b)(2) The Commissioner shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

When a party to a Board inter partes proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, the Commissioner shall not be made a party to the civil action. However, the clerk of the court in which the civil action is filed must notify the Commissioner of the filing of the

OLD EDITION

complaint, and the Commissioner has the right to intervene in the action. See Section 21(b)(2) of the Act, 15 U.S.C. §1071(b)(2).

The suit may be instituted against the party in interest as shown by the records of the PTO at the time of the decision of which review is sought, but any party in interest may become a party to the action. See Section 21(b)(4) of the Act, 15 U.S.C. §1071(b)(4).

When an applicant in an ex parte proceeding appeals a decision of the Board by commencing a civil action seeking review of the decision, a copy of the complaint must be served on the Commissioner (who is a party to the proceeding). See Section 21(b)(3) of the Act, 15 U.S.C. §1071(b)(3).

OLD EDITION

903.03 Place of Civil Action

15 U.S.C. §1071(b)(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

Generally, a civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), may be brought in any Federal district court which has jurisdiction over the person. However, if there are adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia has jurisdiction. See Section 21(b)(4), 15 U.S.C. §1071(b)(4); Del-Viking Productions Inc. v. Estate of Johnson, 31 USPQ2d 1063 (W.D.Pa. 1994); and Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 405-407 (1985). Cf. Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991), and Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc., 24 USPQ2d 1236 (S.D.N.Y. 1992).

903.04 Time for Filing Civil Action, Cross-Action

15 U.S.C. §1071(b)(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Commissioner or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be cancelled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Commissioner to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c).

37 CFR §2.145(d) Time for appeal or civil action. (1) The time for filing the notice of appeal to the U.S. Court of Appeals for the Federal Circuit (paragraph (b) of this section),or for commencing a civil action (paragraph (c) of this section), is two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, as the case may be. If a request for rehearing or reconsideration or modification of the decision is filed within the time specified in §§2.127(b), 2.129(c) or §2.144, or within any extension of time granted thereunder, the time for filing an appeal or commencing a civil action shall expire two months after action on the request. In inter partes cases, the time for filing a cross-action or a notice of a cross-appeal expires (i) 14 days after service of the notice of appeal or the summons and complaint; or (ii) two months from the date of the decision of the Trademark Trial and Appeal Board or the Commissioner, whichever is later.

* * *

(e) Extensions of time to commence judicial review. The Commissioner may extend the time for filing an appeal or commencing a civil action (1) for good cause shown if requested in writing before the expiration of the period for filing

OLD EDITION

an appeal or commencing a civil action, or (2) upon written request after the expiration of the period for filing an appeal or commencing a civil action upon a showing that the failure to act was the result of excusable neglect.

The time for commencing a civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), is two months from the date of the Board decision of which review is sought. See Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1); 37 CFR §2.145(d)(1); and Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). A civil action is commenced by the filing of a complaint with the court. See FRCP 3. When the Board enters judgment in favor of a Section 1(b), 15 U.S.C. §1051(b), applicant subject to that party's establishment of constructive use (see TBMP §901.02(b)), the time for commencing a civil action for review of the Board's decision runs from the date of the entry of judgment subject to establishment of constructive use. See 37 CFR §2.129(d), and Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991).

If a request for rehearing, reconsideration, or modification of the Board's decision is filed within the time specified in 37 CFR §§2.127(b), 2.129(c), or 2.144, or within any extension of time granted thereunder, the time for commencing a civil action expires two months after action on the request. See 37 CFR §2.145(d)(1).

In an inter partes case, the time for filing a cross-action expires (1) 14 days after service of the summons and complaint, or (2) two months from the date of the Board decision which is the subject of the civil action, whichever is later. See 37 CFR §2.145(d)(1).

If a written request to extend the time for commencing a civil action is filed before the expiration of the period for commencing a civil action, the Commissioner may grant the request upon a showing of good cause. If the request is not filed until after the expiration of the period for commencing a civil action, the Commissioner may grant the request only upon a showing that the failure to act was the result of excusable neglect. See 37 CFR §2.145(e). Cf.Appeals to the Federal Circuit From PTO, 1120 TMOG 22, 24 (November 13, 1990). A request for an extension of time to file an appeal should be directed to the attention of the Office of the Solicitor. Cf. Appeals to the Federal Circuit From PTO, supra.

OLD EDITION

903.05 Information Concerning Times Specified in 37 CFR §2.145

37 CFR §2.145(d)(2) The times specified in this section in days are calendar days. The times specified herein in months are calendar months except that one day shall be added to any two-month period which includes February 28. If the last day of time specified for an appeal, or commencing a civil action falls on a Saturday, Sunday or Federal holiday in the District of Columbia, the time is extended to the next day which is neither a Saturday, Sunday nor a Federal holiday.

In 37 CFR §2.145 (which concerns appeals and civil actions seeking review of Board decisions), the times specified in days are calendar days, while the times specified in months are calendar months (except that one day is added to any two-month period which includes February 28). If the last day of the time allowed for commencing a civil action falls on a Saturday, Sunday, or Federal holiday in the District of Columbia, the time for commencing a civil action is extended to the next day which is not a Saturday, Sunday, or Federal holiday. See 37 CFR §2.145(d)(2).

903.06 Civil Action Precluded by Appeal to Federal Circuit

In a proceeding before the Board, a party which is dissatisfied with the decision of the Board may have remedy by way of civil action, unless an appeal to the United States Court of Appeals for the Federal Circuit has been taken. See Section 21(b)(1) of the Act, 15 U.S.C. §1071(b)(1). Cf. Section 21(a)(1) of the Act, 15 U.S.C. §1071(a)(1) (party which appeals to the Federal Circuit thereby waives its right to proceed under Section 21(b) of the Act); 37 CFR §2.145(c)(2) (applicant in ex parte case which takes an appeal to the Federal Circuit waives any right to proceed under Section 21(b) of the Act); and TBMP §902.03.

However, in an inter partes case, if an appeal has been taken to the Federal Circuit, and a party adverse to the appellant files a notice electing to have further proceedings conducted instead by way of civil action, the appeal to the Federal Circuit will be dismissed, and the party which filed the appeal must commence a civil action, within 30 days after the filing of the notice of election, for review of the appealed decision, failing which that decision will govern further proceedings in the case. See TBMP §§901.01 and 902.04.

OLD EDITION

903.07 Special Provisions for Ex Parte Cases

15 U.S.C. §1071(b)(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Commissioner, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

When an applicant in an ex parte case seeks review of a decision of the Board by way of civil action under Section 21(b) of the Act, 15 U.S.C. §1071(b), all the expenses of the proceeding must be paid by the applicant which brought the suit, whether the final decision is in favor of the applicant or not, unless the court finds the expenses to be unreasonable. See Section 21(b)(3) of the Act, 15 U.S.C. §1071(b)(3).

OLD EDITION

904 Access to Record During Appeal

904.01 Access During Appeal to Federal Circuit

During an appeal to the United States Court of Appeals for the Federal Circuit, from a decision of the Board in an inter partes case, the Board retains the original PTO record of the case. However, when it deems necessary, the Federal Circuit may, upon motion or sua sponte, order transmission (via the Office of the Solicitor) of the original or certified copies of the record, or portions thereof, or the physical exhibits, at any time during the pendency of the appeal. See Section 21(a)(3) of the Act, 15 U.S.C. §1071(a)(3), and Federal Circuit Rule 17(a).

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record

which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the Federal Circuit amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the Court's order. See Federal Circuit Rules 17(d) and 17(e).

During an appeal to the Federal Circuit from a decision of the Board in an ex parte case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

904.02 Access During Appeal by Civil Action

During a civil action seeking review of a decision of the Board in an inter partes case, the Board retains the original PTO record of the case. The Board will release the original record for submission (via the Office of the Solicitor) to the court in which the civil action is pending only upon order of the court.

The Board will permit a party, or its attorney or other authorized representative, to inspect and copy any portions of the record, including papers, transcripts, and exhibits, which are not subject to a protective order. Any portions of the record which are subject to a protective order may be inspected and copied only in accordance with the terms of the protective order, unless the court amends, modifies, or annuls the protective order, in which case access by a party, or its attorney or other authorized representative, to the record will be governed by the court's order.

During a civil action seeking review of a decision of the Board in an ex parte case, the subject application file is kept at the Office of the Solicitor. Any request for access to the application should be directed to the Office of the Solicitor.

905 Petition to the Commissioner

37 CFR §2.146 Petitions to the Commissioner.

OLD EDITION

(a) Petition may be taken to the Commissioner: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Commissioner; (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner.

(c) Every petition to the Commissioner shall include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief that is requested, and the requisite fee (see §2.6). Any brief in support of the petition shall be embodied in or accompany the petition. When facts are to be proved in ex parte cases (as in a petition to revive an abandoned application), the proof in the form of affidavits or declarations in accordance with §2.20, and any exhibits, shall accompany the petition.

(d) A petition on any matter not otherwise specifically provided for shall be filed within sixty days from the date of mailing of the action from which relief is requested.

(e)(1) A petition from the denial of a request for an extension of time to file a notice of opposition shall be filed within fifteen days from the date of mailing of the denial of the request and shall be served on the attorney or other authorized representative of the applicant, if any, or on the applicant. Proof of service of the petition shall be made as provided by §2.119(a). The applicant may file a response within fifteen days from the date of service of the petition and shall serve a copy of the response on the petitioner, with proof of service as provided by §2.119(a). No further paper relating to the petition shall be filed.

(2) A petition from an interlocutory order of the Trademark Trial and Appeal Board shall be filed within thirty days after the date of mailing of the order from

OLD EDITION

which relief is requested. Any brief in response to the petition shall be filed, with any supporting exhibits, within fifteen days from the date of service of the petition. Petitions and responses to petitions, and any papers accompanying a petition or response, under this subsection shall be served on every adverse party pursuant to §2.119(a).

(f) An oral hearing will not be held on a petition except when considered necessary by the Commissioner.

(g) The mere filing of a petition to the Commissioner will not act as a stay in any appeal or inter partes proceeding that is pending before the Trademark Trial and Appeal Board nor stay the period for replying to an Office action in an application except when a stay is specifically requested and is granted or when §§2.63(b) and 2.65 are applicable to an ex parte application.

(h) Authority to act on petitions, or on any petition, may be delegated by the Commissioner.

The only type of Board decision which may be appealed, whether to the United States Court of Appeals for the Federal Circuit or by way of civil action, is a final decision, i.e., a "final dispositive ruling that ends litigation on the merits" before the Board. Interlocutory decisions or orders, i.e., decisions or orders that do not put an end to the litigation before the Board, are not appealable. Appealability is not limited to decisions issued by the Board after final hearing. Other types of Board decisions are also appealable, in those cases where they put an end to the litigation before the Board. See TBMP §901.02(a), and cases cited therein.

When a final decision of the Board is reviewed on appeal, interlocutory orders or decisions issued during the course of the proceeding before the Board may also be reviewed if they are "logically related" to the basic substantive issues in the case. See TBMP §901.02(a), and cases cited therein.

In an inter partes proceeding, a party may obtain review of an order or decision of the Board which concerns matters of procedure (rather than the central issue or issues before the Board), and does not put an end to the litigation before the Board, by timely petition to the Commissioner. See 37 CFR §2.146; Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 USPQ 888 (CCPA 1980); Palisades Pageants, Inc. v. Miss America Pageant, 442 F.2d 1385, 169 USPQ 790 (CCPA 1971), cert. denied, 404 U.S. 938, 171 USPQ 641 (1971); Miss Nude Florida, Inc. v. Drost, 198 USPQ 485 (Comm'r 1977); Martin

OLD EDITION

Marietta Corp. v. Lith-Kem Corp., 184 USPQ 492 (Comm'r 1974); Aloe Creme Laboratories, Inc. v. Magic of Aloe, Inc., 182 USPQ 45 (Comm'r 1973); Hudson Pharmaceutical Corp. v. Laboratorios Hosbon, S.A., 177 USPQ 707 (Comm'r 1973); Johnson & Johnson v. Cenco Medical/Health Supply Corp., 177 USPQ 586 (Comm'r 1973); Outdoor Sports Industries, Inc. v. Joseph & Feiss Co., 177 USPQ 533 (Comm'r 1973); and Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43 (Comm'r 1971). For further information concerning which Board decisions are petitionable and which are appealable, see the foregoing decisions. Cf. 37 CFR 2.146(b) (questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056, and 1091, are not considered to be appropriate subject matter for petition to the Commissioner).

A petition to the Commissioner from an interlocutory order or decision of the Board, in a Board inter partes proceeding, must be filed within 30 days after the mailing date of the order or decision from which relief is requested. Any brief in response to the petition must be filed, with any supporting exhibits, within 15 days from the date of service of the petition. Petitions from an interlocutory order or decision of the Board, responses to such petitions, and any papers accompanying a petition or response, must be served on every adverse party in the manner prescribed in 37 CFR §2.119(a) (see TBMP §113). See 37 CFR §2.146(e)(2).

For information concerning a petition to the Commissioner from the denial, or from the granting, of a request for an extension of time to file a notice of opposition, see 37 CFR §2.146(e)(1), and TBMP §211.02.

A petition on any matter not otherwise specifically provided for must be filed within 60 days from the mailing date of the action from which relief is requested. See 37 CFR §2.146(d).

The mere filing of a petition to the Commissioner will not act as a stay in any ex parte appeal or inter partes proceeding pending before the Board. See 37 CFR §2.146(g); In re Unistar Radio Networks Inc., 30 USPQ2d 1390 (Comm'r 1993); and In re Rent A Boxx Moving Systems Inc., 25 USPQ2d 1399 (Comm'r 1992).

A petition to the Commissioner must include a statement of the facts relevant to the petition, the points to be reviewed, the action or relief requested, and the fee required by 37 CFR §2.6. Any brief in support of the petition must be embodied

OLD EDITION

in or accompany the petition. When facts are to be proved in ex parte cases, the proof, in the form of affidavits or declarations in accordance with 37 CFR §2.20, and any exhibits, must accompany the petition. See 37 CFR §2.146(c).

An oral hearing will not be held on a petition to the Commissioner except when considered necessary by the Commissioner. See 37 CFR §2.146(f).

For further information concerning petitions to the Commissioner, see 37 CFR §2.146. Cf. TMEP §§1701-1705.

OLD EDITION

CHAPTER 1000 INTERFERENCES

1001 In General

1002 Declaration of Interference

1003 Institution of Interference

1004 Issues in Interference

1005 Burden of Proof

1006 Addition of Party

1007 Conduct of Proceeding

OLD EDITION

1001 In General

15 U.S.C.§1066. Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.

37 CFR §2.83 Conflicting marks.
(a) Whenever an application is made for registration of a mark which so resembles another mark or marks pending registration as to be likely to cause confusion or mistake or to deceive, the mark with the earliest effective filing date will be published in the Official Gazette for opposition if eligible for the Principal Register, or issued a certificate of registration if eligible for the Supplemental Register.

(b) In situations in which conflicting applications have the same effective filing date, the application with the earliest date of execution will be published in the Official Gazette for opposition or issued on the Supplemental Register.

(c) Action on the conflicting application which is not published in the Official Gazette for opposition or not issued on the Supplemental Register will be suspended by the Examiner of Trademarks until the published or issued application is registered or abandoned.

37 CFR §2.91 Declaration of interference.
(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Commissioner. Interferences will be declared by the Commissioner only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

OLD EDITION

An interference is a proceeding in which the Board determines which, if any, of the owners of conflicting applications (or of one or more applications and one or more registrations which are in conflict) is entitled to registration. See Sections 16 and 18 of the Act, 15 U.S.C. §§1066 and 1068. A "conflict" exists, for interference purposes, whenever "application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive." See Section 16 of the Act, 15 U.S.C. §1066. See also Section 2(d) of the Act, 15 U.S.C. §1052(d); 37 CFR §2.83; and TMEP §1208.01(a).

Ordinarily, when conflicting applications are pending, the application with the earliest effective filing date is approved for publication in the Official Gazette for opposition (if the mark is eligible for registration on the Principal Register), or is registered on the Supplemental Register (if the mark is eligible for registration on the Supplemental Register). Action on any later-filed conflicting application is suspended until the earlier-filed application is registered or abandoned. See 37 CFR §2.83, and TMEP §1208.01.

If the owner of an application which conflicts with one or more pending applications wishes to have the PTO set up an interference proceeding between the conflicting applications, rather than have the PTO follow the procedure described in 37 CFR §2.83, that applicant must file a petition to the Commissioner to declare an interference. See Section 16 of the Act, 15 U.S.C. §1066; 37 CFR §2.91(a); and TBMP §1002.

NOTE: Although the Commissioner is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable), it is not the Commissioner's practice to do so. See TBMP §1002, and authorities cited therein.

1002 Declaration of Interference

OLD EDITION

15 U.S.C.§1066. Upon petition showing extraordinary circumstances, the Commissioner may declare that an interference exists when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive. No interference shall be declared between an application and the registration of a mark the right to use of which has become incontestable.

37 CFR §2.91 Declaration of interference.
(a) An interference will not be declared between two applications or between an application and a registration except upon petition to the Commissioner. Interferences will be declared by the Commissioner only upon a showing of extraordinary circumstances which would result in a party being unduly prejudiced without an interference. In ordinary circumstances, the availability of an opposition or cancellation proceeding to the party will be deemed to remove any undue prejudice.

(b) Registrations and applications to register on the Supplemental Register, registrations under the Act of 1920, and registrations of marks the right to use of which has become incontestable are not subject to interference.

Under Section 16 of the Act of 1946, 15 U.S.C. §1066, the Commissioner, upon petition showing extraordinary circumstances, may declare that an interference exists when an application conflicts with a registration issued to another, or with an application previously filed by another, that is, "when application is made for the registration of a mark which so resembles a mark previously registered by another, or for the registration of which another has previously made application, as to be likely when used on or in connection with the goods or services of the applicant to cause confusion or mistake or to deceive.".

A petition for declaration of an interference will be granted by the Commissioner only if the petition shows "extraordinary circumstances which would result in a party being unduly prejudiced without an interference." See 37 CFR §2.91(a). See also In re Ratny, 24 USPQ2d 1713 (Comm'r 1992); In re Kimbell Foods, Inc., 184 USPQ 172 (Comm'r 1974); and In re Family Inns of America, Inc., 180 USPQ 332 (Comm'r 1974). Ordinarily, the availability of an opposition or cancellation proceeding is deemed to prevent any undue prejudice from the unavailability of an interference proceeding. See 37 CFR §2.91(a). See also In re Kimbell Foods, Inc., supra. However, a petition to the Commissioner to

OLD EDITION

declare an interference has been granted where, but for the interference, multiple oppositions would be necessary. See In re Family Inns of America, Inc., supra. See also TMEP §§1208.04 and 1208.04(b).

Although the Commissioner is authorized by Section 16 of the Act to declare an interference between an application and a registration (except for registrations issued on the Supplemental Register, registrations issued under the Act of 1920, and registrations of marks the right to use of which has become incontestable--see Sections 16, 26, and 46(b) of the Act, and 37 CFR §2.91(b)), it is not the Commissioner's practice to do so. See In re Kimbell Foods, Inc., 184 USPQ 172 (Comm'r 1974), and Ex parte H. Wittur & Co., 153 USPQ 362 (Comm'r 1966). This is because a registration will not be cancelled as a result of a decision in an interference proceeding. A formal petition for cancellation must still be filed and granted, and the registration must be cancelled, before any registration will be issued to the applicant. See 37 CFR §2.96; In re Kimbell Foods, Inc., supra; Ex parte H. Wittur & Co., supra; Hy-Pure Laboratories, Inc. v. Foley & Co., 98 USPQ 280 (Chief Examiner 1953); and Cudahy Packing Co. v. York Pharmacal Co., 93 USPQ 227 (Comm'r 1952). The interference proceeding is superfluous, since the cancellation proceeding by itself will accomplish the same purpose as the two proceedings together.

A petition to the Commissioner to declare an interference should be made by separate paper bearing the title "PETITION TO THE COMMISSIONER," and be accompanied by the fee specified in 37 CFR §2.6(k). For further information concerning the form for a petition to the Commissioner, see 37 CFR 2.§146(c), and TBMP §905.

A petition to declare an interference should not be filed in an application until the application has been examined by the Trademark Examining Attorney, and the mark has been found registrable but for the existence of one or more pending conflicting applications. When such a petition is filed, the Examining Attorney will immediately forward the petition, together with the application file, to the Assistant Commissioner for Trademarks for determination of the petition. See TMEP §1208.04(a).

1003 Institution of Interference

37 CFR §2.92 Preliminary to interference.

OLD EDITION

An interference which has been declared by the Commissioner will not be instituted by the Trademark Trial and Appeal Board until the Examiner of Trademarks has determined that the marks which are to form the subject matter of the controversy are registrable, and all of the marks have been published in the Official Gazette for opposition.

37 CFR §2.93 Institution of interference.
An interference is instituted by the mailing of a notice of interference to the parties. The notice shall be sent to each applicant, in care of the applicant's attorney or other representative of record, if any, and if one of the parties is a registrant, the notice shall be sent to the registrant or the registrant's assignee of record. The notice shall give the name and address of every adverse party and of the adverse party's attorney or other authorized representative, if any, together with the serial number and date of filing and publication of each of the applications, or the registration number and date of issuance of each of the registrations, involved.

An interference proceeding does not commence with the granting of a petition to the Commissioner to declare an interference. Rather, the interference proceeding will not be instituted unless and until the Trademark Examining Attorney has determined that the marks which are to be included in the interference are registrable, but for the interfering marks; and all of the marks have been published (preferably together) in the Official Gazette for opposition, subject to the interference. See 37 CFR §2.92, and TMEP §1208.04(c).

If an application published subject to interference is opposed by an entity which is not to be a party to the interference, the opposition may be determined first, following which the interference, if still necessary and appropriate, will be instituted (cf. 37 CFR §2.99(c)); alternatively, depending upon the circumstances, the opposition and interference may go forward contemporaneously. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve three or more parties, the opposition will be dismissed without prejudice in favor of the interference proceeding, wherein the rights of all parties can be determined in a single proceeding. If an opposition is filed by an entity which is to be a party to the interference, and the interference is to involve only two parties, the rights of the parties will be determined in the opposition, and the interference will not be instituted.

OLD EDITION

If the marks which are to be included in an interference (1) are found by the Trademark Examining Attorney to be registrable, (2) are published for opposition, and (3) survive the opposition period (as indicated in the preceding paragraph), the interference proceeding will be instituted by the Board.

The Board prepares a "notice of interference" notifying the parties that the interference proceeding is thereby instituted, and setting trial and briefing dates in the case. The notice specifies the name and address of each party to the proceeding and of each party's attorney or other authorized representative, if any; the mark of each party; and the serial number, filing date, and publication date of each involved application. See 37 CFR §2.93.

An interference proceeding commences when the Board mails the notice of interference to the parties. The notice is mailed to the attorney or other authorized representative of each involved applicant, or, if the applicant does not have an attorney or other authorized respresentative, to the applicant. See 37 CFR §2.93.

It is not the Commissioner's practice to declare an interference with a registration. See TBMP §1002, and cases cited therein. However, should the Commissioner elect to declare an interference with one or more registrations, the notice of interference would specify the registration number and issuance date of each involved registration, and would be mailed to the registrant or its assignee of record. See 37 CFR §2.93.

There are no pleadings in an interference proceeding. Cf. TBMP §§1004, 1105, and 1106. The notice of interference takes the place of pleadings, to the extent that it serves to provide each party with information concerning the involved application (or registration, if an interference should be declared with one or more registrations) of every adverse party.

There is no fee for an interference proceeding, beyond the fee required for a petition to the Commissioner to declare an interference. See 37 CFR §2.6. Cf. TBMP §1002.

OLD EDITION

1004 Issues in Interference

37 CFR §2.96 Issue; burden of proof.

The issue in an interference between applications is normally priority of use, but the rights of the parties to registration may also be determined. ... The issue in an interference between an application and a registration shall be the same, but in the event the final decision is adverse to the registrant, a registration to the applicant will not be authorized so long as the interfering registration remains on the register.

Normally, the issue to be determined in an interference proceeding is priority of use. However, such additional issues as the registrability of each mark, and whether there is, in fact, a conflict between the marks involved in the proceeding (i.e., whether the marks do so resemble one another as to be likely, when used in connection with the respective goods and/or services of the parties, to cause confusion, mistake, or deception), are always before the Board in an interference, and may also be determined; there is no requirement that a party file an affirmative pleading of such matters in order to be heard thereon. See, for example, Sections 17 and 18 of the Act, 15 U.S.C. §§1067 and 1068; 37 CFR §2.96; Giant Food Inc. v. Malone & Hyde, Inc., 522 F.2d 1386, 187 USPQ 374, 380 (CCPA 1975); Dynamet Technology, Inc. v. Dynamet Inc., 197 USPQ 702 (TTAB 1977), aff'd, 593 F.2d 1007, 201 USPQ 129 (CCPA 1979); Jos. Schlitz Brewing Co. v. United Vintners, Inc., 166 USPQ 493, 494 (TTAB 1970); Clairol Inc. v. Holland Hall Products, Inc., 165 USPQ 214, 217-218 (TTAB 1970); Tudor Square Sportswear, Inc. v. Pop-Op Corp., 160 USPQ 50, 53-54 (TTAB 1968); La Jolla Sportswear Co. v. Maskuline Underwear Co., 114 USPQ 130, 131 (Comm'r 1957); Saul Lefkowitz and Janet E. Rice, Adversary Proceedings Before the Trademark Trial and Appeal Board, 75 Trademark Rep. 323, 325 (1985); and Notice of Final Rulemaking published in the Federal Register on May 23, 1983 at 48 FR 23122, and in the Official Gazette of June 21, 1983 at 1031 TMOG 13 (deleting former 37 CFR §2.97, which contained a requirement for an affirmative pleading of registrability issues).

OLD EDITION

1005 Burden of Proof

37 CFR §2.96 Issue; burden of proof.
... The party whose application involved in the interference has the latest filing date is the junior party and has the burden of proof. When there are more than two parties to an interference, a party shall be a junior party to and shall have the burden of proof as against every other party whose application involved in the interference has an earlier filing date. If the involved applications of any

parties have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. ...

37 CFR §2.116(b) ... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

In an interference proceeding, the party whose involved application has the latest filing date is the junior party. When there are three or more parties to an interference, a party is a junior party to every other party whose involved application has an earlier filing date. If the involved applications of any parties have the same filing date, the application with the latest date of execution is deemed to have the latest filing date, and that applicant is the junior party. See 37 CFR §2.96.

A junior party in an interference proceeding is in the position of plaintiff, and has the burden of proof, as against every party that is senior, that is, as against every party whose involved application has an earlier filing date. Conversely, a senior party is in the position of defendant as against every party that is junior, that is, as against every party whose involved application has a later filing date. See 37 CFR §§2.96 and 2.116(b). See also Jim Dandy Co. v. Martha White Foods, Inc., 458 F.2d 1397, 173 USPQ 673 (CCPA 1972); and McNeil v. Mini Mansions, Inc., 178 USPQ 312 (TTAB 1973).

OLD EDITION

1006 Addition of Party

37 CFR §2.98 Adding party to interference.
A party may be added to an interference only upon petition to the Commissioner by that party. If an application which is or might be the subject of a petition for addition to an interference is not added, the examiner may suspend action on the application pending termination of the interference proceeding.

A party may be added to an interference only upon petition to the Commissioner filed, pursuant to 37 CFR §2.98, by the party to be added.

For information concerning joining or substituting a transferee when there has been an assignment of a mark which is involved in an interference proceeding, see TBMP §512.01.

1007 Conduct of Proceeding

Once commenced (see TBMP §§1002 and 1003), an interference proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that there are no pleadings (see TBMP §§1003 and 1004), and therefore no motions relating to pleadings; the issues of priority of use, likelihood of confusion, and registrability are always before the Board (see TBMP §1004); a party's burden of proof as against another party to the proceeding depends upon the filing date of its involved application (see TBMP §1005); and additional parties may be added to the proceeding upon petition to the Commissioner filed by the party to be added (see TBMP §1006).

In addition, the trial and briefing schedule in an interference involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation. In the notice of interference which commences an interference proceeding, the Board sets trial and briefing dates in the case. See TBMP §1003. Specifically, the Board sets a closing date for discovery (which opens when the notice of interference is served by the Board upon the parties), and schedules testimony periods so that each party in the position of plaintiff (see TBMP §1005) will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal; the testimony periods are separated from the discovery period and from each other by 30-day intervals. See TBMP §701. Similarly, the Board schedules briefing periods so that each party, beginning with the junior-most party and ending with the senior-most party, will have a time for filing its main brief on the case, and each junior party will have a time for filing a reply brief. See TBMP §801.02(e).

Set forth below is a sample trial and briefing schedule for an interference involving parties A, B, C, D, and E, where A is junior to every other party; B is junior to C, D, and E, and senior to A; C is junior to D and E, and senior to A

OLD EDITION

and B; D is junior to E, and senior to A, B, and C; and E is senior to every other party:

THE PERIOD FOR DISCOVERY TO CLOSE	: July 2, 1984
Testimony period for A to close (opening 30 days prior thereto)	: August 31, 1984
Testimony period for B to close (opening 30 days prior thereto)	: October 30, 1984
Testimony period for C to close (opening 30 days prior thereto)	: December 31, 1984
Testimony period for D to close (opening 30 days prior thereto)	: March 1, 1985
Testimony period for E to close (opening 30 days prior thereto)	: April 30, 1985
Rebuttal testimony period for A to close (opening 15 days prior thereto)	: June 14, 1985
Rebuttal testimony period for B to close (opening 15 days prior thereto)	: July 29, 1985
Rebuttal testimony period for C to close (opening 15 days prior thereto)	: September 12, 1985
Rebuttal testimony period for D to close (opening 15 days prior thereto)	: October 28, 1985

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for A shall be due	: December 27, 1985

OLD EDITION

Brief for B shall be due	: January 26, 1986
Brief for C shall be due	: February 25, 1986
Brief for D shall be due	: March 27, 1986
Brief for E shall be due	: April 26, 1986

Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due	: May 11, 1986
Reply brief for B shall be due	: May 26, 1986
Reply brief for C shall be due	: June 10, 1986
Reply brief for D shall be due	: June 25, 1986

With the exceptions noted above, the practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in an interference as in an opposition or cancellation.

OLD EDITION

CHAPTER 1100 CONCURRENT USE PROCEEDINGS

1101 In General

1102 Generation of Proceeding

1103 Parties to Proceeding; Involved Applications, Registrations

1104 Applications and Registrations Not Subject to Proceeding

1105 Commencement of Proceeding

1106 Answer

1107 Issue; Burden of Proof

1108 Conduct of Proceeding

1109 Settlement Providing for Concurrent Registration

1110 Effect of Abandonment of Involved Application

1111 Effect of Adverse Decision in Opposition or Cancellation

1112 "Conversion" of Opposition to Concurrent Use Proceeding

1113 Alteration of Limitations on Concurrent Registration

OLD EDITION

1101 In General

15 U.S.C.§1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --

* * *

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

15 U.S.C. §1067. In every case of interference, opposition to registration, application to register as a lawful concurrent user, or application to cancel the registration of a mark, the Commissioner shall give notice to all parties and shall direct a Trademark Trial and Appeal Board to determine and decide the respective rights of registration. ...

OLD EDITION

15 U.S.C. §1068. In such proceedings the Commissioner may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or registration by limiting the goods or services specified therein, may otherwise restrict or rectify with respect to the register the registration of a registered mark, may refuse to register any or all of several interfering marks, or may register the mark or marks for the person or persons entitled thereto, as the rights of the parties hereunder may be established in the proceedings: Provided, That in the case of the registration of any mark based on concurrent use, the Commissioner shall determine and fix the conditions and limitations provided for in subsection (d) of section 2 of this Act. ...

1101.01 Nature of Proceeding

A concurrent use registration proceeding (hereafter referred to as a "concurrent use proceeding") is an inter partes proceeding in which the Board determines whether one or more applicants is entitled to a concurrent registration, that is, a registration with conditions and limitations, fixed by the Board, as to the mode or place of use of the applicant's mark or the goods and/or services on or in connection with which the mark is used. See, for example, Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§1052(d), 1067, and 1068; Houlihan v. Parliament Import Co., 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990); Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820 (CCPA 1980); Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995); Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990); Pinocchio's Pizza Inc. v. Sandra Inc., 11 USPQ2d 1227 (TTAB 1989); Women's World Shops Inc. v. Lane Bryant Inc., 5 USPQ2d 1985 (TTAB 1988); Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879 (TTAB 1985); and Ole' Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912 (TTAB 1984).

OLD EDITION

The Board's determination of registrability in a concurrent use proceeding is governed by Section 2(d) of the Act. That section provides, in part, that if the Commissioner (acting through the Board--see Section 17 of the Act, 15 U.S.C. §1067):

> ... determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when

> they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to ...

a certain specified date (normally, prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding, or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905--see: TBMP §1102.02(a)(2)). See, for example, Fleming Companies v. Thriftway Inc., 26 USPQ2d 1551 (S.D.Ohio 1992); Houlihan v. Parliament Import Co., 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990); Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); In re Beatrice Foods Co., 429 F.2d 466, 166 USPQ 431 (CCPA 1970); Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995); DataNational Corp. v. BellSouth Corp., 18 USPQ2d 1862 (TTAB 1991); Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990); and Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879 (TTAB 1985).

1101.02 Context for PTO Determination of Concurrent Rights

37 CFR §2.99(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.

37 CFR §2.133(c) Geographic limitations will be considered and determined by the Trademark Trial and Appeal Board only in the context of a concurrent use registration proceeding.

Within the PTO, the right to concurrent registration is determined by the Board. See Sections 2(d), 17, and 18 of the Act, 15 U.S.C. §§1052(d), 1067, and 1068. Concurrent rights are considered and determined by the Board only in the context of a concurrent use proceeding. See, for example, 37 CFR §§2.99(h) and 2.133(c); Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984); Mother's Restaurant Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983); Rosso & Mastracco, Inc. v. Giant Food Inc., 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983); Selfway, Inc. v. Travelers Petroleum, Inc., 579 F.2d 75, 198 USPQ 271 (CCPA 1978); American Security Bank v. American Security and Trust Co., 571 F.2d 564, 197 USPQ 65 (CCPA 1978); Giant Food Inc. v. Malone & Hyde, Inc., 522 F.2d 1386, 187 USPQ 374 (CCPA 1975); Hollowform, Inc. v. Delma AEH, 515 F.2d 1174, 185 USPQ 790

OLD EDITION

(CCPA 1975); Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990); In re Appetito Provisions Co., 3 USPQ2d 1553 (TTAB 1987); Village Inn Pizza Parlors, Inc. v. Los Tios Mexican Restaurants, Inc., 215 USPQ 476 (TTAB 1982); U.S. Soil, Inc. v. Colovic, 214 USPQ 471 (TTAB 1982); May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978); and Zimmerman v. Holiday Inns of America, Inc., 123 USPQ 86 (TTAB 1959).

A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173(a), nor may a Section 7(e) amendment generally be used to remove a concurrent use restriction from a registration. However, removal of a concurrent use restriction by amendment under Section 7(e) may be permitted where an entity which was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. See TBMP §1113, and cases cited therein.

OLD EDITION

1101.03 Bases for Concurrent Registration

There are two bases upon which a concurrent registration may be issued.

First, a concurrent registration may be issued when the Board has determined, in a concurrent use proceeding, that an applicant for concurrent registration is entitled thereto. See TBMP §1101.01, and authorities cited therein.

Second, a concurrent registration may be issued "when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce." See Section 2(d) of the Act, 15 U.S.C. §1052(d). See also 37 CFR §2.99(f); Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962); Morgan Services Inc. v. Morgan Linen Services Inc., 12 USPQ2d 1841 (TTAB 1989); In re Forbo, 4 USPQ2d 1415 (Comm'r 1984); In re Alfred Dunhill Ltd., 4 USPQ2d 1383 (Comm'r 1987); and Chichi's, Inc. v. Chi-Chi's, Inc., 222 USPQ 831 (Comm'r 1984).

1102 Generation of Proceeding

1102.01 Means of Generation

A concurrent use proceeding before the Board may be generated only by way of an application for registration as a lawful concurrent user (hereafter referred to as a "concurrent use application"). See Chichi's, Inc. v. Chi-Chi's, Inc., 222 USPQ 831 (Comm'r 1984); Inland Oil & Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977); Hollowform, Inc. v. Delma AEH, 180 USPQ 284 (TTAB 1973), aff'd, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975); Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982); and Rany L. Simms, TIPS FROM THE TTAB: The Concurrent User as Opposer, 67 Trademark Rep. 654 (1977). A concurrent use application is an application in which applicant (1) concedes that its use is not exclusive, (2) specifies the goods and/or services and area or mode of use for which it desires registration, (3) identifies, as exceptions to its claim of exclusive use, one or more persons (unrelated to applicant) which use the same or similar mark, for the same or similar goods or services, concurrently with applicant, and (4) provides, to the extent of the applicant's knowledge, certain information concerning use of the mark by each listed concurrent user. See Sections 1(a)(1)(A) and 2(d) of the Act, 15 U.S.C. §§1051(a)(1)(A) and 1052(d); 37 CFR §2.42; and TMEP §§202.04(c); 1207.04(b); and 1207.04(d). For further information concerning the requirements for a concurrent use application, see TBMP §1102.02.

There are two types of concurrent use applications, namely, the application seeking concurrent registration on the basis of a Board determination, in a prior or to-be-instituted concurrent use proceeding, of registrability; and the application seeking concurrent registration on the basis of a prior court determination of concurrent rights. These two types of concurrent use applications are the only means by which a geographically restricted registration may be obtained. See TBMP §§1101.02 and 1101.03. Thus, for example, an applicant may not, by including a geographical restriction in its identification of goods and/or services, obtain a geographically restricted registration without a concurrent use proceeding. See In re Home Federal Savings & Loan Ass'n, 213 USPQ 68 (TTAB 1982).

If an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding meets certain requirements (in addition to those necessary for all concurrent use applications--see 37 CFR §2.42, and TBMP §1102.02), the registration sought, if otherwise appropriate, will be issued based on the Board's prior decision. A new concurrent use

OLD EDITION

proceeding before the Board will not be necessary, because of the legal principles of res judicata and stare decisis. Cf. 37 CFR §2.99(f). For information concerning the requirements for an application seeking concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding, see TBMP §1102.02(a)(4).

Similarly, if an application seeking concurrent registration on the basis of a prior court determination of concurrent rights meets certain requirements, in addition to those necessary for all concurrent use applications, the registration sought, if otherwise appropriate, will be issued based on the court determination, without any concurrent use proceeding before the Board. See 37 CFR §2.99(f). For information concerning the requirements for an application seeking concurrent registration on the basis of a prior court determination of concurrent rights, see TBMP §1102.02(b).

OLD EDITION

1102.02 Requirements for Concurrent Use Application

15 U.S.C. §1051(a) The owner of a trademark used in commerce may apply to register his or her trademark under this Act on the principal register hereby established:

(1) By filing in the Patent and Trademark Office--

(A) a written application, in such form as may be prescribed by the Commissioner, ... Provided, That in the case of every application claiming concurrent use the applicant shall state exceptions to his claim of exclusive use, in which he shall specify, to the extent of his knowledge, any concurrent use by others, the goods on or in connection with which and the areas in which each concurrent use exists, the periods of each use, and the goods and area for which the applicant desires registration; ...

15 U.S.C.§1052. No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it --

* * *

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in

connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Commissioner shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

37 CFR §2.42 Concurrent use.
An application for registration as a lawful concurrent user shall specify and contain all the elements required by the preceding sections. The applicant in addition shall state in the application the area, the goods, and the mode of use for which applicant seeks registration; and also shall state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; registrations issued to or applications filed by such others, if any; the areas of such use; the goods on or in connection with which such use is made; the mode of such use; and the periods of such use.

37 CFR §2.73(b) An application under section 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of §2.42. The examiner will determine whether the application, as amended, is acceptable.

OLD EDITION

37 CFR §2.99 Application to register as concurrent user.
(a) An application for registration as a lawful concurrent user will be examined in the same manner as other applications for registration.

(b) When it is determined that the mark is ready for publication, the applicant may be required to furnish as many copies of his application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application for registration.

(c) Upon receipt of the copies required by paragraph (b) of this section, the examiner shall forward the application for concurrent use registration for publication in the Official Gazette as provided by §2.80. If no opposition is filed, or if all oppositions that are filed are dismissed or withdrawn, the Trademark Trial and Appeal Board shall prepare a notice for the applicant for concurrent use registration and for each applicant, registrant or user specified as a concurrent user in the application. The notices for the specified parties shall state the name and address of the applicant and of the applicant's attorney or other authorized representative, if any, together with the serial number and filing date of the application.

(d)(1) The notices shall be sent to each applicant, in care of his attorney or other authorized representative, if any, to each user, and to each registrant. A copy of the application shall be forwarded with the notice to each party specified in the application.

(2) An answer to the notice is not required in the case of an applicant or registrant whose application or registration is specified as a concurrent user in the application, but a statement, if desired, may be filed within forty days after the mailing of the notice; in the case of any other party specified as a concurrent user in the application, an answer must be filed within forty days after the mailing of the notice.

(3) If an answer, when required, is not filed, judgment will be entered precluding the specified user from claiming any right more extensive than that acknowledged in the application(s) for concurrent use registration, but the applicant(s) will remain with the burden of proving entitlement to registration(s).

(e) The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use

OLD EDITION

registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.

(f) When a concurrent use registration is sought on the basis that a court of competent jurisdiction has finally determined that the parties are entitled to use the same or similar marks in commerce, a concurrent use registration proceeding will not be instituted if all of the following conditions are fulfilled:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party to the court proceeding; and

(2) The court decree specifies the rights of the parties; and

(3) A true copy of the court decree is submitted to the examiner; and

(4) The concurrent use application complies fully and exactly with the court decree; and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Commisssioner in accordance with the court decree.

If any of the conditions specified in this paragraph is not satisfied, a concurrent use registration proceeding shall be prepared and instituted as provided in paragraphs (a) through (e) of this section.

(g)Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications to register under section 1(b) of the Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed.

(h) The Trademark Trial and Appeal Board will consider and determine concurrent use rights only in the context of a concurrent use registration proceeding.

OLD EDITION

1102.02(a) Application Based on Board Determination

1102.02(a)(1) Application Must Assert Use in Commerce

A basic requirement for any concurrent use application (whether it is to be based on a Board determination, through a concurrent use proceeding, of applicant's right to concurrent registration, or whether it is based on a prior court determination of applicant's concurrent use rights) is that it must assert use in commerce of the mark sought to be registered. Section 2(d) of the Act, 15 U.S.C. §1052(d), provides, in pertinent part:

> [I]f the Commissioner determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; ... Concurrent registrations may also be issued by the Commissioner when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce." (emphasis added)

See also 37 CFR §2.99(g), and Fleming Companies v. Thriftway Inc., 26 USPQ2d 1551 (S.D.Ohio 1992) (use must be lawful).

If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act, 15 U.S.C. §1051(b), rather than as a use application under Section 1(a) of the Act, 15 U.S.C. §1051(a), the application is void. See 37 CFR §2.99(g); TMEP §1207.04(b); and Marc A. Bergsman, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications, 83 Trademark Rep. 416 (1993). However, an intent-to-use application for an unrestricted registration may be amended to seek concurrent registration when an acceptable amendment to allege use under 37 CFR §2.76, or an acceptable statement of use under 37 CFR §2.88, has been filed in the application. See 37 CFR §2.73(b), and Marc A. Bergsman,

OLD EDITION

TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications, supra.

An application for registration under the provisions of Section 44 of the Act, 15 U.S.C. §1126, may not seek concurrent registration unless the application also includes, as a second basis for registration, an allegation of use in commerce pursuant to Section 1(a) of the Act. See TMEP §1207.04(b).

1102.02(a)(2) Jurisdictional Requirement

An application seeking concurrent registration based on a Board determination, through a concurrent use proceeding, of applicant's right thereto, must allege use in commerce "prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act [of 1946]; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947." See Section 2(d) of the Act, 15 U.S.C. §1052(d). See also Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); In re Beatrice Foods Co., 429 F.2d 466, 166 USPQ 431 (CCPA 1970); Morgan Services Inc. v. Morgan Services Inc., 12 USPQ2d 1841 (TTAB 1989); My Aching Back Inc. v. Klugman, 6 USPQ2d 1892 (TTAB 1988); Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879 (TTAB 1985); and In re Home Federal Savings & Loan Ass'n, 213 USPQ 68 (TTAB 1982). As a practical matter, this means that an application seeking concurrent registration through a concurrent use proceeding normally must assert a date of first use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905).

This requirement is jurisdictional in nature. See Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); In re Beatrice Foods Co., 429 F.2d 466, 166 USPQ 431 (CCPA 1970); Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995); Morgan Services Inc. v. Morgan Services Inc., 12 USPQ2d 1841 (TTAB 1989); My Aching Back Inc. v. Klugman, 6 USPQ2d 1892 (TTAB 1988); and Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879 (TTAB 1985). If it is not met, applicant

OLD EDITION

normally is not entitled to a concurrent registration, and the Trademark Examining Attorney in charge of the application should refuse registration.

However, an application for concurrent registration need not meet the jurisdictional requirement, that is, need not assert use in commerce prior to the earliest application filing date of the application(s), or registration(s) (if any), involved in the proceeding if the owner of such application(s) or registration(s) consents to the grant of a concurrent registration to the applicant. See Section 2(d) of the Act, 15 U.S.C. §1052(d).

In addition, the jurisdictional requirement does not apply to an application seeking concurrent registration based on a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark. See TBMP §1102.02(b), and authorities cited therein.

OLD EDITION

1102.02(a)(3) Other Requirements

A concurrent use application must specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42. See 37 CFR §2.42.

In addition, the applicant must:

(1) State in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration--see 37 CFR §2.42. See also Section 1(a) of the Act, 15 U.S.C. §1051(a).

The statement in the application of the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration serves to give notice, both when the mark is published for opposition (assuming it is approved for publication) and when a concurrent use proceeding is thereafter instituted (if no opposition is filed, or if all oppositions filed are dismissed), of the scope of the registration sought by applicant, and the extent of applicant's acknowledgment of the concurrent rights of others. See 37 CFR §§2.99(d)(1) and 2.99(d)(3); In re Wells Fargo & Co., 231 USPQ 95 (TTAB 1986); and In re El Chico Corp., 159 USPQ 740 (TTAB 1968). See also Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993).

The vast majority of concurrent use applications seek a registration which is restricted geographically. The area for which registration is sought is usually more extensive than the area in which the applicant is actually using its mark. For example, if applicant believes that it is the prior user as against the other party or parties to the proceeding, applicant is likely, as the prior user, to seek registration for all of the United States except for the subsequent user's area of actual use and (possibly) natural expansion. If applicant is not the prior user, but believes that the prior user, through its failure to expand over a long period of time, has abandoned its right as prior user to expand into all of the United States except for the subsequent user's area of actual use and natural expansion, applicant may seek registration for all of the United States except for the prior user's area of actual use. See, for example, Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820 (CCPA 1980), and Pinocchio's Pizza Inc. v. Sandra Inc., 11 USPQ2d 1227 (TTAB 1989). If the concurrent use applicant is a subsequent user, it normally will seek registration not only for its area of actual use but also for its area of natural expansion. If another party to the proceeding owns a registration of its mark, the right to use of which has become incontestable, any registration issued to applicant will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. See Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§1065 and 1115(b)(5); Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and Thriftimart, Inc. v. Scot Lad Foods, Inc., 207 USPQ 330 (TTAB 1980).

In very rare instances, a concurrent use applicant may seek concurrent registration based only on conditions or limitations as to the mode of use of its mark or as to the goods and/or services on or in connection with which the mark is used, i.e., a restriction as to the form in which it may use its mark; a limitation as to the trade channels in which its goods are sold; a requirement that the mark always be used in conjunction with a particular trade dress or house mark, or a specified disclaimer of affiliation; etc. See, for example, Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962); Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995); and In re Wells Fargo & Co., 231 USPQ 95 (TTAB 1986). Usually, "mode of use" cases arise before the Federal district courts, which, for equitable reasons, may permit a continuation of concurrent use even if there is some resulting confusion. Notwithstanding the likelihood of confusion, a party to the court proceeding may obtain concurrent registration on the basis of such a court determination, if its

OLD EDITION

application is otherwise acceptable. See, for example, Section 2(d) of the Act, 15 U.S.C. §1052(d); Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962). In contrast, when concurrent registration is sought by way of a concurrent use proceeding before the Board, the Board cannot allow registration if it finds that there would be likelihood of confusion from the continued concurrent use of the marks. See Section 2(d) of the Act, 15 U.S.C. §1052(d); Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995).

An applicant seeking registration on the basis of "mode of use" conditions or limitations should request concurrent registration only if its application includes a condition or limitation not capable of being incorporated into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another. See Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995).

Where an applicant seeks registration on the basis of "mode of use" conditions or limitations which are incorporated, or are capable of being incorporated, into the applicant's drawing of its mark and/or identification of goods or services, and into the drawing and/or identification of any conflicting application or registration which may be owned by another, a concurrent use proceeding is unnecessary and will not be instituted by the Board. The application should be presented as a regular application, not as a concurrent use application. See Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995). If an applicant which has incorporated mode of use conditions or limitations into its drawing and/or identification is unable to obtain a registration in the absence of corresponding conditions or limitations in a conflicting application or registration, and the owner thereof is not willing to amend its application or registration to include the conditions or limitations, applicant's remedy lies in an opposition or a petition for cancellation, respectively, to restrict the application or registration appropriately. See Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995). For information concerning a claim for partial opposition or partial cancellation, i.e., a request to restrict, see TBMP §311.

(2) State in the application, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses; their

OLD EDITION

areas of use; the goods and/or services on or in connection with which their use is made; the mode of their use; the periods of their use; and the registrations issued to or applications filed by them, if any--See 37 CFR §2.42. See also Section 1(a) of the Act, 15 U.S.C. 1051(a); Gallagher's Restaurants Inc, v. Gallagher's Farms Inc., 3 USPQ2d 1864 (TTAB 1986); In re Wells Fargo & Co., 231 USPQ 106 (TTAB 1986); and In re El Chico Corp., 159 USPQ 740 (TTAB 1968).

It is not necessary that an applicant for concurrent registration list, as exceptions to its claim of exclusive use, every entity known to it to be using the same or similar mark for the same or similar goods or services. Rather, applicant's duty is to list any entity known to it to be a senior user of a clearly conflicting mark, as well as any junior user known to it to have clearly conflicting rights which are clearly established, as, for example, by court decree, by settlement agreement, or by a registration. See Rosso & Mastracco, Inc. v. Giant Food Inc., 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983), and Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc., 215 USPQ 1133 (TTAB 1982). See also In re Sun Refining & Marketing Co., 23 USPQ2d 1072 (TTAB 1991). Cf. SCOA Industries Inc. v. Kennedy & Cohen, Inc., 188 USPQ 411 (TTAB 1975).

(3) When it is determined that applicant's mark is ready for publication, applicant may also be required to furnish a copy of its application, specimens and drawing for each applicant, registrant or user specified in the application as a concurrent user--see 37 CFR §2.99(b). Cf.: 37 CFR §2.99(c).

The additional application copies required by 37 CFR §2.99(b) are used by the Board, when it institutes a concurrent use proceeding, to provide each specified concurrent user with information concerning the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others. See TBMP §1105.

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____. The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first

OLD EDITION

blank space. The second blank is filled in with the area for which applicant seeks registration.

For information concerning the examination, by the Trademark Examining Attorney, of a concurrent use application, see TMEP §§1207.04(d)(i) and 1207.04(d)(ii).

1102.02(a)(4) Application Based on Prior Board Decision

An application seeking concurrent registration on the basis of the Board's final decision in a prior concurrent use proceeding (see TBMP §1102.01) must assert use in commerce of the mark sought to be registered. See TBMP §1102.02(a)(1), and authorities cited therein. The application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42; and must comply with the requirements of 37 CFR §2.42 (described in TBMP §1102.02(a)(3)), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. See 37 CFR §2.42. In addition, the applicant should, of course, submit a copy of the Board decision upon which it relies.

When an application for concurrent registration is based on a final determination by the Board, in a prior concurrent use proceeding, that applicant is entitled to a concurrent registration of its mark, a new concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a new concurrent use proceeding, provided that the following conditions are met:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the prior concurrent use proceeding; and

(2) The Board's prior decision specifies applicant's right to concurrent registration; and

(3) A copy of the Board's prior decision is submitted to the Trademark Examining Attorney; and

OLD EDITION

(4) The concurrent use application complies with the Board's prior decision (that is, seeks registration for the same or a more limited geographic area, or mode of use, and for substantially the same mark and substantially the same goods and/or services as, or more limited goods and/or services than, those listed in the Board's prior specification of applicant's entitlement to concurrent registration), or seeks registration for the same or a more limited area, or mode of use, than that accorded to applicant in the prior decision, and for a mark and goods and/or services less similar to those of the other party or parties than applicant's mark and goods and/or services in the prior proceeding (cf. Missouri Silver Pages Directory Publishing Corp. v. Southwestern Bell Media, Inc., 6 USPQ2d 1028 (TTAB 1988); Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc., 222 USPQ 979 (TTAB 1983), recon. denied, 222 USPQ 727 (TTAB 1983); and Place for Vision, Inc. v. Pearle Vision Center, Inc., 218 USPQ 1022 (TTAB 1983)); and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted in accordance with the Board's prior decision.

If an application seeking concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, meets all of the conditions specified above, a new concurrent use proceeding is unnecessary, because of the legal principles of res judicata and stare decisis. Cf. 37 CFR §2.99(f). If any of the conditions is not satisfied, a new concurrent use proceeding will be prepared and instituted. In the event that the first four conditions are met, but an involved registration, through some happenstance, has not already been restricted in accordance with the Board's prior decision, a new concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the Board's decision. In such cases, the Board sends out, with the notice of institution, an order to the registrant to show cause why its registration should not be restricted in accordance with the Board's prior decision. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the five conditions specified above are satisfied, so that a new concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR §2.99(b) (cf. TBMP §1102.02(a)(3)). When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: REGISTRATION LIMITED TO THE AREA

OLD EDITION

COMPRISING _____ PURSUANT TO CONCURRENT USE PROCEEDING NO. ___. CONCURRENT REGISTRATION WITH _____. The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If the five conditions are not all satisfied, so that a new concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application. See 37 CFR §2.99(b). When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING
_____. The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

The Board does not determine, in a concurrent use proceeding, the right to concurrent registration of a party which is included in the proceeding only as a common law concurrent user, i.e., a party which does not own an involved application or registration. See TBMP §1107, and cases cited therein. A party which was included in a prior concurrent use proceeding only as a common law concurrent user may not thereafter obtain a concurrent registration, on the basis of the Board's decision in the prior proceeding, without going through a new concurrent use proceeding.

OLD EDITION

1102.02(b) Application Based on Court Determination

An application for concurrent registration on the basis of a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark in commerce, must assert use in commerce of the mark sought to be registered. See TBMP §1102.02(a)(1), and authorities cited therein. The application must also specify and contain all the elements required by those of the rules of practice in trademark cases preceding 37 CFR §2.42; and must comply with the requirements of 37 CFR §2.42 (described in TBMP §1102.02(a)(3)), namely, the requirements that applicant state in the application the area, goods and/or services, and (if applicable) mode of use for which applicant seeks registration, and also state, to the extent of applicant's knowledge, the concurrent lawful use of the mark by others, setting forth their names and addresses, their areas of use, the goods and/or services on or in connection with which their use is made, the mode of their use, the periods of their use, and the registrations issued to or applications filed by them, if any. See 37 CFR §2.42. In addition, the applicant must, of course, submit a copy of the court decree upon which it relies.

When an application for concurrent registration is based on a final determination, by a court of competent jurisdiction, that applicant is entitled to concurrently use its mark, a concurrent use proceeding will not be instituted, that is, the application (if found otherwise acceptable, published, and not opposed, or opposed unsuccessfully) will be forwarded to issue without having to go through a concurrent use proceeding, provided that all of the following conditions, specified in 37 CFR §2.99(f), are met:

(1) The applicant is entitled to registration subject only to the concurrent lawful use of a party or parties to the court proceeding; and

(2) The court decree specifies the rights of the parties; and

(3) A true copy of the court decree is submitted to the Trademark Examining Attorney; and

(4) The concurrent use application complies fully and exactly with the court decree (see Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976), and Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962)); and

(5) The excepted use specified in the concurrent use application does not involve a registration, or any involved registration has been restricted by the Commissioner in accordance with the court decree.

OLD EDITION

If any of the five conditions specified above is not satisfied, a concurrent use registration proceeding will be prepared and instituted. See 37 CFR §2.99(f), and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269 (1984). If the first four conditions are met, but an involved registration has not already been restricted by the Commissioner in accordance with the court decree, a concurrent use proceeding will be instituted solely for the purpose of restricting the involved registration in accordance with the court decree. In such cases, the Board sends out, with the notice of institution, an order to the registrant to show cause why its registration should not be restricted in accordance with the court decree. If no good cause is shown, the registration is ordered restricted, applicant is found entitled to the registration sought, and the concurrent use proceeding is dissolved.

If all of the five conditions specified above are satisfied, so that a concurrent use proceeding is not necessary, there is no need for applicant to furnish the extra copies of its application, specimens and drawing referred to by 37 CFR §2.99(b) (cf. TBMP §1102.02(a)(3)). When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: REGISTRATION LIMITED TO THE AREA COMPRISING _____ PURSUANT TO THE DECREE OF _____. CONCURRENT REGISTRATION WITH _____. The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If the five conditions are not all satisfied, so that a concurrent use proceeding is necessary, applicant normally will be required, at least if its mark is determined to be ready for publication, to furnish as many copies of its application, specimens and drawing as may be necessary for the preparation of notices for each applicant, registrant or user specified as a concurrent user in the application. See 37 CFR §2.99(b). When and if the application is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: SUBJECT TO CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____. The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other

OLD EDITION

party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

An application for concurrent registration on the basis of a court determination of applicant's right to concurrently use its mark in commerce does not need to meet the jurisdictional requirement of use in commerce prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. §1052(d) (for information concerning the dates specified in Section 2(d) of the Act, see TBMP §1102.02(a)(2)). Similarly, such an application is not subject to the requirement that the Commissioner determine, prior to issuance of a concurrent registration, that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. These two requirements are conditions precedent to the issuance of a concurrent registration by way of a concurrent use proceeding before the Board, but they are not conditions precedent to the issuance of a concurrent registration on the basis of a court decree. The sentence in Section 2(d) permitting the Commissioner to issue concurrent registrations when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce, is wholly independent of these two provisions. Thus, a concurrent registration may (and should, if otherwise appropriate) be issued on the basis of a court decree even though the application for registration does not claim use in commerce prior to the applicable date specified in Section 2(d), and even though there is likelihood of confusion by reason of the concurrent use of the marks of the parties to the court proceeding. See Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976), and TMEP §1207.04(d)(ii). Cf. Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962).

For information concerning the examination, by the Trademark Examining Attorney, of a concurrent use application, see TMEP §§1207.04(d)(i) and 1207.04(d)(ii).

1103 Parties to Proceeding; Involved Applications, Registrations

The parties to a concurrent use proceeding are the concurrent use applicant(s), and all of those persons listed in the concurrent use application(s) as exceptions

OLD EDITION

to applicant's claim of exclusive use. The persons listed as exceptions may themselves own one or more Federal applications (either for concurrent registration, or for an unrestricted registration) or Federal registrations for a conflicting mark, or may simply be common law users of a conflicting mark. Thus, a concurrent use proceeding may involve the concurrent use applicant(s) and one or more other applicants (either for concurrent registration or for unrestricted registration), and/or one or more registrants, and/or one or more common law concurrent users which do not own an involved application or registration. Often, the only parties to a concurrent use proceeding are the concurrent use applicant, and a common law user which does not own an involved application or registration. See Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984).

If, after the commencement of a concurrent use proceeding, the concurrent use applicant learns of another person with conflicting concurrent rights, the applicant may file a motion to amend its application to list that person as an additional exception to applicant's claim to exclusive use. If the motion is granted, the person listed in the amendment will be added as a party to the proceeding. See Gallagher's Restaurants Inc. v. Gallagher's Farms Inc., 3 USPQ2d 1864 (TTAB 1986). Similarly, if the concurrent use applicant learns that a person listed as an exception to applicant's claim of exclusive use has abandoned its mark, or if the person assigns its rights in its mark to the applicant, the applicant may file a motion to amend its application to delete reference to that person. The motion should include an explanation of the facts which serve as the basis for the motion. If the motion is granted, the amendment will be entered, and the person in question will be dropped as a party to the proceeding.

The applications and/or registrations involved in a concurrent use proceeding include the concurrent use application(s); every conflicting unrestricted application which is identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent applicant's claim of exclusive use, and which has a filing date prior to the filing date of the concurrent use application(s); every conflicting registration identified in the concurrent use application(s) as being owned by a person listed as an exception to the concurrent applicant's claim of exclusive use; and every registration claimed by the concurrent use applicant(s) in the concurrent use application(s), unless there is no conflict between the mark(s) in such registration(s) and the mark(s) of the other party or parties to the proceeding (see Morgan Services Inc. v. Morgan Linen Services Inc., 12 USPQ2d 1841 (TTAB 1989)). Further, when the Board institutes the concurrent use proceeding, inquiry will be made as to

OLD EDITION

whether any party owns any other application or registration which is for the same or similar mark, and same or similar goods and/or services, and thus should be added to the proceeding. A conflicting application or registration identified in response to this inquiry normally will be added to the proceeding.

However, if a party to the proceeding owns a conflicting application which seeks an unrestricted registration, and which was not filed until after the concurrent use application(s), action on the subsequent unrestricted application will be suspended by the Trademark Examining Attorney (once the application is otherwise in condition for approval for publication) pending disposition of the concurrent use application(s). See Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993), and Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990). In the event that the concurrent use application(s) matures into concurrent registration(s), the concurrent registration(s) will be cited, under Section 2(d) of the Act, as a reference(s) against the subsequent unrestricted application. See Georgia-Southern Oil Inc. v. Richardson, supra. Alternatively, if the owner of the subsequent unrestricted application amends it to seek concurrent registration, the application will be published for opposition and, if no opposition is filed, or if all oppositions filed are dismissed, the application will be added to the concurrent use proceeding, if the amendment is filed early enough so that addition to the concurrent use proceeding is feasible, or will be the subject of a new concurrent use proceeding, if the amendment is not filed early enough. See Pro-Cuts v. Schilz-Price Enterprises Inc., supra, and Georgia-Southern Oil Inc. v. Richardson, supra.

OLD EDITION

1104 Applications and Registrations Not Subject to Proceeding

37 CFR §2.73(b) An application under section 1(b) of the Act may not be amended so as to be treated as an application for a concurrent registration until an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed in the application, after which time such an amendment may be made, provided the application as amended satisfies the requirements of §2.42. The examiner will determine whether the application, as amended, is acceptable.

37 CFR §2.99(g) Registrations and applications to register on the Supplemental Register and registrations under the Act of 1920 are not subject to concurrent use registration proceedings. Applications to register under section 1(b) of the

Act of 1946 are subject to concurrent use registration proceedings only after an acceptable amendment to allege use under §2.76 or statement of use under §2.88 has been filed.

Applications for registration on the Supplemental Register, registrations on the Supplemental Register, and registrations issued under the Act of 1920 are not subject to concurrent use proceedings. See Sections 26 and 46(b) of the Act of 1946; 37 CFR §2.99(g); and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269 (1984).

Applications to register under Section 1(b) of the Act, 15 U.S.C. §1051(b), i.e., intent-to-use applications, are subject to concurrent use proceedings only after an acceptable amendment to allege use under 37 CFR §2.76, or an acceptable statement of use under 37 CFR §2.88, has been filed. See 37 CFR §2.99(g). Cf. 37 CFR §2.73(b), and TBMP §1102.02(a)(1). If a concurrent use application is filed as an intent-to-use application under Section 1(b) of the Act, 15 U.S.C. §1051(b), rather than as a use application under Section 1(a) of the Act, 15 U.S.C. §1051(a), the application is void. See 37 CFR §2.99(g); TMEP §1207.04(b); and Marc A. Bergsman, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications, 83 Trademark Rep. 416 (1993).

An "incontestable registration," that is, a registration of a mark the right to use of which has become incontestable pursuant to Section 15 of the Act, 15 U.S.C. §1065, is subject to a concurrent use proceeding. However, any registration issued to the concurrent use applicant as against the owner of an incontestable registration will be limited (even if applicant is the prior user) to applicant's area of actual use prior to actual or constructive notice of registrant's rights, unless the parties stipulate otherwise. See Sections 15 and 33(b)(5) of the Act, 15 U.S.C. §§1065 and 1115(b)(5); Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976); and Thriftimart, Inc. v. Scot Lad Foods, Inc., 207 USPQ 330 (TTAB 1980).

OLD EDITION

1105 Commencement of Proceeding

When an application seeking concurrent registration by way of a concurrent use proceeding before the Board is approved for publication, it is marked (by the Trademark Examining Attorney) with the following statement: SUBJECT TO

CONCURRENT USE PROCEEDING WITH _____. APPLICANT CLAIMS EXCLUSIVE RIGHT TO USE THE MARK IN THE AREA COMPRISING _____. The first blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the first blank space. The second blank is filled in with the area for which applicant seeks registration.

If an application approved for publication seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto, and meets the conditions described in TBMP §1102.02(a)(4), so that a new concurrent use proceeding is unnecessary, the application is marked with the following statement: REGISTRATION LIMITED TO THE AREA COMPRISING _____ PURSUANT TO CONCURRENT USE PROCEEDING NO. ___. CONCURRENT REGISTRATION WITH _____. The area specified in the Board's decision as the area for which applicant is entitled to registration is inserted in the first blank, together with any other conditions or limitations imposed by the Board. The second blank is filled in with the number of the prior concurrent use proceeding. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the prior concurrent use proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

If an application approved for publication seeks concurrent registration on the basis of a court determination of concurrent rights, and meets the conditions of 37 CFR §2.99(f) (see TBMP §1102.02(b)), so that a concurrent use proceeding is unnecessary, the application is marked with the following statement: REGISTRATION LIMITED TO THE AREA COMPRISING _____ PURSUANT TO THE DECREE OF _____. CONCURRENT REGISTRATION WITH _____. The area granted to applicant by the court is inserted in the first blank, together with any other conditions or limitations imposed by the court. The second blank is filled in with the name of the court, proceeding number, and date of decree. The third blank is filled in with the number(s) of the involved application(s) or registration(s) owned by the other party or parties to the court proceeding. If any such party does not own an application or registration of its involved mark, then the name and address of the party is inserted in the third blank space.

OLD EDITION

The application is then published, with the indicated statement, in the Official Gazette for opposition. If the application seeks concurrent registration on the basis of a court decree, meets the requirements of 37 CFR §2.99(f), and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a concurrent use proceeding. See 37 CFR §2.99(f), and TBMP §1102.02(b). Similarly, if the application seeks concurrent registration on the basis of the Board's determination, in a prior concurrent use proceeding, of applicant's entitlement thereto; meets the conditions described in TBMP §1102.02(a)(4); and is not opposed, or all oppositions filed are dismissed, the application goes to issue without a new concurrent use proceeding. See TBMP §1102.02(a)(4). Cf. 37 CFR §2.99(f), and TBMP §1102.02(b).

If the application seeks concurrent registration by way of a concurrent use proceeding before the Board, and is not opposed, or all oppositions filed are dismissed, a concurrent use proceeding is instituted. See 37 CFR §2.99(c). Similarly, if the application seeks concurrent registration on the basis of a court decree but does not meet the requirements of 37 CFR §2.99(f), or seeks concurrent registration on the basis of the Board's decision in a prior concurrent use proceeding but does not meet the conditions described in TBMP §1102.02(a)(4), and the application is not opposed, or all oppositions filed are dismissed, a concurrent use proceeding is instituted. See 37 CFR §§2.99(c) and 2.99(f), and TBMP §§1102.02(a)(4) and 1102.02(b).

After the opposition period has expired, and no opposition is filed, or all oppositions filed are dismissed, the file of a concurrent use application which must go through a concurrent use proceeding before the Board is forwarded to the Board for institution of the proceeding. There is no fee for the institution of a concurrent use proceeding.

The Board obtains the files of all of the other applications and registrations, if any, to be included in the proceeding. If any such application has not yet been published in the Official Gazette, or has been published but has not yet cleared the opposition period, the proceeding will be instituted, with the owner of that application being included as a common law user, rather than as an applicant. The Board may, in its discretion, suspend proceedings in the concurrent use proceeding until the unpublished application either becomes abandoned, or is published in the Official Gazette and survives the opposition period; and then, if the application is published and survives the opposition period, add it to the

OLD EDITION

proceeding, and change the proceeding position of its owner from that of common law user to applicant (cf. TBMP §§1103 and 1107).

When the Board has obtained the files of all other applications and registrations, if any, to be included in the proceeding, the Board prepares a notice for each party advising the party that the concurrent use proceeding is thereby instituted; supplying information concerning the filing of an "answer" to the notice and specifying a due date therefor (for information concerning the "answer" in a concurrent use proceeding, see TBMP §1106); and allowing the party until a specified time to advise the Board of any relevant, but as yet uninvolved, application(s) and/or registration(s), which should be included in the proceeding. The notice to each party listed as an exception to a concurrent use applicant's claim of exclusive use also specifies the name and address of the concurrent use applicant and the concurrent use applicant's attorney or other authorized representative, if any, together with the concurrent use applicant's mark, goods and/or services, application filing date and serial number, and claimed territory (see 37 CFR §2.99(c)); the name and address of any other involved applicant or registrant; the name and address of any other involved applicant's attorney or other authorized representative, if any; the mark, goods and/or services, application filing date, application serial number, and claimed territory of any other involved applicant, as reflected in its involved application (if the application is unrestricted, the claimed territory will be described in the notice as "The entire United States"); the mark, goods and/or services, registration filing and issue date, registration number, and claimed territory of any other involved registrant, as reflected in its involved registration; and the name and address of any other involved party which is simply a common law concurrent user, i.e., does not own an involved application or registration of its mark.

The notices are sent to each involved applicant, in care of the applicant's attorney or other authorized representative, if any; to any involved user; and to any involved registrant. A copy of each concurrent use applicant's involved application(s) is forwarded with the notice to each party specified in the concurrent use application as an exception to applicant's claim of exclusive use. See 37 CFR §2.99(d)(1).

The concurrent use proceeding commences when the Board mails the notices to the parties. Cf. 37 CFR §2.93.

It is the responsibility of the concurrent use applicant, which has the burden of proving its entitlement to concurrent registration, to provide information

OLD EDITION

concerning the current address of each specified excepted user, as well as information concerning each user's use of its particular mark in its particular area or mode of use. See 37 CFR §§2.42 and 2.99(e). See also TBMP §§1102.02(a)(3) and 1107. The address used by the Board in mailing the notice to a specified excepted user is the address provided by the concurrent use applicant in its application, unless the user itself owns an involved application or registration which includes an address more current than the one provided by the concurrent use applicant. If a notice or other communication sent by the Board to a specified excepted user is returned as undeliverable, the concurrent use applicant will be required to investigate further and furnish the correct address. Unless and until the concurrent use applicant does so, the proceeding cannot go forward. Alternatively, if, upon further investigation, the concurrent use applicant learns that a specified excepted user has abandoned its use of its mark, the concurrent use applicant may file a motion to amend its application to delete reference to that user. See TBMP §1103.

OLD EDITION

1106 Answer

There is no complaint in a concurrent use proceeding. Cf. TBMP §1003. Instead, there is a notice which informs the parties to the proceeding of the institution thereof, supplies information concerning the filing of an "answer" to the notice, and specifies a due date therefor. In addition, the notice, (including the copy of each involved concurrent use application, which is mailed with the notice to every person specified in the application) takes the place of a complaint to the extent that it informs every specified person of the scope of the concurrent registration sought by each concurrent use applicant, and the extent of each concurrent use applicant's acknowledgment of the concurrent rights of others--i.e., the essence of what each concurrent use applicant intends to prove at trial. See TBMP §§1102.02(a)(3) and 1105.

The "answer" in a concurrent use proceeding is a response to the notice. In the "answer," the answering party sets forth its position with respect to the registration(s) sought by the concurrent use applicant(s). See, for example, Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993); Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992); Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990); Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984); Ole' Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912 (TTAB

1984); T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269 (1984); and Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982).

An answer to the notice is not required of an applicant or registrant whose application or registration is involved in the proceeding (for information concerning which applications and registrations are involved in a concurrent use proceeding, see TBMP §1103), but such a party may file an answer if it so desires. Any other party specified as a concurrent user in an involved concurrent use application must file an answer to avoid default. See 37 CFR §2.99 (d)(2). See also Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984), and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269 (1984). Any answer filed must be filed within 40 days after the mailing date of the notice, or within an extension of time for the purpose. See 37 CFR §2.99(d)(2). See also TBMP §§501 and 509. Cf. TBMP §316.

If a party which is required, under 37 CFR §2.99(d)(2), to file an answer fails to do so, judgment will be entered against that party precluding the party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s). However, each concurrent use applicant still will have the burden of proving its entitlement to the registration(s) sought as against every party specified in its application(s), including any party against which default judgment for failure to answer has been entered. That is, the concurrent use applicant still will have to prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary (see TBMP §1102.02(a)(2)), that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. §1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. See 37 CFR §2.99(d)(3). See also Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993); Precision Tune Inc. v. Precision Auto-Tune Inc., 4 USPQ2d 1095 (TTAB 1987); Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984); and T. Jeffrey Quinn, TIPS FROM THE TTAB: The Rules Are Changing, 74 Trademark Rep. 269 (1984). Moreover, if, after the entry of default judgment against a party for failure to answer, the concurrent use applicant seeks to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting

OLD EDITION

party, the defaulting party will be allowed an opportunity to object thereto. If the amendment is permitted, the defaulting party will be allowed to contest the registration sought by the applicant, to the extent that the applicant claims a greater right, as against the defaulting party, than that previously claimed.

If a concurrent use proceeding involves only a concurrent use applicant and one or more specified common law concurrent users which do not have an involved application or registration, and default judgment for failure to answer is entered against every specified user, or applicant has entered into a persuasive settlement agreement with every party against which default judgment has not been entered, applicant may prove its entitlement to registration as against the defaulting users by an "ex parte" type of showing. That is, applicant may prove its entitlement to registration by less formal procedures (such as by the submission of affidavit evidence) than those (such as depositions upon oral examination) normally required for the introduction of evidence in an inter partes proceeding. See Precision Tune Inc. v. Precision Auto-Tune Inc., 4 USPQ2d 1095 (TTAB 1987). See also Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992). In such a case, the Board, instead of setting formal trial dates, simply allows the concurrent use applicant time (usually 60 days) in which to submit proof of its entitlement to registration. For an example of proof of entitlement to concurrent registration in such a situation, see Precision Tune Inc. v. Precision Auto-Tune Inc., supra.

When default judgment for failure to file an answer is entered against a party to a concurrent use proceeding, the Board does not continue to send to that party copies of all of the communications issued by the Board in the proceeding, nor do the other parties to the proceeding need to continue serving on the defaulting party copies of all papers which they file in the proceeding. However, a copy of the Board's final decision in the case is mailed to the defaulting party. Moreover, any request by the concurrent use applicant to amend its application to narrow the extent of the concurrent rights conceded therein to the defaulting party must be served upon that party. If the amendment is permitted, the Board's action on the request, and copies of all further communications issued by the Board in the proceeding, will be sent to the defaulting party by the Board. Similarly, after approval of such an amendment, copies of all further papers filed by the other parties to the proceeding should be served on the defaulting party.

1107 Issue; Burden of Proof

37 CFR §2.99(e) The applicant for a concurrent use registration has the burden of proving entitlement thereto. If there are two or more applications for concurrent use registration involved in a proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date and that applicant will be the junior party. A person specified as an excepted user in a concurrent use application but who has not filed an application shall be considered a party senior to every party that has an application involved in the proceeding.

37 CFR §2.116(b) ... A party that is a junior party in an interference proceeding or in a concurrent use registration proceeding shall be in the position of plaintiff against every party that is senior, and the party that is a senior party in an interference proceeding or in a concurrent use registration proceeding shall be a defendant against every party that is junior.

The issue to be determined in a concurrent use proceeding is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof. The Board does not determine the right to registration of a party which is included in the proceeding only as a common law concurrent user, i.e., a party which does not own an involved application or registration (for information concerning the parties to a concurrent use proceeding, and the applications and registrations involved therein, see TBMP §1103). See Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993), and Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990). See also Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992).

Each applicant for concurrent registration has the burden of proving its entitlement thereto as against every other party specified in its application as an exception to its claim of exclusive right to use. That is, a concurrent use applicant must prove that there will be no likelihood of confusion by reason of the concurrent use by the parties of their respective marks, and, where necessary (see TBMP §1102.02(a)(2)), that the parties have become entitled to use their marks as a result of their concurrent lawful use in commerce prior to the

OLD EDITION

applicable date specified in Section 2(d) of the Act, 15 U.S.C. §1052(d) [usually, this means use in commerce prior to the earliest application filing date of the application(s), or 1946 Act registration(s) (if any), involved in the proceeding (or prior to July 5, 1947, in the case of an involved registration under the Acts of 1881 or 1905)]. See, for example, Section 2(d) of the Act, 15 U.S.C. §1052(d); 37 CFR §2.99(e); Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987); Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992); Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990); Faces, Inc. v. Face's, Inc., 222 USPQ 918 (TTAB 1983); Ole' Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912 (TTAB 1984); Inland Oil & Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977); Handy Spot Inc. v. J. D. Williams Co., 181 USPQ 351 (TTAB 1974); Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982); and Rany L. Simms, TIPS FROM THE TTAB: The Concurrent User as Opposer, 67 Trademark Rep. 654 (1977).

Any other party may attempt to prove any ground for refusal of registration which might be asserted with respect to an application for an unrestricted registration, as well as other matters, such as, that the concurrent use applicant is entitled to a concurrent registration covering only some of the area specified in its application; that the concurrent use applicant is not entitled to registration at all because it is a bad faith junior user; that applicant does not meet the jurisdictional requirement of use of its involved mark prior to the applicable date specified in Section 2(d) of the Act, 15 U.S.C. §1052(d) (see TBMP §1102.02(a)(2)); that applicant's use of its mark is unlawful; etc. See Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990); Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992); Women's World Shops Inc. v. Lane Bryant Inc., 5 USPQ2d 1985 (TTAB 1988); Faces, Inc. v. Face's, Inc., 222 USPQ 918 (TTAB 1983); Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc., 216 USPQ 897 (TTAB 1982); Inland Oil & Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977); Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982); and Rany L. Simms, TIPS FROM THE TTAB: The Concurrent User as Opposer, 67 Trademark Rep. 654 (1977).

In a concurrent use proceeding, a junior party stands in the position of plaintiff, and a senior party stands in the position of defendant. See 37 CFR §2.116(b). When there are two or more concurrent use applications involved in a concurrent use proceeding, the party whose application has the latest filing date is the junior party. A party whose application has a filing date between the filing dates of the

OLD EDITION

earliest involved application and the latest involved application is a junior party to every party whose involved application has an earlier filing date. If any applications have the same filing date, the application with the latest date of execution will be deemed to have the latest filing date, and that applicant will be the junior party. A party which is specified in an involved concurrent use application as an excepted user, but which does not have an involved application, shall be considered a party senior to every party that has an application involved in the proceeding. See 37 CFR §2.99(e). See also Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982).

1108 Conduct of Proceeding

Once commenced (see TBMP §1105), a concurrent use proceeding is conducted in the same general manner as an opposition or cancellation proceeding, except that, inter alia, there is no complaint (see TBMP §1106), and thus no motions relating to the complaint; the "answer" is not an answer in the usual sense of the word, and is not always required (see TBMP §1106); if an answer, when required, is not filed, default judgment is entered against the nonanswering party precluding that party from claiming any right more extensive than that acknowledged in the involved concurrent use application(s), but each concurrent use applicant will still have the burden of proving its entitlement to the registration(s) sought (see TBMP §1106); the issue is the entitlement of the concurrent use applicant(s) to the registration(s) sought, and the extent, if any, to which every other involved application or registration should be restricted as a result thereof (see TBMP §1107); the order in which the parties offer evidence depends upon whether or not they own an involved application or registration, and, if two or more parties own an involved concurrent use application, the filing dates of such applications (see TBMP §1107); and in certain cases, where default judgment is entered for failure to answer, a concurrent use applicant may be permitted to prove its entitlement to registration by less formal procedures than those normally required for the introduction of evidence in an inter partes proceeding (see TBMP §1106).

In addition, the trial and briefing schedule in a concurrent use proceeding involving three or more parties differs, because of the multiplicity of parties, from that in an opposition or cancellation proceeding. After the time for answer has passed, the Board sends out an order setting trial and briefing dates in the

OLD EDITION

case (except in those default judgment situations where the concurrent use applicant is permitted to prove its entitlement to registration by less formal procedures than those normally required for the introduction of evidence in an inter partes proceeding--see TBMP §1106). Specifically, the Board sets a closing date for discovery (which opens when the notices of institution are served by the Board upon the parties), and schedules testimony periods so that each party in the position of plaintiff will have a period for presenting its case in chief against each party in the position of defendant, each party in the position of defendant will have a period for presenting its case and meeting the case of each plaintiff, and each party in the position of plaintiff will have a period for presenting evidence in rebuttal. See 37 CFR §2.121(b)(2). See also TBMP §701. The testimony periods are separated from the discovery period and from each other by 30-day intervals. Similarly, the Board schedules briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief and meeting the main brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. See TBMP §801.02(e).

Set forth below is a sample trial and briefing schedule for a concurrent use proceeding involving parties A, B, C, D, and E, where A, B, C, and D are all concurrent use applicants, A's application has the latest filing date, B's application has the next-latest filing date, C's application has the next-latest filing date, D's application has the earliest filing date, and E is a specified concurrent user which does not own an involved application or registration (the trial and briefing schedule would look the same if E were a concurrent use applicant whose application had the earliest filing date, or if E owned an involved registration):

THE PERIOD FOR DISCOVERY TO CLOSE : July 2, 1984

Testimony period for A to close (opening 30 days prior thereto) : August 31, 1984

Testimony period for B to close (opening 30 days prior thereto) : October 30, 1984

Testimony period for C to close (opening 30 days prior thereto) : December 31, 1984

Testimony period for D to close : March 1, 1985

OLD EDITION

(opening 30 days prior thereto)

Testimony period for E to close : April 30, 1985
(opening 30 days prior thereto)

Rebuttal testimony period for
A to close : June 14, 1985
(opening 15 days prior thereto)

Rebuttal testimony period for
B to close : July 29, 1985
(opening 15 days prior thereto)

Rebuttal testimony period for
C to close : September 12, 1985
(opening 15 days prior thereto)

Rebuttal testimony period for
D to close : October 28, 1985
(opening 15 days prior thereto)

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for A shall be due : December 27, 1985

Brief for B shall be due : January 26, 1986

Brief for C shall be due : February 25, 1986

Brief for D shall be due : March 27, 1986

Brief for E shall be due : April 26, 1986

Reply briefs, if any, shall be due as follows:

Reply brief for A shall be due : May 11, 1986

Reply brief for B shall be due : May 26, 1986

Reply brief for C shall be due : June 10, 1986

OLD EDITION

Reply brief for D shall be due : June 25, 1986

Set forth below is another sample trial and briefing schedule for a concurrent use proceeding involving parties X, Y, and Z, where X is a concurrent use applicant, Y owns a registration which is involved in the proceeding, and Z is a specified concurrent user which does not own an involved application or registration:

THE PERIOD FOR DISCOVERY TO CLOSE : May 21, 1991

Testimony period for X to close (opening 30 days prior thereto) : July 22, 1991

Testimony period for Y to close (opening 30 days prior thereto : September 20, 1991

Testimony period for Z to close (opening 30 days prior thereto) : November 19, 1991

Rebuttal testimony period for X to close (opening 15 days prior thereto) : January 3, 1992

Briefs on final hearing (37 CFR 2.128) shall become due as follows:

Brief for X shall be due : March 3, 1992

Brief for Y shall be due : April 2, 1992

Brief for Z shall be due : May 4, 1992

Reply briefs, if any, shall be due as follows:

Reply brief for X shall be due : May 19, 1992

The trial and briefing schedule set forth immediately above would look the same if Y and Z were both specified concurrent users which did not own an involved application or registration. If X, Y, and Z were all concurrent use applicants, there would be a separate testimony period for each party, and X and Y would each have a separate rebuttal testimony period; each party would also be allowed

OLD EDITION

time to file a brief on the case, but only X and Y would be allowed time in which to file a reply brief.

With the exceptions noted above, the practices and procedures for taking discovery, filing motions, introducing evidence, briefing the case, presenting oral arguments at final hearing, and seeking review of a decision of the Board, are essentially the same in a concurrent use proceeding as in an opposition or cancellation proceeding.

1109 Settlement Providing for Concurrent Registration

Most concurrent use proceedings before the Board are not litigated to final decision on the merits, but rather are settled on the basis of an agreement between the parties which provides for the issuance to the concurrent use applicant(s) of the concurrent registration(s) sought. Such an agreement is usually filed by the concurrent use applicant(s) together with a request for issuance of the concurrent registration(s) sought.

The Board will not enter judgment in behalf of the concurrent use applicant(s), and find such applicant(s) entitled to concurrent registration, on the basis of a settlement agreement, unless the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. See Section 2(d) of the Act, 15 U.S.C. §1052(d); Meijer, Inc. v. Purple Cow Pancake House, 226 USPQ 280 (TTAB 1985); Handy Spot Inc. v. J. D. Williams Co., 181 USPQ 351 (TTAB 1974); and Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982). For information concerning settlement agreements offered in a concurrent use proceeding as a basis for the issuance of the concurrent registration(s) sought, see Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988); In re Beatrice Foods Co., 429 F.2d 466, 166 USPQ 431 (CCPA 1970); Meijer, Inc. v. Purple Cow Pancake House, supra; Handy Spot Inc. v. J. D. Williams Co., supra; and Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, supra. See also Houlihan v. Parliament Import Co., 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990).

OLD EDITION

If a settlement agreement does not include every party to the proceeding, each concurrent use applicant still will have the burden of proving its entitlement to registration as against every party to the proceeding which is not also a party to the agreement, even if a default judgment for failure to answer has been entered against a nonincluded party. See Precision Tune Inc. v. Precision Auto-Tune Inc., 4 USPQ2d 1095 (TTAB 1987).

1110 Effect of Abandonment of Involved Application

For information concerning the effect of the abandonment of an application which is a subject of a concurrent use proceeding, see TBMP §603.

1111 Effect of Adverse Decision in Opposition or Cancellation

A party which receives an adverse decision, in an opposition, cancellation, or interference proceeding, on the issue of priority of use is not precluded thereby from seeking concurrent registration, unless its first use in commerce was subsequent to the earliest application filing date of any conflicting application or registration owned by another party to the opposition, cancellation, or interference proceeding; that other party does not consent to the grant of a concurrent registration to the applicant; and concurrent registration is sought by way of a concurrent use proceeding before the Board. See Section 2(d) of the Act, 15 U.S.C. §1052(d); Chichi's, Inc. v. Chi-Chi's, Inc., 222 USPQ 831 (Comm'r 1984); U.S. Soil, Inc. v. Colovic, 214 USPQ 471 (TTAB 1982); Home Federal Savings & Loan Ass'n v. Home Federal Savings & Loan Ass'n of Chicago, 205 USPQ 467 (TTAB 1979); and Cook's Pest Control, Inc. v. Sanitas Pest Control Corp., 197 USPQ 265 (TTAB 1977). For information concerning the jurisdictional requirement of Section 2(d) of the Act, see TBMP §1102.02(a)(2).

1112 "Conversion" of Opposition to Concurrent Use Proceeding

In certain situations, an opposition proceeding may be "converted" into a concurrent use proceeding. In these cases, the opposition proceeding is not

OLD EDITION

actually transformed into a concurrent use proceeding. Rather, the opposition is terminated, usually by dismissal without prejudice, in favor of the concurrent use proceeding. The concurrent use proceeding, in turn, is instituted immediately. In fact, notice of the institution of the concurrent use proceeding is normally included in the decision terminating the opposition proceeding. See Janet E. Rice, TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings, 76 Trademark Rep. 252 (1986). Cf. 37 CFR 2.99(c) (in effect providing, inter alia, that when a concurrent use application has been published in the Official Gazette for opposition, a concurrent use proceeding will not be instituted unless no opposition is filed, or unless all oppositions that are filed are dismissed).

An opposition may be terminated in favor of a concurrent use proceeding in the situations described below:

(1) When an opposition to a concurrent use application is filed by a party specified in the application as an exception to applicant's claim of exclusive use, the opposition may be dismissed without prejudice in favor of a concurrent use proceeding. See Inland Oil & Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977). This action may be taken by the Board upon its own initiative, or upon motion.

(2) When an opposition to a concurrent use application is filed by a party which is not specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if opposer files an application for concurrent registration, naming applicant as an exception to its claim of exclusive use. However, the opposition will not be dismissed, and the concurrent use proceeding instituted, unless opposer's concurrent use application is published in the Official Gazette for opposition, and no opposition is filed, or all oppositions filed are dismissed.

(3) When an opposition to a concurrent use application is filed by a party which is not specified in the application as an exception to applicant's claim of exclusive use, the Board may grant a motion to dismiss the opposition without prejudice in favor of a concurrent use proceeding if applicant amends its application to specify the opposer as an additional exception to its claim of exclusive use.

(4) When an opposition is filed against an application for an unrestricted registration, the applicant may file a motion to amend its application to one for concurrent registration, reciting opposer as an exception to applicant's claim of exclusive use, together with a motion to terminate the opposition in favor of a concurrent use proceeding. If opposer consents to the amendment, the

OLD EDITION

opposition will be dismissed without prejudice, and the concurrent use proceeding will be instituted. If opposer does not consent to the amendment, but applicant consents to entry of judgment against itself with respect to its right to an unrestricted registration, judgment will be entered against applicant, in the opposition, with respect to applicant's right to an unrestricted registration; the amendment will be approved; and a concurrent use proceeding involving the amended application will be instituted, all in one Board action. See Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993); Faces, Inc. v. Face's, Inc., 222 USPQ 918 (TTAB 1983); Marc A. Bergsman, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications, 83 Trademark Rep. 416 (1993); and Janet E. Rice, TIPS FROM THE TTAB: Newest TTAB Rule Changes; More Tips on Concurrent Use Proceedings, 76 Trademark Rep. 252 (1986). See also Janet E. Rice, TIPS FROM THE TTAB: Concurrent Use Applications and Proceedings, 72 Trademark Rep. 403 (1982), and Rany L. Simms, TIPS FROM THE TTAB: The Concurrent User as Opposer, 67 Trademark Rep. 654 (1977) (NOTE: these two articles were written at earlier stages in the development of the Board's practice concerning termination of an opposition in favor of a concurrent use proceeding).

For information concerning the possible "conversion" of an opposition to a concurrent use proceeding when the opposed application is an intent-to-use application in which an amendment to allege use has not been filed, see Marc A. Bergsman, TIPS FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE TTAB: Concurrent Use and Intent-to-Use Applications, 83 Trademark Rep. 416 (1993).

In appropriate situtations, a cancellation proceeding may also be terminated in favor of a concurrent use proceeding, if one party has a concurrent use application reciting the adverse party in the cancellation proceeding as an exception to its claim of exclusive use; the application is published in the Official Gazette for opposition; and no opposition is filed, or all oppositions filed are dismissed.

OLD EDITION

1113 Alteration of Restrictions on Concurrent Registration

A concurrent registration may be issued only pursuant to the decision of the Board in a concurrent use proceeding, or on the basis of a final determination, by

a court of competent jurisdiction, that more than one person is entitled to use the same or similar marks in commerce. See TBMP §1101.03, and authorities cited therein. A registration cannot be restricted territorially by amendment under Section 7(e) of the Act, 15 U.S.C. §1057(e), and 37 CFR §2.173(a). See Morgan Services Inc. v. Morgan Linen Services Inc., 12 USPQ2d 1841 (TTAB 1989); In re Forbo, 4 USPQ2d 1415 (Comm'r 1984); and In re Alfred Dunhill Ltd., 4 USPQ2d 1383 (Comm'r 1987).

Further, a concurrent registrant which wishes to alter the restriction to its registration ordinarily may do so, if at all, only through an appropriate decision in a new concurrent use proceeding before the Board, or a new civil action before a court of competent jurisdiction; a Section 7(e) amendment cannot be used to alter a concurrent use restriction. See Morgan Services Inc. v. Morgan Linen Services Inc., 12 USPQ2d 1841 (TTAB 1989); In re Forbo, 4 USPQ2d 1415 (Comm'r 1984); and In re Alfred Dunhill Ltd., 4 USPQ2d 1383 (Comm'r 1987).

However, removal of such a restriction by amendment under Section 7(e) may be permitted where an entity which was the only exception to registrant's right to exclusive use of its registered mark assigns its rights in its mark to registrant, so that all rights in the mark are merged in registrant. See In re Alfred Dunhill Ltd., 4 USPQ2d 1383 (Comm'r 1987).

In addition, if every concurrent user specified in a concurrent registration abandons its use of its involved mark, and owns no subsisting registration thereof, the owner of the remaining concurrent registration may file a new application for an unrestricted registration of the mark.

OLD EDITION

CHAPTER 1200 EX PARTE APPEALS

1201 Propriety of Appeal

1202 Filing an Appeal

1203 Appeal Briefs

1204 Effect of Request for Reconsideration of Final Action

1205 Amendment of Application During Appeal

1206 Amendment to Allege Use; Statement of Use

1207 Submission of Evidence During Appeal

1208 Treatment of Evidence

1209 Remand for New Refusal or New Requirement

1210 Approval for Publication During Appeal

1211 Abandonment During Appeal

1212 Cancellation or Assignment of Cited Registration

1213 Suspension of Appeal

1214 Consolidation

1215 Alternative Positions

1216 Oral Hearing

1217 Final Decision

1218 Reopening (Amendment, etc., After Final Decision)

1219 Review of Final Decision

OLD EDITION

1201 Propriety of Appeal

1201.01 Readiness of Case for Appeal

15 U.S.C. §1070. An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

37 CFR §2.63(b) After reexamination the applicant may respond by filing a timely petition to the Commissioner for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Commissioner (see §2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Commissioner. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Commissioner may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

37 CFR §2.64(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Commissioner if permitted by §2.63(b).

37 CFR §2.141 Ex parte appeals from the Examiner of Trademarks. Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

37 CFR §2.146(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner.

OLD EDITION

On the first or any subsequent reexamination or reconsideration of an application for registration of a trademark, the Examining Attorney may state that the refusal of the registration or the insistence upon a requirement is final. See Section 12(b) of the Act; 37 CFR §2.64(a); and TMEP §1105.03. When the Examining Attorney states that his or her action is final, the applicant's response is limited to an appeal to the Board, or to a compliance with any requirement, or to a petition to the Commissioner if a petition is permitted by 37 CFR §2.63(b). See 37 CFR §2.64(a), and TMEP §1105.04(g). See also Section 20 of the Act, 15 U.S.C. §1070, and TMEP §1501. An applicant may consider a second refusal on the same ground(s), or a repeated requirement, as final for purposes of appeal. See 37 CFR §2.141; TMEP §1502; In re Hechinger Investment Co. of Delaware Inc., 24 USPQ2d 1053 (TTAB 1991); and In re Citibank, N.A., 225 USPQ 612 (TTAB 1985).

Thus, an application is ripe for appeal when the Examining Attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or from a repeated requirement. See Section 20 of the Act; 37 CFR §§2.64(a) and 2.141; TMEP §1501; In re Hechinger Investment Co. of Delaware Inc., 24 USPQ2d 1053 (TTAB 1991); and In re Citibank, N.A., 225 USPQ 612 (TTAB 1985). But see TBMP §§1201.02 and 1201.03.

OLD EDITION

1201.02 Premature Final

15 U.S.C. 1062(b) If the applicant is found not entitled to registration, the examiner shall advise the applicant thereof and of the reason therefor. The applicant shall have a period of six months in which to reply or amend his application, which shall then be reexamined. This procedure may be repeated until (1) the examiner finally refuses registration of the mark or (2) the applicant fails for a period of six months to reply or amend or appeal, whereupon the application shall be deemed to have been abandoned, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unavoidable, whereupon such time may be extended.

A refusal of registration or an insistence upon a requirement may be made final by the Trademark Examining Attorney only on the first or any subsequent reexamination or reconsideration of an application; a refusal or requirement may

not be made final in a first action. See Section 12(b) of the Act, 15 U.S.C. §1062(b); 37 CFR §2.64(a); and TMEP §1105.04(a).

An action should not be stated to be final until the applicant has had at least one opportunity to reply to each ground of refusal, and each requirement, asserted by the Examining Attorney. See TMEP §1105.04(a). See also In re Abolio y Rubio S.A.C.I. y G., 24 USPQ2d 1152 (TTAB 1992), and In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986). Moreover, a final action should not be issued until all matters but for those which are to be the subject of the final action have been resolved, and a clear issue has been developed between the Examining Attorney and the applicant with respect to each remaining ground of refusal or requirement. See In re Variable Speech Control Co., 209 USPQ 431 (TTAB 1980), and TMEP §1105.04(c). See also In re Moore Business Forms Inc., 24 USPQ2d 1638 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration). As stated in TMEP §1105.04(c),

> No requirement may be made final, even if it is a repeated requirement, unless the entire action is made final. Thus, if the examining attorney makes a new refusal or requirement in a subsequent action, a repeated refusal or requirement may not be made final.

If an applicant believes that a refusal to register, or the insistence upon a requirement, has been made final prematurely, applicant may raise the matter by request to the Examining Attorney for reconsideration and by petition to the Commissioner. See TMEP §1105.04(e).

The prematureness of a final action is not a ground for appeal to the Board. See TMEP §1105.04(e). However, if it comes to the attention of the Board, when an appeal has been filed from a final refusal to register or a final requirement, that the final action was issued prematurely, the Board normally will suspend action with respect to the appeal and remand the case to the Examining Attorney with appropriate instructions. The instructions in the remand letter generally are to the effect that the finality of the Examining Attorney's action should be withdrawn; that a new nonfinal action should be issued; that if the Examining Attorney finds, upon consideration of applicant's response to the new nonfinal action, that the application is in condition for publication (or for registration, if the application seeks registration on the Supplemental Register), the appeal will be moot; and that if the Examining Attorney ultimately issues a new final action, no six-month response clause should be included therein, and the case should be returned to the

OLD EDITION

Board for resumption of action with respect to the appeal. See In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986), and In re Variable Speech Control Co., 209 USPQ 431 (TTAB 1980) (NOTE: a possible alternative approach, suggested in the latter case for use in situations where informalities which are not the subject of the appeal have not been resolved, of including in the Board's decision on the appealed issues a recommendation that no registration be granted to applicant until the informalities have been resolved, is no longer appropriate because (1) present 37 CFR §2.142(c), adopted thereafter, provides that all requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal, and (2) it is now settled that once the Board decides an appeal, the Examining Attorney is without jurisdiction to take further action in the case, nor may the Board, in its decision on the appealed issues, remand the case for further action on a matter not before it in the appeal--see In re Hamilton Bank, 222 USPQ 174 (TTAB 1984); In re Mercedes Slacks, Ltd., 213 USPQ 397 (TTAB 1982); and TBMP §1217).

OLD EDITION

1201.03 Premature Appeal

An application is ripe for appeal when the Trademark Examining Attorney issues a final action, and an appeal may also be taken from a second refusal on the same ground(s) or a repeated requirement; an appeal from a first refusal or requirement is premature. See TBMP §1201.01, and authorities cited therein.

The Board has no jurisdiction to entertain a premature appeal. Thus, if an appeal is filed prematurely, the Board, in a written action, will notify applicant that the appeal was filed prematurely, and remand the application to the Trademark Examining Attorney for further appropriate action. In the event that a final action, or a second refusal on the same ground(s) or a repeated requirement, is ultimately issued by the Examining Attorney, and applicant wishes to appeal, applicant should file a new notice of appeal, and request that the appeal fee previously submitted be applied to the new appeal. If, on the other hand, no new appeal is ever filed in the case, applicant may request that the appeal fee submitted with the premature appeal be refunded.

1201.04 Compliance With Requirements Not Subject of Appeal

37 CFR §2.142(c) All requirements made by the examiner and not the subject of appeal shall be complied with prior to the filing of an appeal.

Prior to the filing of an appeal, the applicant should comply with all requirements which have been made by the Trademark Examining Attorney, but which are not the subject of appeal. If an applicant which files an appeal to the Board fails to comply with a requirement not the subject of appeal, the refusal to register may be affirmed by the Board as to that requirement, regardless of the disposition made by the Board of the issue or issues which are the subject of appeal. See 37 CFR §2.142(c); In re Babies Beat Inc., 13 USPQ2d 1729 (TTAB 1990); In re Cord Crafts Inc., 11 USPQ2d 1157 (TTAB 1989); In re Riddle, 225 USPQ 630 (TTAB 1985); In re Big Daddy's Lounges, Inc., 200 USPQ 371 (TTAB 1978); and Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984). Cf. In re Walker-Home Petroleum, Inc., 229 USPQ 773 (TTAB 1985), and In re Citibank, N.A., 225 USPQ 612 (TTAB 1985).

OLD EDITION

1201.05 Appeal Versus Petition

37 CFR §2.63(b) After reexamination the applicant may respond by filing a timely petition to the Commissioner for relief from a formal requirement if: (1) The requirement is repeated, but the examiner's action is not made final, and the subject matter of the requirement is appropriate for petition to the Commissioner (see §2.146(b)); or (2) the examiner's action is made final and such action is limited to subject matter appropriate for petition to the Commissioner. If the petition is denied, the applicant shall have until six months from the date of the Office action which repeated the requirement or made it final or thirty days from the date of the decision on the petition, whichever date is later, to comply with the requirement. A formal requirement which is the subject of a petition decided by the Commissioner may not subsequently be the subject of an appeal to the Trademark Trial and Appeal Board.

37 CFR §2.64(a) On the first or any subsequent reexamination or reconsideration the refusal of the registration or the insistence upon a requirement may be stated to be final, whereupon applicant's response is limited to an appeal, or to a compliance with any requirement, or to a petition to the Commissioner if permitted by §2.63(b).

37 CFR §2.146(a) Petition may be taken to the Commissioner: (1) From any repeated or final formal requirement of the examiner in the ex parte prosecution of an application if permitted by §2.63(b); (2) in any case for which the Act of 1946, or Title 35 of the United States Code, or this Part of Title 37 of the Code of Federal Regulations specifies that the matter is to be determined directly or reviewed by the Commissioner; (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances; (4) in any case not specifically defined and provided for by this Part of Title 37 of the Code of Federal Regulations; (5) in an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules not being a requirement of the Act of 1946.

(b) Questions of substance arising during the ex parte prosecution of applications, including, but not limited to, questions arising under sections 2, 3, 4, 5, 6 and 23 of the Act of 1946, are not considered to be appropriate subject matter for petitions to the Commissioner.

An action taken on a matter arising during the ex parte prosecution of an application for registration may, depending on the nature of the matter and the posture of the case, be reviewable only by appeal to the Board, or only by petition to the Commissioner, or by either appeal or petition. The following discussion contains general guidelines for determining whether a matter is appealable or petitionable.

An appeal to the Board may be taken from any final action, second refusal to register on the same ground(s), or repeated requirement issued by the Trademark Examining Attorney during the ex parte prosecution of an application for registration, whether the matter involved in the Examining Attorney's action is substantive or procedural in nature, except that a formal requirement which was the subject of a petition decided by the Commissioner may not thereafter be the subject of an appeal to the Board. See Section 20 of the Act, 15 U.S.C. §1070; 37 CFR §§2.63(b), 2.64(a), and 2.141; In re Pony International Inc., 1 USPQ2d 1076 (Comm'r 1986); and TBMP §1201.01.

Substantive questions arising during the ex parte prosecution of an application, including, but not limited to, issues arising under Sections 2, 3, 4, 5, 6, and 23 of the Act, 15 U.S.C. §§1052, 1053, 1054, 1055, 1056, and 1091, are considered to be appropriate subject matter for appeal to the Board (after issuance of a final action, or a second refusal on the same ground(s)--see TBMP §1201.01), but not for petition to the Commissioner. See 37 CFR §2.146(b); In re Mission

OLD EDITION

Pharmacal Co., Inc., 33 USPQ2d 1060 (Comm'r 1993); In re Direct Access Communications (M.C.G.) Inc., 30 USPQ2d 1393 (Comm'r 1993); In re Tetrafluor Inc., 17 USPQ2d 1160 (Comm'r 1990); In re Hart, 199 USPQ 585 (Comm'r 1978); and In re Stenographic Machines, Inc., 199 USPQ 313 (Comm'r 1978).

Nevertheless, a wide variety of matters are petitionable. Petition may be taken to the Commissioner in the following situations:

(1) From any repeated or final formal requirement made by the Trademark Examining Attorney, during the ex parte prosecution of an application, if (i) the requirement is repeated, but the Examining Attorney's action is not made final, and the subject matter of the requirement is appropriate for petition to the Commissioner (see, in this regard, 37 CFR §2.146(b), and the preceding paragraph), or (ii) the Examining Attorney's action is made final and is limited to subject matter appropriate for petition to the Commissioner. See 37 CFR §§2.63(b) and 2.146(a)(1). If the petition is denied, the applicant will have six months from the date of the Office action which repeated the requirement or made it final, or 30 days from the date of the Commissioner's decision on the petition, whichever is later, to comply with the requirement. A formal requirement which was the subject of a petition to the Commissioner may not thereafter be the subject of an appeal to the Board. See 37 CFR §2.63(b). See also In re Pony International Inc., 1 USPQ2d 1076 (Comm'r 1986).

(2) In any case for which the Act of 1946, or Title 35 of the United States Code, or Part 2 of 37 CFR (i.e., the rules of practice in trademark cases) specifies that the matter is to be determined directly or reviewed by the Commissioner. See 37 CFR §2.146(a)(2). Insofar as applications for registration are concerned, this includes petitions to make special (i.e., to advance an application out of its normal order of examination), petitions to revive an abandoned application, petitions to record a document in the Assignment Branch of the PTO, and petitions requesting that an interference be declared. See TMEP §§1702 and 1703.

(3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. See 37 CFR §2.146(a)(3). Under this provision, an applicant generally may petition to the Commissioner for relief from, inter alia, a nonfinal refusal to register based on a procedural matter, i.e., an alleged failure of the applicant to comply with a technical requirement of the rules of practice governing trademark cases, or an alleged failure of the Examining Attorney to act in accordance with those rules and/or proper practice thereunder. See, for example, In re Mission Pharmacal Co., Inc., 33 USPQ2d 1060 (Comm'r 1993); In re Direct Access Communications (M.C.G.) Inc., 30 USPQ2d 1393 (Comm'r

OLD EDITION

1993); In re Tetrafluor Inc., 17 USPQ2d 1160 (Comm'r 1990); In re Hart, 199 USPQ 585 (Comm'r 1978); and In re Stenographic Machines, Inc., 199 USPQ 313 (Comm'r 1978); and TMEP §§1702 and 1703. For further information concerning the matters which are petitionable under this provision, see TMEP §§1702 and 1703.

(4) In any case not specifically defined and provided for by Part 2 of 37 CFR (i.e., the rules of practice in trademark cases). See 37 CFR §2.146(a)(4). Under this provision, an applicant may petition the Commissioner with respect to any situation, not covered by the rules, from which applicant seeks relief. See TMEP §1702.

(5) In an extraordinary situation, when justice requires and no other party is injured thereby, to request a suspension or waiver of any requirement of the rules which is not also a requirement of the Act of 1946. See 37 CFR §2.146(a)(5). For information concerning the meaning of the words "extraordinary situation," see TMEP §1702.

However, petition may not be taken to the Commissioner on a question of substance arising during the ex parte prosecution of an application; nor may petition be taken from a final action of the Examining Attorney, except that an applicant may petition for relief from an action making a formal requirement final if the action is limited to subject matter appropriate for petition to the Commissioner (i.e., involves questions such as the applicant's alleged failure to comply with one or more of the technical requirements of the rules of practice in trademark cases, rather than a question of substance). See 37 CFR §§2.63(b), 2.64(a), 2.146(a), and 2.146(b); In re Tetrafluor Inc., 17 USPQ2d 1160 (Comm'r 1990); In re Hart, 199 USPQ 585 (Comm'r 1978); In re Stenographic Machines, Inc., 199 USPQ 313 (Comm'r 1978); and TMEP §1702.

For examples of matters which are appealable and those which are petitionable, see TMEP §1501.01.

OLD EDITION

1202 Filing an Appeal

1202.01 In General

15 U.S.C. §1070. An appeal may be taken to the Trademark Trial and Appeal Board from any final decision of the examiner in charge of the registration of marks upon the payment of the prescribed fee.

37 CFR §2.141 Ex parte appeals from the Examiner of Trademarks. Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

37 CFR §2.142(a) Any appeal filed under the provisions of §2.141 must be filed within six months from the date of final refusal or the date of the action from which the appeal is taken. An appeal is taken by filing a notice of appeal and paying the appeal fee.

An appeal to the Board from a Trademark Examining Attorney's final action, second refusal on the same ground(s), or repeated requirement, is taken by timely (see TBMP §1202.02) filing in the PTO both a notice of appeal and the prescribed appeal fee (see 37 CFR §2.6(a)(18) and TBMP §1202.04). See Section 20 of the Act, 15 U.S.C. §1070; 37 CFR §§2.141 and 2.142(a); and TMEP §1501. If the notice of appeal and fee are not timely filed, the application will be deemed to have been abandoned, and the appeal cannot be entertained by the Board unless applicant successfully petitions the Commissioner to revive the application. See Section 12(b) of the Act, 15 U.S.C. §1062; 37 CFR §§2.64(a), 2.65(a), and 2.66; and TMEP §§1112.02, 1112.05(a), and 1112.05(b) et seq.

All requirements which have been made by the Trademark Examining Attorney, but which are not to be the subject of appeal, should be complied with prior to the filing of an appeal. See 37 CFR §2.142(c). If an applicant which files an appeal to the Board fails to comply with such a requirement, the refusal to register may be affirmed by the Board for failure to comply with that requirement, regardless of the disposition made by the Board of the issue or issues which are the subject of appeal. See TBMP §1201.04, and authorities cited therein.

OLD EDITION

1202.02 Time for Appeal

An appeal to the Board may be taken from any final action, second refusal on the same ground(s), or repeated requirement issued by the Trademark Examining Attorney during the ex parte prosecution of an application for registration, except that a formal requirement which was the subject of a petition decided by the Commissioner may not thereafter be the subject of an appeal to the Board. See TBMP §§1201.01 and 1201.05, and authorities cited therein.

An appeal to the Board must be filed within six months from the date of the action from which the appeal is taken. See Section 12(b) of the Act, 15 U.S.C. §1062, and 37 CFR §2.142(a). If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. See TBMP §1202.01, and authorities cited therein.

The notice of appeal to the Board (unlike other correspondence to be filed with the Board) may be filed by facsimile transmission, as well as by any of the ordinary methods for filing correspondence intended for the Board. See 37 CFR §1.6(d)(8), and TBMP §107. The certificate of mailing and certificate of transmission procedures described in 37 CFR §1.8, and the certificate of "Express Mail" procedure described in 37 CFR §1.10, are available for the filing of an appeal to the Board. See 37 CFR §§1.8(a) and 1.10(a), and TBMP §§110 and 111.

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. See 37 CFR §2.64(b). See also TMEP §§1105.04(f) and 1110, and Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984). However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Commissioner, if appropriate--see 37 CFR §§2.63(b) and 2.64(a), and TBMP §1201.05). See 37 CFR §2.64(b), and TMEP §1110. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response (see 37 CFR §2.64(a), and TMEP §1105.04(g)) to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. See 37 CFR §§2.64 and 2.142(a), and TMEP §1105.04(f). Thus, if an applicant which has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

OLD EDITION

If an appeal is late filed, but applicant timely filed some other response to the appealed action, such as an amendment or request for reconsideration, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for appropriate action with respect to the paper that was timely filed.

1202.03 Notice of Appeal

A notice of appeal is a simple statement indicating that applicant appeals from the decision of the Trademark Examining Attorney refusing registration; reasons for appeal need not be given. The notice of appeal should bear at its top the wording "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD," followed by information identifying the application in which the appeal is being filed, namely, applicant's name, the serial number and filing date of the application, and the involved mark.

A notice of appeal need not be verified, and it may be signed by the applicant or its attorney or other authorized representative.

Although the notice of appeal must be signed, an unsigned notice of appeal will not be refused consideration if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. Cf. 37 CFR §2.119(e), and TBMP §106.02. The same is true of other unsigned papers filed in an application during an ex parte appeal to the Board.

For further information concerning signature of papers, see TBMP §106.02.

The Board prefers that a notice of appeal be submitted in typewritten or printed form, double spaced. A notice of appeal may be submitted on either legal or letter-size paper. However, letter-size paper (the size preferred by many Federal district courts) is recommended. See TBMP §106.03. Cf. 37 CFR §2.31.

The PTO has no printed form for use in filing a notice of appeal. However, as an aid to applicants, the PTO has prepared a suggested format for a notice of appeal. A notice of appeal need not follow the suggested format, as long as it includes

OLD EDITION

the necessary information. The suggested format for a notice of appeal is shown below:

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....
(Name of applicant)
.....
(Serial Number of application)
.....
(Filing date of application)
.....
(Mark)

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.(1)

By.....
(Signature)(2)
.....
(Identification of person signing)(3)

OLD EDITION

FOOTNOTES

(1) The required fee must be submitted for each class for which an appeal is taken. If an appeal is taken for fewer than the total number of classes in the application, the classes in which the appeal is taken should be specified.
(2) The notice of appeal may be signed by the applicant or by the applicant's attorney or other authorized representative. If an applicant signing for itself is a partnership, the signature must be made by a partner; if an applicant signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.
(3) State the capacity in which the signing individual signs, e.g., attorney for applicant, applicant (if applicant is an individual), partner of applicant (if applicant is a partnership), officer of applicant identified by title (if applicant is a corporation), etc.

1202.04 Appeal Fee

37 CFR 2.85(e) Where the amount of the fee received on filing an appeal in connection with an application or on an application for renewal or in connection with a petition for cancellation is sufficient for at least one class of goods or services but is less than the required amount because multiple classes in an application or registration are involved, the appeal or renewal application or petition for cancellation will not be refused on the ground that the amount of the fee was insufficient if the required additional amount of the fee is received in the Patent and Trademark Office within the time limit set forth in the notification of this defect by the Office, or if action is sought only for the number of classes equal to the number of fees submitted.

37 CFR §2.141 Ex parte appeals from the Examiner of Trademarks.
Every applicant for the registration of a mark may, upon final refusal by the Examiner of Trademarks, appeal to the Trademark Trial and Appeal Board upon payment of the prescribed fee for each class in the application for which an appeal is taken. An appeal which includes insufficient fees to cover all classes in the application should specify the particular class or classes in which an appeal is taken. A second refusal on the same grounds may be considered as final by the applicant for purpose of appeal.

An ex parte appeal to the Board is taken by timely filing in the PTO both a notice of appeal and the prescribed appeal fee. If a notice of appeal is timely filed, but the appeal fee is not, the appeal will be untimely, and the application will be deemed to have been abandoned. See TBMP §1202.01, and authorities cited therein.

The amount of the fee required for an ex parte appeal to the Board is specified in 37 CFR §2.6(a)(18). If an application in which an appeal is filed has more than one class of goods and/or services (see 37 CFR §2.86(b)), the required fee must be paid for each class in which appeal is taken. See 37 CFR §2.6(a)(18). If an appeal is taken in, and an appeal fee is submitted for, fewer than all of the classes in the application, the class or classes in which the appeal is taken should be specified. See 37 CFR §2.141, and TMEP §1113.05(a).

OLD EDITION

If an applicant timely submits a fee sufficient to pay for an appeal in at least one class, but the fee submitted is less than the required amount because multiple classes in an application are involved, and applicant has not specified the class or classes to which the submitted fee applies, the Board will issue a written notice allowing applicant until a set time in which to submit the required fee or to specify the class or classes appealed. If the required fee is not submitted, or the specification made, within the time set in the notice, the fee submitted will be applied to the classes in ascending order, beginning with the lowest numbered class and including the number of classes in the application for which sufficient fees have been submitted. See 37 CFR §§2.85(e) and 2.141, and TMEP §§1113.05(a) and 1501.04.

OLD EDITION

1203 Appeal Briefs

1203.01 Form of Brief

37 CFR §2.142(b)(2) Briefs shall be submitted in typewritten or printed form, double spaced, in at least pica or eleven-point type, on letter-size paper. Without prior leave of the Trademark Trial and Appeal Board, a brief shall not exceed twenty-five pages in length in its entirety.

A brief filed in an ex parte appeal to the Board should conform to the requirements of 37 CFR §2.142(b)(2). Only one copy of the brief need be submitted.

The brief should bear a title indicating that it is an appeal brief, as well as information identifying the application in which it is filed, namely, the applicant's name, the serial number and filing date of the application, and the mark sought to be registered. Cf. TMEP §702.

For further information concerning the form and contents of the Trademark Examining Attorney's appeal brief, in particular, see TMEP §1501.02.

1203.02 Time for Filing Brief

1203.02(a) Applicant's Main Brief

37 CFR §2.142(b)(1) The brief of appellant shall be filed within sixty days from the date of appeal. If the brief is not filed within the time allowed, the appeal may be dismissed. The examiner shall, within sixty days after the brief of appellant is sent to the examiner, file with the Trademark Trial and Appeal Board a written brief answering the brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

An applicant's main brief in an ex parte appeal to the Board must be filed within 60 days from the date of appeal, or within an extension of time for that purpose. If no brief is filed, the appeal will be dismissed. See 37 CFR §2.142(b)(1). If the brief is filed late, applicant will be allowed an opportunity to submit an explanation for the late filing; in the absence of an adequate explanation, the appeal will be dismissed.

If a notice of appeal (accompanied by the required fee) is filed with a certificate of mailing by first-class mail pursuant to 37 CFR §1.8, the date of mailing specified in the certificate will be used for determining the timeliness of the notice of appeal. However, the actual date of receipt of the notice of appeal in the PTO will be used for all other purposes, including the running of the time for filing applicant's main brief. See 37 CFR §1.8(a).

If an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal, and the Examining Attorney has not yet considered the request for reconsideration when the appeal is filed, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the request. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and a new final refusal to register is issued (either in the Examining Attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief. If the Examining Attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will

OLD EDITION

be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or for registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant.

1203.02(b) Trademark Examining Attorney's Brief

When the applicant's main appeal brief has been received by the Board and entered in the application file, the Board sends the file to the Trademark Examining Attorney. Within 60 days after the date of the Board's written action forwarding the file to the Examining Attorney, or within an extension of time for the purpose, the Examining Attorney must file an appeal brief answering the applicant's main brief. See 37 CFR §2.142(b)(1); In re Wells Fargo & Co., 231 USPQ 106 (TTAB 1986); In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, 223 USPQ 188 (TTAB 1984); TMEP §1501.02; and Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984). See also In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985). The Examining Attorney must also mail a copy of his or her brief to the applicant. See 37 CFR §2.142(b)(1). See also In re De Luxe N.V., 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993). If the Examining Attorney's brief is late filed, it may be excluded by the Board in the absence of an adequate explanation for the late filing. See In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, supra.

If the Examining Attorney, having received the application for preparation of his or her appeal brief, is persuaded, by applicant's appeal brief, that applicant is entitled to the registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney must also notify the applicant, in writing. See TMEP §1501.03.

On the other hand, the Examining Attorney, having received the application for preparation of his or her appeal brief, may decide that registration should be

OLD EDITION

refused on an additional ground, or that a new requirement should be made, or that the application should be suspended. In that event, the Examining Attorney, during the time for and instead of preparing an appeal brief, should send to the Board a written request that the application be remanded to him or her for further examination. See TMEP §1501.02. See also In re Moore Business Forms Inc., 24 USPQ2d 1638 (TTAB 1992) (ground for refusal first raised in Examining Attorney's appeal brief given no consideration). For information concerning requests for remand, see TBMP §1209 and TMEP §1504.05(a). If the request is denied, the Board will reset the Examining Attorney's time in which to file an appeal brief. See In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985). If the request is granted, the Board will suspend proceedings with respect to the appeal, and remand the application to the Examining Attorney for further examination in accordance with the request for remand. If, during the course of the further examination, the application is ultimately approved for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. If the Examining Attorney refuses registration on a new ground, or makes a new requirement, and the new refusal or requirement is ultimately made final, the new final action should not include a six-month response clause; the application should be returned to the Board; and the Board will resume proceedings with respect to the appeal and allow applicant 60 days in which to submit a supplemental appeal brief directed to the new issue or issues, following which the application will be returned to the Examining Attorney for preparation of his or her appeal brief.

OLD EDITION

1203.02(c) Applicant's Reply Brief

Within 20 days from the mailing date of the Trademark Examining Attorney's appeal brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief. See 37 CFR §2.142(b)(1); In re Gena Laboratories, Inc., 230 USPQ 382 (TTAB 1985); and In re Randall & Hustedt, 226 USPQ 1031 (TTAB 1985). Cf. In re Gale Hayman Inc., 15 USPQ2d 1478 (TTAB 1990). However, the filing of a reply brief is not mandatory.

If the applicant files a reply brief, a copy thereof will be forwarded by the Board to the Trademark Examining Attorney. If the Examining Attorney, having read the applicant's reply brief, is persuaded thereby that applicant is entitled to the registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register

application), and the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney must also notify the applicant, in writing. See TMEP §1501.03.

There is no provision in the rules for the filing by the Examining Attorney of a written response to the applicant's reply brief. However, if the applicant requests an oral hearing, the Examining Attorney may respond orally, at the oral hearing, to arguments raised in applicant's reply brief. See TMEP §1501.02(a).

OLD EDITION

1203.02(d) Extension of Time for Filing Brief

An extension of time for filing an appeal brief in an ex parte appeal to the Board may be granted by the Board upon written request showing good cause for the requested extension. See In re Miller Brewing Co., 226 USPQ 666 (TTAB 1985). See also In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, 223 USPQ 188 (TTAB 1984).

1204 Effect of Request for Reconsideration of Final Action

During the period between issuance of a final action and expiration of the time for filing an appeal therefrom, an applicant may file a request for reconsideration, with or without an amendment and/or new evidence. See 37 CFR §2.64(b). See also TMEP §§1105.04(f) and 1110, and Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984). However, the filing of a request for reconsideration will not serve to stay the time for filing an appeal (or for petitioning the Commissioner, if appropriate--see 37 CFR §§2.63(b) and 2.64(a), and TBMP §1201.05). See 37 CFR §2.64(b), and TMEP §1110. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and no appeal or other proper response (see 37 CFR §2.64(a), and TMEP §1105.04(g)) to the final refusal has been filed during the six months following issuance of the final action, the application will be abandoned. See 37 CFR §§2.64 and 2.142(a), and TMEP §1105.04(f). Thus, if an applicant which

has filed a request for reconsideration of a final action wishes to preserve its right to appeal in the event that the request is unsuccessful, the applicant must file an appeal prior to the expiration of the six-month period following issuance of the final action.

When an applicant files, in response to a final action, or a second refusal on the same ground(s), or a repeated requirement, both a request for reconsideration and an appeal, the request for reconsideration should be made by separate paper and should specify the reasons why applicant believes reconsideration is warranted. The request for reconsideration should not be combined with the applicant's appeal brief. See In re Best Western Family Steak House, Inc., 222 USPQ 827 (TTAB 1984).

If an applicant which has filed a timely request for reconsideration of a final action, second refusal on the same ground(s), or repeated requirement, also files a timely appeal, and the Examining Attorney has not yet considered the request for reconsideration when the appeal is filed, the file of the application, with the appeal and the request for reconsideration, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and request, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the request. For information concerning the actions which an Examining Attorney may take in response to a request for reconsideration of a final action, see TMEP §1110. See also In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992). Further, if the Examining Attorney believes that the outstanding issue(s) can be resolved, the Examining Attorney may contact applicant and attempt to work out a resolution.

If, after suspension and remand for consideration by the Examining Attorney of a timely request for reconsideration, the Examining Attorney approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. If, upon the Examining Attorney's consideration of the request, all refusals and requirements are not withdrawn, and a new final refusal to register is issued (either in the Examining Attorney's action on the request for reconsideration, or in a subsequent action), the six-month response clause should be omitted from the

OLD EDITION

paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief.

If an appeal is late filed, but applicant timely filed a request for reconsideration, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for consideration of the request for reconsideration.

A timely request for reconsideration of an appealed action may be accompanied by an amendment and/or by additional evidence. The evidentiary record in an application should be complete prior to the filing of an appeal, and additional evidence filed after appeal normally will be given no consideration by the Board. See 37 CFR §2.142(d). See also TBMP §1207. However, evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration. See Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984), and Daniel L. Skoler, TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities, 73 Trademark Rep. 310 (1983). See also In re Corning Glass Works, 229 USPQ 65 (TTAB 1985), and In re Best Western Family Steak House, Inc., 222 USPQ 827 (TTAB 1984).

If the Examining Attorney, upon consideration of a request for reconsideration (made with or without new evidence), does not find the request persuasive, and issues a new final or nonfinal action, the Examining Attorney may submit therewith new evidence directed to the issue(s) for which reconsideration is sought.

1205 Amendment of Application During Appeal

If, within six months following the issuance of a final action, or a second refusal on the same ground(s), or a repeated requirement, applicant files both an amendment to its application and an ex parte appeal to the Board, and the

OLD EDITION

Examining Attorney has not yet acted on the amendment when the appeal is filed, the file of the application, with the amendment and the appeal, will be forwarded to the Board. The Board will acknowledge receipt of the amendment and appeal, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Trademark Examining Attorney for consideration of the amendment. The Board's remand letter will also include instructions to the Examining Attorney with respect to the further actions which may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment. For information concerning the actions which may be taken by the Examining Attorney upon consideration of the amendment, see TMEP §1110. See also In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992); In re Abolio y Rubio S.A.C.I. y G., 24 USPQ2d 1152 (TTAB 1992); and In re Pierce Foods Corp., 230 USPQ 307 (TTAB 1986). Further, if the Examining Attorney believes that the outstanding issue(s) can be resolved, the Examining Attorney may contact applicant and attempt to work out a resolution. The Examining Attorney may not, however, assert a new refusal or requirement unrelated to the amendment or material submitted therewith, unless the Examining Attorney files with the Board a request under 37 CFR §2.142(f)(6) for remand to assert the new refusal or requirement, and the request is granted.

If the Examining Attorney is persuaded, on the basis of the amendment, that applicant is entitled to the registration sought, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), and the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant.

If the Examining Attorney, after consideration of the amendment filed after appeal, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and applicant will be allowed time in which to file its appeal brief.

If an applicant which has filed a timely appeal to the Board files an amendment to its application more than six months after the issuance of the final action, or

OLD EDITION

the second refusal on the same ground(s), or the repeated requirement, from which the appeal was taken, the Board normally will suspend proceedings with respect to the appeal, and remand the application to the Examining Attorney for consideration of the amendment. The Board's remand letter will also include instructions to the Examining Attorney with respect to the further actions which may and/or should be taken by the Examining Attorney in conjunction with the Examining Attorney's consideration of the amendment. However, remand in an ex parte appeal is a matter of discretion with the Board, and the Board may refuse to remand for consideration of an amendment filed more than six months after the date of the action from which the appeal was taken, if, for example, the amendment was filed in bad faith, or would serve no useful purpose. Further, if remand is made, the Board's instructions to the Examining Attorney concerning the handling of the amendment, and further action in connection therewith, may differ, for an amendment filed more than six months after the date of the action from which the appeal was taken, from those given by the Board for an amendment filed within six months after that date.

If an appeal is late filed, but applicant timely filed an amendment to its involved application, the Board will issue a written action informing applicant of the lateness of its appeal; stating that the late appeal cannot be entertained by the Board; and forwarding the application to the Examining Attorney for appropriate action with respect to the amendment.

An application which has been considered and decided on appeal may be amended, if at all, only in accordance with 37 CFR §2.142(g). For further information concerning amendment after decision on appeal, see TBMP §1218, and TMEP §1501.05.

OLD EDITION

1206 Amendment to Allege Use; Statement of Use

1206.01 Amendment to Allege Use

An amendment to allege use under Section 1(c) of the Act, 15 U.S.C. §1051(c), may be filed in an intent-to-use application, i.e., an application under Section 1(b) of the Act, 15 U.S.C. §1051(b), at any time between the filing of the application and the date the Trademark Examining Attorney approves the mark for publication. Thereafter, an allegation of use may be submitted only as a statement of use under Section 1(d) of the Act, 15 U.S.C. §1051(d), after the

issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. §1063(b)(2). See 37 CFR §2.76(a), and "Wavier [sic] of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993). See also In re Sovran Financial Corp., 25 USPQ2d 1537 (Comm'r 1991).

Thus, an amendment to allege use filed during the pendency of an ex parte appeal to the Board is timely, even if the amendment to allege use was filed after the expiration of the six-month response period following issuance of the appealed final action. See "Wavier [sic] of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993).

If an applicant which has filed an amendment to allege use during the six-month response period following issuance of a final action also files a timely appeal, and the Examining Attorney has not yet acted on the amendment to allege use when the appeal is filed, the file of the application, with the appeal and the amendment to allege use, will be forwarded to the Board. The Board will acknowledge receipt of the appeal and amendment to allege use, suspend further proceedings (including applicant's time for filing its appeal brief) with respect to the appeal, and remand the application to the Examining Attorney for consideration of the amendment to allege use. That is, the amendment to allege use will be handled by the Board in the same manner as any other amendment filed during the six-month response period following issuance of a final action. See, in this regard, TBMP §1205. For information concerning examination by the Examining Attorney of an amendment to allege use filed in conjunction with a notice of appeal, see TMEP §1105.05(a)(i). If, in the course of examination of the amendment to allege use, the application is approved for publication (or for registration, in the case of an application amended to seek registration on the Supplemental Register), or becomes abandoned, the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), or has become abandoned, so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant, by telephone. If the Examining Attorney, after consideration of the amendment to allege use, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. See TMEP §1105.05(a)(i).

OLD EDITION

If an applicant which has filed a timely appeal to the Board files an amendment to allege use, in the application which is the subject of the appeal, more than six months after issuance of the appealed action, the Board may, in its discretion, suspend proceedings with respect to the appeal and remand the application to the Examining Attorney for consideration of the amendment to allege use. Alternatively, the Board may continue proceedings with respect to the appeal, thus deferring examination of the amendment to allege use until after final determination of the appeal. See "Wavier [sic] of Trademark Rule 2.76(a)," 1156 TMOG 12 (November 2, 1993). If the final determination of the appeal is adverse to applicant, the amendment to allege use will be moot.

1206.02 Statement of Use

A statement of use under Section 1(d) of the Act, 15 U.S.C. §1051(d), is premature if it is filed in an intent-to-use application, i.e., an application under Section 1(b) of the Act, 15 U.S.C. §1051(b), prior to the issuance of a notice of allowance under Section 13(b)(2) of the Act, 15 U.S.C. §1063(b)(2). See 37 CFR §2.88(a).

A notice of allowance is not issued in an intent-to-use application (for which no amendment to allege use under Section 1(c) of the Act, 15 U.S.C. §1051(c) has been timely filed and accepted) unless and until the application is approved for publication, and then published in the Official Gazette for opposition; no timely opposition is filed or all oppositions filed are dismissed; and no interference is declared. See Section 13(b)(2) of the Act, and 37 CFR §2.81(b). See also TMEP §1105.05(e)(i) and TBMP §219.

Therefore, a statement of use filed during an ex parte appeal to the Board is premature. A premature statement of use will not be considered. See 37 CFR §2.88(a). See also TMEP §1105.05(e)(i). Instead, the premature statement of use will be returned to applicant after action has been taken to refund the fee submitted with the paper.

1207 Submission of Evidence During Appeal

1207.01 General Rule--Evidence Submitted After Appeal Untimely

OLD EDITION

37 CFR §2.142(d) The record in the application should be complete prior to the filing of an appeal. The Trademark Trial and Appeal Board will ordinarily not consider additional evidence filed with the Board by the appellant or by the examiner after the appeal is filed. After an appeal is filed, if the appellant or the examiner desires to introduce additional evidence, the appellant or the examiner may request the Board to suspend the appeal and to remand the application for further examination.

The evidentiary record in an application should be complete prior to the filing of an ex parte appeal to the Board. Additional evidence filed after appeal normally will be given no consideration by the Board. See 37 CFR §2.142(d). See also In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992); In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Nationwide Industries Inc., 6 USPQ2d 1882 (TTAB 1988); In re Bonni Keller Collections Ltd., 6 USPQ2d 1224 (TTAB 1987); In re Gold's Gym Enterprises Inc., 3 USPQ2d 1716 (TTAB 1987); In re International Environmental Corp., 230 USPQ 688 (TTAB 1986); In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984); In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull, 223 USPQ 363 (TTAB 1984); In re Carvel Corp., 223 USPQ 65 (TTAB 1984); In re Jos. Schlitz Brewing Co., 223 USPQ 45 (TTAB 1983); In re Best Western Family Steak House, Inc., 222 USPQ 827 (TTAB 1984); In re Jeep Corp., 222 USPQ 333 (TTAB 1984); In re Pierre Fabre S.A., 221 USPQ 1210 (TTAB 1984); In re Development Dimensions International, Inc., 219 USPQ 161 (TTAB 1983); In re Gagliardi Bros., Inc., 218 USPQ 181 (TTAB 1983); and In re Royal Viking Line A/S, 216 USPQ 795 (TTAB 1982). Cf. In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986), and In re Volvo White Truck Corp., 16 USPQ2d 1417 (TTAB 1990).

OLD EDITION

1207.02 Request to Remand for Additional Evidence

If an applicant or Trademark Examining Attorney wishes to introduce additional evidence after an appeal has been filed, the applicant or Examining Attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. See 37 CFR §2.142(d). See also In re Juleigh Jeans Sportswear Inc., 24 USPQ2d 1694 (TTAB 1992); In re Wells Fargo & Co., 231 USPQ 95 (TTAB 1986); In re Big Wrangler Steak House, Inc., 230 USPQ 634 (TTAB 1986); In re Bercut-Vandervoort & Co., 229 USPQ

763 (TTAB 1986); In re Chung, Jeanne & Kim Co., 226 USPQ 938 (TTAB 1985); In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984); In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull, 223 USPQ 363 (TTAB 1984); In re Carvel Corp., 223 USPQ 65 (TTAB 1984); In re Jos. Schlitz Brewing Co., 223 USPQ 45 (TTAB 1983); In re Best Western Family Steak House, Inc., 222 USPQ 827 (TTAB 1984); In re Jeep Corp., 222 USPQ 333 (TTAB 1984); In re Consolidated Foods Corp., 218 USPQ 184 (TTAB 1983); and In re Royal Viking Line A/S, 216 USPQ 795 (TTAB 1982).

A request under 37 CFR §2.142(d) to suspend and remand for additional evidence must be filed prior to the rendering of the Board's final decision on the appeal. See In re Johanna Farms, Inc., 223 USPQ 459 (TTAB 1984), and In re Carvel Corp., 223 USPQ 65 (TTAB 1984). In addition, the request must include a showing of good cause therefor (which may take the form of a satisfactory explanation as to why the evidence was not filed prior to appeal), and be accompanied by the additional evidence sought to be introduced. See In re Big Wrangler Steak House, Inc., 230 USPQ 634 (TTAB 1986); In re Bercut-Vandervoort & Co., 229 USPQ 763 (TTAB 1986); In re Chung, Jeanne & Kim Co., 226 USPQ 938 (TTAB 1985); In re Mayer-Beaton Corp., 223 USPQ 1347 (TTAB 1984); In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull, 223 USPQ 363 (TTAB 1984); In re Jeep Corp., 222 USPQ 333 (TTAB 1984); and In re Historic Wharf's Associates, Inc., 222 USPQ 92 (TTAB 1984). Examples of circumstances which have been found to constitute good cause for a remand for additional evidence include the following:

(1) The evidence was not previously available.

(2) A new attorney for the applicant, or a new Examining Attorney, has taken over the case and wishes to supplement the evidence of record. (The transfer of a case from one firm member to another is not considered by the Board to constitute good cause for a remand under the "new attorney" rationale.)

(3) The applicant and Examining Attorney have agreed to the remand. See In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities, 73 Trademark Rep. 310 (1983).

In addition, because a consent agreement, offered in response to a refusal to register under Section 2(d) of the Act, 15 U.S.C. §1052(d) (see, for example, In re N.A.D. Inc., 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985), and In re E.I. duPont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973); cf. In

OLD EDITION

re Mastic Inc., 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987)), is inherently difficult and time-consuming to obtain, and may be highly persuasive of registrability, the Board will grant a request to suspend and remand for consideration of a consent agreement if the request, accompanied by the consent agreement, is filed at any time prior to the rendering of the Board's final decision on the appeal.

If a request to remand for additional evidence is granted, the nonrequesting party may submit additional evidence in response to the evidence submitted with the request. See In re Northland Aluminum Products, Inc., 221 USPQ 1110 (TTAB 1984), aff'd, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985). Cf. In re Development Dimensions International, Inc., 219 USPQ 161 (TTAB 1983).

When an applicant's request to suspend and remand for additional evidence is granted, and the application is remanded to the Examining Attorney for further examination, the Examining Attorney may approve the application for publication (or for registration, in the case of a Supplemental Register application), or adhere to the action from which the appeal was taken. The Examining Attorney may also issue a new nonfinal action asserting any new refusal or requirement necessitated by the new evidence. The Examining Attorney may not, however, assert a new refusal or requirement unrelated to the new evidence, unless the Examining Attorney files with the Board a request under 37 CFR §2.142(f)(6) for remand to assert the new refusal or requirement, and the request is granted. If the Examining Attorney is persuaded, on the basis of the new evidence, that applicant is entitled to the registration sought, and approves the application for publication (or for registration, in the case of a Supplemental Register application), the appeal will be moot. However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. If the Examining Attorney, after consideration of the new evidence, adheres to the final refusal to register, or ultimately issues a new final refusal to register, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein.

When an Examining Attorney's request to suspend and remand for additional evidence is granted, the Board, in its action granting the request, will allow the

OLD EDITION

Examining Attorney until a specified time in which to issue an Office action (with no six-month response clause) relating to the new evidence to be submitted therewith. After the Examining Attorney's new action has been issued, the application should be returned to the Board; proceedings with respect to the appeal will be resumed; applicant will be allowed an opportunity to submit, if it so desires, responsive evidence; and further appropriate action with respect to the appeal will be taken. If applicant's appeal brief has already been filed, applicant will be allowed an opportunity, if it so desires, to file a supplemental brief directed to the new evidence submitted by the Examining Attorney.

1207.03 Evidence Considered Due to Actions of Nonoffering Party

Evidence submitted after appeal, without a granted request to suspend and remand for additional evidence (see TBMP §1207.02), may be considered by the Board, despite its untimeliness, if the nonoffering party (1) does not object to the new evidence, and (2) discusses the new evidence or otherwise affirmatively treats it as being of record. See, for example, In re Pennzoil Products Co., 20 USPQ2d 1753 (TTAB 1991); In re Nuclear Research Corp., 16 USPQ2d 1316 (TTAB 1990); In re Dana Corp., 12 USPQ2d 1748 (TTAB 1989); In re Pencils Inc., 9 USPQ2d 1410 (TTAB 1988); In re Wells Fargo & Co., 231 USPQ 95 (TTAB 1986); In re Weather Channel, Inc., 229 USPQ 854 (TTAB 1985); In re Bercut-Vandervoort & Co., 229 USPQ 763 (TTAB 1986); In re Cotter & Co., 228 USPQ 202 (TTAB 1985); In re Chung, Jeanne & Kim Co., 226 USPQ 938 (TTAB 1985); In re Bee Pollen From England Ltd., 219 USPQ 163 (TTAB 1983); In re Development Dimensions International, Inc., 219 USPQ 161 (TTAB 1983); Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984); and Daniel L. Skoler, TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities, 73 Trademark Rep. 310 (1983). In such a situation, evidence submitted by the nonoffering party to rebut the untimely evidence may be considered by the Board. See In re Development Dimensions International, Inc., supra. Cf. In re Northland Aluminum Products, Inc., 221 USPQ 1110 (TTAB 1984), aff'd, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985).

1207.04 Evidence Filed With Timely Request for Reconsideration

OLD EDITION

A timely request for reconsideration of an appealed action may be accompanied by additional evidence, which will thereby be made part of the evidentiary record in the application. There is no need, in such a situation, for a 37 CFR §2.142(d) request to suspend and remand for additional evidence. Evidence submitted with a timely request for reconsideration of an appealed action, that is, a request filed during the six-month response period following issuance of the appealed action, is considered by the Board to have been filed prior to appeal, even if the notice of appeal was, in fact, filed earlier in the six-month response period than the request for reconsideration. See TBMP §1204, and authorities cited therein.

When a timely request for reconsideration of an appealed action is filed (with or without new evidence), the Examining Attorney may submit, with his or her response to the request, new evidence directed to the issue(s) for which reconsideration is sought.

OLD EDITION

1207.05 Submission of Evidence Upon Remand for New Refusal

Additional evidence may be submitted, both by the Examining Attorney and by the applicant, if (1) an appealed application is remanded by the Board for further examination under 37 CFR §2.142(f) (i.e., sua sponte remand by the Board when it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable) or under 37 CFR §2.142(f)(6) (i.e., remand by the Board upon written request by the Examining Attorney when it appears to the Examining Attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable), and (2) the Examining Attorney, upon remand, does, in fact, issue a new refusal to register or requirement. See In re Bank America Corp., 229 USPQ 852 (TTAB 1986). If no new refusal or requirement is made, and the file is instead returned by the Examining Attorney to the Board, no additional evidence may be submitted. See In re Diet Tabs, Inc., 231 USPQ 587 (TTAB 1986).

1207.06 Letter of Protest Evidence

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the

PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Director will determine whether the information should be given to the Trademark Examining Attorney for consideration. See TBMP §215, and authorities cited therein.

Proceedings in an ex parte appeal will not be suspended pending determination by the Director of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the Examining Attorney, having considered the supporting evidence submitted with the letter of protest, wishes to make that evidence of record in the application, that is, wishes to rely on the evidence to support the appealed refusal of registration, the Examining Attorney may file a written request with the Board, pursuant to 37 CFR 2.142(d), to suspend the appeal and remand the application for further examination. For information concerning a request for remand for additional evidence, see TBMP §1207.02.

The request must be filed prior to the rendering of the Board's final decision on the appeal, and must be accompanied by the additional evidence sought to be introduced. See TBMP §1207.02. In addition, the request must include a showing of good cause therefor, in the same manner as any other request to remand for additional evidence. For information concerning good cause for a remand for additional evidence, see TBMP §1207.02.

OLD EDITION

1208 Treatment of Evidence

The Board generally takes a somewhat more permissive stance with respect to the introduction and evaluation of evidence in an ex parte proceeding than it does in an inter partes proceeding. That is, in an ex parte proceeding, the Board tolerates some relaxation of technical requirements for the introduction of evidence and focuses instead on the spirit and essence of the rules of evidence. The reason for this more relaxed approach in ex parte cases is that in an ex parte proceeding, there is no cross-examination of witnesses or any compelling need for the strict safeguards required in an inter partes proceeding. See In re Murphy Door Bed Co., 223 USPQ 1030 (TTAB 1984); In re Pillsbury Co., 174 USPQ 318 (TTAB 1972); and Daniel L. Skoler, TIPS FROM THE TTAB: Evidence in Ex Parte Appeals--Problems and Lost Opportunities, 73 Trademark Rep. 310, 315 (1983).

See also In re Berman Bros. Harlem Furniture Inc., 26 USPQ2d 1514 (TTAB 1993).

For example, the affidavit or 37 CFR §2.20 declaration is an established method for the introduction of evidence in an ex parte proceeding. See, for example, 37 CFR §2.41(b); In re Manco Inc., 24 USPQ2d 1938 (TTAB 1992); In re Bauhaus Designs Canada Ltd., 12 USPQ2d 2001 (TTAB 1989); In re Motorola, Inc., 3 USPQ2d 1142 (TTAB 1986); In re Peterson Manufacturing Co., 229 USPQ 466 (TTAB 1986); In re Melville Corp., 228 USPQ 970 (TTAB 1986); In re Gammon Reel, Inc., 227 USPQ 729 (TTAB 1985); and In re Original Red Plate Co., 223 USPQ 836 (TTAB 1984). In an inter partes proceeding, however, evidence may not be offered in affidavit or 37 CFR §2.20 declaration form except by agreement of the parties. See 37 CFR §2.123(b), and TBMP §713.02 and cases cited therein.

For information as to how the Court of Appeals for the Federal Circuit, in reviewing a decision of the Board on an ex parte appeal, evaluates the sufficiency of the evidence offered by the Trademark Examining Attorney, see In re Budge Manufacturing Co., 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988) (Court, being mindful that the PTO has limited facilities for acquiring evidence--it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits--concludes evidence of record is sufficient to establish a prima facie case of deceptiveness), and In re Loew's Theatres, Inc., 769 F.2d 764, 768, 226 USPQ 865, 868 (Fed. Cir. 1985) ("...practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action."). But see In re Mavety Media Group Ltd., 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) ("...the PTO may discharge its burden of proving that Mavety's mark BLACK TAIL is scandalous under §1052(a) through evidence such as consumer surveys regarding the substantial composite of the general public.").

OLD EDITION

1209 Remand for New Refusal or New Requirement

1209.01 Upon Board's Own Initiative

37 CFR §2.142(f)(1) If, during an appeal from a refusal of registration, it appears to the Trademark Trial and Appeal Board that an issue not previously raised may render the mark of the appellant unregistrable, the Board may

suspend the appeal and remand the application to the examiner for further examination to be completed within thirty days.

(2) If the further examination does not result in an additional ground for refusal of registration, the examiner shall promptly return the application to the Board, for resumption of the appeal, with a written statement that further examination did not result in an additional ground for refusal of registration.

(3) If the further examination does result in an additional ground for refusal of registration, the examiner and appellant shall proceed as provided by §§2.61, 2.62, 2.63 and 2.64. If the ground for refusal is made final, the examiner shall return the application to the Board, which shall thereupon issue an order allowing the appellant sixty days from the date of the order to file a supplemental brief limited to the additional ground for the refusal of registration. If the supplemental brief is not filed by the appellant within the time allowed, the appeal may be dismissed.

(4) If the supplemental brief of the appellant is filed, the examiner shall, within sixty days after the supplemental brief of the appellant is sent to the examiner, file with the Board a written brief answering the supplemental brief of appellant and shall mail a copy of the brief to the appellant. The appellant may file a reply brief within twenty days from the date of mailing of the brief of the examiner.

(5) If an oral hearing on the appeal had been requested prior to the remand of the application but not yet held, an oral hearing will be set and heard as provided in paragraph (e) of this section. If an oral hearing had been held prior to the remand or had not been previously requested by the appellant, an oral hearing may be requested by the appellant by a separate notice filed not later than ten days after the due date for a reply brief on the additional ground for refusal of registration. If the appellant files a request for an oral hearing, one will be set and heard as provided in paragraph (e) of this section.

If, during an ex parte appeal to the Board, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may issue a written action suspending the appeal and remanding the application to the Trademark Examining Attorney for further examination with respect to that issue. See 37 CFR §2.142(f)(1). See also In re United States Tobacco Co., 1 USPQ2d 1502, 1505 (TTAB 1986) (rule comes into play only where a possible ground of refusal not previously raised is discovered by the Board); In re Opryland USA Inc., 1 USPQ2d 1409, 1411 (TTAB 1986); In re

OLD EDITION

Diet Tabs, Inc., 231 USPQ 587, 588 (TTAB 1986); In re Johanna Farms, Inc., 223 USPQ 459, 461 (TTAB 1984); and Gary D. Krugman, TIPS FROM THE TTAB: The Amended Trademark Rules of Practice and Their Effect on Ex Parte Appeals, 74 Trademark Rep. 341 (1984). See also In re Wella A.G., 230 USPQ 77 (TTAB 1986) (but see In re Wella A.G., 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988)). The further examination must be completed within 30 days from the date of remand, or within an extension of time for that purpose. See 37 CFR §2.142(f)(1).

If the Examining Attorney, upon consideration of the issue specified in the Board's remand letter, does not believe that the specified issue renders the mark of the applicant unregistrable, the Examining Attorney must promptly return the application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration. See 37 CFR §2.142(f)(2). See also In re Diet Tabs, Inc., 231 USPQ 587 (TTAB 1986).

If the Examining Attorney returns the remanded application to the Board with a written statement that further examination did not result in an additional ground for refusal of registration, the Board will resume proceedings with respect to the appeal, and take further appropriate action therein. The issues ultimately determined by the Board will be those which were the subject of the appeal; no consideration will be given to the issue which was the subject of the remand. See In re Diet Tabs, Inc., 231 USPQ 587 (TTAB 1986).

If, on the other hand, the further examination does result in an additional ground for refusal of registration, the Examining Attorney and applicant should proceed as specified in 37 CFR §§2.61 through 2.64. See 37 CFR §2.142(f)(3). If the additional ground for refusal of registration is ultimately made final, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. Specifically, the Board will issue an order allowing applicant 60 days from the date of the order in which to file a supplemental brief directed (solely) to the additional ground for refusal of registration. See 37 CFR §2.142(f)(3).

If applicant fails to file a supplemental brief within the specified 60-day period, or during an extension of time for the purpose, the appeal may be dismissed. See 37 CFR §2.142(f)(3). If applicant files a supplemental brief, the Board will send the application file, with applicant's supplemental brief entered therein, to the Examining Attorney. Within 60 days after the date of the Board's written action

OLD EDITION

forwarding the file to the Examining Attorney, or within an extension of time for the purpose, the Examining Attorney must file a written brief answering the supplemental brief of the applicant. The Examining Attorney must also mail a copy of his or her brief to the applicant. See 37 CFR §2.142(f)(4). If the Examining Attorney's brief is late filed, it may be excluded by the Board in the absence of an adequate explanation for the late filing. Cf. In re Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, 223 USPQ 188 (TTAB 1984), and TBMP §1203.02(b). Within 20 days from the mailing date of the Examining Attorney's brief, or within an extension of time for the purpose, the applicant may, if it so desires, file a reply brief. See 37 CFR §2.142(f)(4). However, the filing of a reply brief is not mandatory. If the applicant files a reply brief, a copy thereof will be forwarded by the Board to the Examining Attorney.

If an oral hearing on the appeal had been requested by applicant prior to the remand of the application, but had not yet been held, the oral hearing will be set after the expiration of applicant's time for filing a reply brief directed to the additional ground for refusal of registration. See 37 CFR §2.142(f)(5). If an oral hearing had been held prior to the remand, or had not previously been requested by applicant, an oral hearing may be requested by applicant by separate paper filed not later than 10 days after the due date for a reply brief on the additional ground for refusal of registration; the oral hearing will be set by the Board upon receipt of the request. See 37 CFR §2.142(f)(5).

If the Examining Attorney is persuaded by applicant's supplemental brief and/or reply brief that the additional ground for refusal of registration should be withdrawn, the Examining Attorney should issue a written action withdrawing the additional ground, and return the application to the Board for resumption of proceedings with respect to the appeal.

The Examining Attorney may not, upon remand under 37 CFR §2.142(f)(1), refuse registration on a new ground not specified in the Board's remand letter. If the Examining Attorney, upon remand, wishes to refuse registration on a new ground not specified in the Board's remand letter, the Examining Attorney must file a request with the Board, pursuant to 37 CFR §2.142(f)(6), for jurisdiction to refuse registration on the new ground.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP §1207.05.

OLD EDITION

1209.02 Upon Request by Trademark Examining Attorney

37 CFR §2.142(f)(6) If, during an appeal from a refusal of registration, it appears to the examiner that an issue not involved in the appeal may render the mark of the appellant unregistrable, the examiner may, by written request, ask the Board to suspend the appeal and to remand the application to the examiner for further examination. If the request is granted, the examiner and appellant shall proceed as provided by §§2.61, 2.62, 2.63 and 2.64. After the additional ground for refusal of registration has been withdrawn or made final, the examiner shall return the application to the Board, which shall resume proceedings in the appeal and take further appropriate action with respect thereto.

If, during an ex parte appeal to the Board, it appears to the Trademark Examining Attorney that an issue not involved in the appeal may render the mark of the applicant unregistrable, the Examining Attorney may file a written request with the Board to suspend the appeal and remand the application for further examination. See 37 CFR §2.142(f)(6). See also In re Wells Fargo & Co., 231 USPQ 116, 119 (TTAB 1986); In re Wells Fargo & Co., 231 USPQ 95, 101 (TTAB 1986); and In re Texsun Tire and Battery Stores, Inc., 229 USPQ 227, 228 (TTAB 1986) (NOTE: the cited cases were decided prior to the adoption of 37 CFR §2.142(f)(6)).

If the Examining Attorney's request for remand is granted, the application will be forwarded by the Board to the Examining Attorney for further examination in accordance with the request. In its action granting the request, the Board will allow the Examining Attorney a specified time in which to issue an Office action pursuant to the request. Thereafter, the Examining Attorney and applicant should proceed as provided in 37 CFR §§2.61 through 2.64. See 37 CFR §2.142(f)(6). Cf. 37 CFR §2.142(f)(3).

When, upon remand, the Examining Attorney either determines that registration should not be finally refused on the additional ground for refusal of registration mentioned in the request for remand, or issues a final refusal to register on that ground, the six-month response clause should be omitted from the paper in which such action is taken; the file of the case should be returned to the Board; proceedings with respect to the appeal will be resumed; and further appropriate action will be taken therein. See 37 CFR §2.142(f)(6). See also, for information

OLD EDITION

as to the further action taken by the Board, i.e., for information concerning the filing of supplemental briefs, and a request for oral hearing, TBMP §1209.01.

The Examining Attorney may not, upon remand under 37 CFR §2.142(f)(6), refuse registration on a new ground not mentioned in the Examining Attorney's request for remand. If the Examining Attorney, upon remand, wishes to refuse registration on a new ground not mentioned in the request for remand, the Examining Attorney must file a new request with the Board for jurisdiction to refuse registration on the new ground.

For information concerning the submission of new evidence after remand for refusal of registration on an additional ground, see TBMP §1207.05.

OLD EDITION

1209.03 Upon Granted Letter of Protest

A third party which has knowledge of facts bearing upon the registrability of a mark in a pending application may bring such information to the attention of the PTO by filing, with the Director of the Trademark Examining Groups, a "letter of protest," that is, a letter which recites the facts and which is accompanied by supporting evidence. The Director will determine whether the information should be given to the Trademark Examining Attorney for consideration. See TBMP §215, and authorities cited therein.

Proceedings in an ex parte appeal will not be suspended pending determination by the Director of a letter of protest. However, if a letter of protest is granted during the pendency of an ex parte appeal, and the Examining Attorney, having considered the supporting evidence submitted with the letter of protest, believes that an issue not involved in the appeal may render the mark of the applicant unregistrable, the Examining Attorney may file a written request with the Board, pursuant to 37 CFR §2.142(f)(6), to suspend the appeal and remand the application for further examination.

For information concerning requests for remand for a new refusal or new requirement, and the further proceedings in the case if such a request is granted by the Board, see 37 CFR §2.142(f)(6), and TBMP §1209.02.

1210 Approval for Publication During Appeal

The Trademark Examining Attorney may withdraw an appealed refusal to register, and approve the involved application for publication (or for registration, in the case of a Supplemental Register application), at any time prior to issuance of the Board's decision in the case. See TMEP §1501.03. See also, for example, TBMP §§1203.02(b), 1203.02(c), 1204, 1205, and 1207.02. When the Examining Attorney does so, the appeal becomes moot.

However, the Examining Attorney should notify the Board (by telephoning the Board's administrator) that the application is being approved for publication (or registration), so that the Board's records may be amended to reflect the disposition of the application. The Examining Attorney should also notify the applicant. See TMEP §1501.03.

1211 Abandonment During Appeal

37 CFR §2.68 Express abandonment (withdrawal) of application.
An application may be expressly abandoned by filing in the Patent and Trademark Office a written statement of abandonment or withdrawal of the application signed by the applicant, or the attorney or other person representing the applicant. Except as provided in §2.135, the fact that an application has been expressly abandoned shall not, in any proceeding in the Patent and Trademark Office, affect any rights that the applicant may have in the mark which is the subject of the abandoned application.

During an ex parte appeal to the Board, the applicant may expressly abandon its involved application by filing in the PTO a written statement of abandonment or withdrawal of the application. The abandonment or withdrawal must be signed by the applicant or its attorney or other authorized representative. See 37 CFR §2.68.

The express abandonment, during an ex parte appeal to the Board, of the applicant's involved application will not, in any proceeding in the PTO, affect any rights that the applicant may have in the mark which is the subject of the abandoned application. See 37 CFR §2.68. See also Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812, 2 USPQ2d 1264 (1st Cir. 1987). Cf. (re preclusive effect of prior final judgment arising out of an ex parte case) In

OLD EDITION

re Honeywell Inc., 8 USPQ2d 1600 (TTAB 1988); Flowers Industries Inc. v. Interstate Brands Corp., 5 USPQ2d 1580 (TTAB 1987); and Lukens Inc. v. Vesper Corp., 1 USPQ2d 1299 (TTAB 1986), aff'd, Vesper Corp. v. Lukens Inc., 831 F.2d 306 (Fed. Cir. 1987).

In contrast, after the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of its involved application or mark without the written consent of every adverse party to the proceeding, judgment will be entered against the applicant. See 37 CFR §2.135, and TBMP §§602.01 and 603.

1212 Cancellation or Assignment of Cited Registration

Often, in an ex parte appeal to the Board, the asserted ground (or one of the asserted grounds) for refusal of registration is the Section 2(d), 15 U.S.C. §1052(d), ground that applicant's mark so resembles a mark registered in the PTO as to be likely, when used on or in connection with the goods or services of the applicant, to cause confusion, or to cause mistake, or to deceive.

If, during the pendency of an ex parte appeal involving a refusal to register under Section 2(d) of the Act, the cited registration is cancelled, or is assigned to the applicant, the appeal will be moot insofar as that issue is concerned. If the refusal to register on the basis of the cancelled or assigned registration is the only issue involved in the appeal, the Board will dismiss the appeal as moot, and the application will be sent to the Trademark Examining Attorney for approval for publication (or for registration, in the case of a Supplemental Register application). If the appeal involves additional issues, it will go forward solely on the additional issues.

When an application has been rejected under Section 2(d) of the Act, and the refusal to register has been appealed to the Board, it is recommended that the applicant periodically check the status of the cited registration. If the applicant learns that the registration has expired or been cancelled, the applicant should immediately notify the Board thereof. Similarly, if the registration is assigned to applicant, the applicant should immediately notify the Board thereof.

OLD EDITION

1213 Suspension of Appeal

Prior to the issuance of the Board's decision in an ex parte appeal, proceedings with respect to the appeal may be suspended by the Board upon written request by applicant showing good cause for the requested suspension. Cf. 37 CFR §2.117, and TBMP §510. Examples of situations in which the Board may suspend proceedings in an appeal, at the request of the applicant, are listed below:

(1) Applicant is involved in a civil action, or a Board inter partes proceeding, which may be dispositive of the issue(s) involved in the appeal--Board may suspend pending final determination of the civil action or Board inter partes proceeding.

(2) Another application which involves the same issue is also on appeal to the Board--Board may suspend pending final determination of the appeal in the other application.

(3) A registration cited as a reference, under Section 2(d) of the Act, 15 U.S.C. §1052(d), against applicant's mark is due, or will soon be due, for an affidavit of continued use (or excusable nonuse) under Section 8 of the Act, 15 U.S.C. §1058, or for an application for renewal under Section 9 of the Act, 15 U.S.C. §1059--Board may suspend pending determination of whether registration will continue in existence or will, instead, be cancelled under Section 8 or expire under Section 9.

A request for suspension of proceedings before the Board in an ex parte appeal must be filed prior to the issuance of the Board's final decision in the case. For example, an applicant which has appealed a refusal to register under Section 2(d) of the Act (i.e., a refusal to register on the ground that applicant's mark so resembles a registered mark as to be likely to cause confusion) may not wait until it receives the Board's decision on appeal and then, if the decision is adverse, file a petition to cancel the cited registration and request suspension of proceedings in the appeal pending the final determination of the cancellation proceeding. See In re Vycom Electronics Ltd., 21 USPQ2d 1799 (Comm'r 1986).

When proceedings have been suspended, at the request of the applicant, in an ex parte appeal to the Board, and the event for which proceedings have been suspended occurs, as, for example, when a civil action for which proceedings have been suspended has been finally determined, the applicant should file a paper notifying the Board thereof and requesting that further appropriate action be taken in the appeal.

OLD EDITION

Proceedings in an ex parte appeal may also be suspended by the Board during remand to the Examining Attorney, as, for example, during remand for (1) consideration of an amendment to the application, or (2) consideration of a request for reconsideration of a final action, or (3) assertion of a new ground of refusal, or (4) submission of additional evidence. See TBMP §§1202.02; 1203.02(a); 1203.02(b); 1204; 1205; 1206.01; 1207.02; 1207.06; and 1209.

1214 Consolidation

When an applicant has filed an ex parte appeal to the Board in two or more copending applications, and the cases involve common issues of law or fact, the Board, upon request by the applicant or Trademark Examining Attorney or upon its own initiative, may order the consolidation of the cases for purposes of briefing, oral hearing, and/or final decision. See, for example, In re Pebble Beach Co., 19 USPQ2d 1687 (TTAB 1991); In re Del E. Webb Corp., 16 USPQ2d 1232 (TTAB 1990); In re Anton/Bauer Inc., 7 USPQ2d 1380 (TTAB 1988); In re Weber-Stephen Products Co., 3 USPQ2d 1659 (TTAB 1987); In re Petersen Manufacturing Co., 2 USPQ2d 2032 (TTAB 1987); In re Le Sorbet, Inc., 228 USPQ 27 (TTAB 1985); In re San Diego National League Baseball Club, Inc., 224 USPQ 1067 (TTAB 1983); In re 1776, Inc., 223 USPQ 186 (TTAB 1984); In re Canadian Pacific Ltd., 222 USPQ 533 (TTAB 1984), aff'd, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985); In re Wallyball, Inc., 222 USPQ 87 (TTAB 1984); and In re Armour & Co., 220 USPQ 76 (TTAB 1983). Cf. FRCP 42(a), and TBMP §511.

Although cases consolidated prior to briefing may be presented on the same brief, they do not have to be. The applicant (and/or the Examining Attorney) may file a different brief in each case, if the applicant (and/or the Examining Attorney) so desires. When consolidated cases are to be presented on the same brief, the brief should bear the serial number of each consolidated application, and a copy of the brief should be submitted for each application.

1215 Alternative Positions

Just as the Trademark Examining Attorney may refuse registration on alternative grounds (such as, that applicant's mark, as applied to its goods and/or services, is

OLD EDITION

either merely descriptive or deceptively misdescriptive of them within the meaning of Section 2(e)(1) of the Act, 15 U.S.C. §1052(e)(1)), so, too, the applicant may, in appropriate cases, take alternative positions with respect to a refusal to register. For example, where registration has been refused on the ground that applicant's mark, as applied to its goods and/or services, is merely descriptive of them, applicant may take the position that its mark is not merely descriptive, and, alternatively, assert a claim, under the provisions of Section 2(f) of the Act, 15 U.S.C. §1052(f), that its mark has become distinctive of its goods and/or services in commerce. See, for example, In re E S Robbins Corp., 30 USPQ2d 1540 (TTAB 1992); In re Analog Devices Inc., 6 USPQ2d 1808 (TTAB 1988), aff'd, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989); In re Engineering Systems Corp., 2 USPQ2d 1075 (TTAB 1986); In re Seaman & Associates Inc., 1 USPQ2d 1657 (TTAB 1986); In re Professional Learning Centers, Inc., 230 USPQ 70 (TTAB 1986); In re American Home Products Corp., 226 USPQ 327 (TTAB 1985); In re Lillian Vernon Corp., 225 USPQ 213 (TTAB 1985); In re Narwood Productions, Inc., 223 USPQ 1034 (TTAB 1984); In re Anania Associates, Inc., 223 USPQ 740 (TTAB 1984); In re Perfect Fit Industries, Inc., 223 USPQ 92 (TTAB 1984); In re House of Windsor, Inc., 221 USPQ 53 (TTAB 1983); In re Capital Formation Counselors, Inc., 219 USPQ 916 (TTAB 1983); In re Harrington, 219 USPQ 854 (TTAB 1983), and TMEP §1212.02(c). Cf. FRCP 8(e)(2), and TBMP §§312.03 and 318.02(b).

When an applicant asserts alternative positions, and is not willing to accept registration on the basis of its "fallback" position unless the Board determines, on appeal, that applicant's primary position is not well taken, the applicant should make its wishes clear both to the Examining Attorney and to the Board. For example, when applicant, in response to a refusal on the ground of mere descriptiveness, has asserted alternatively that its mark is not merely descriptive and that the mark has become distinctive in commerce, but applicant is not willing to accept a registration issued under Section 2(f) on the basis of the claim of distinctiveness unless the Board holds, on appeal from the refusal to register, that the mark is merely descriptive, applicant should clearly so state. Otherwise, if the Examining Attorney finds applicant's claim of distinctiveness to be persuasive (and there is no other outstanding ground for refusal to register), the Examining Attorney will approve the application for publication on that basis, and any registration issued to applicant will be issued under the provisions of Section 2(f) of the Act.

If, in an application which is the subject of an ex parte appeal to the Board, the applicant has asserted alternative positions (such as, that its mark is not merely

OLD EDITION

descriptive of its goods and/or services, and that the mark has, in any event, become distinctive of its goods and/or services in commerce; or that its mark has become distinctive of its goods and/or services in commerce, and that the mark is, in any event, registrable on the Supplemental Register), the Examining Attorney should clearly state his or her position with respect to each of applicant's alternative claims. See TMEP §1212.02(c).

1216 Oral Hearing

37 CFR §2.142(e)(1) If the appellant desires an oral hearing, a request therefor should be made by a separate notice filed not later than ten days after the due date for a reply brief. Oral argument will be heard by at least three Members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing, which may be reset if the Board is prevented from hearing the argument at the specified time or, so far as is convenient and proper, to meet the wish of the appellant or his attorney or other authorized representative.

(2) If the appellant requests an oral argument, the examiner who issued the refusal of registration or the requirement from which the appeal is taken, or in lieu thereof another examiner from the same examining division as designated by the supervisory attorney thereof, shall present an oral argument. If no request for an oral hearing is made by the appellant, the appeal will be decided on the record and briefs.

(3) Oral argument will be limited to twenty minutes by the appellant and ten minutes by the examiner. The appellant may reserve part of the time allowed for oral argument to present a rebuttal argument.

OLD EDITION

For general information concerning oral hearings in proceedings before the Board, see TBMP §802. What follows below is information pertaining specifically to oral hearings in ex parte appeals to the Board.

An oral hearing is not mandatory in an ex parte appeal to the Board, but will be scheduled if a timely request therefor is filed by the applicant. See 37 CFR §2.142(e)(1). If the applicant does not request an oral hearing, the appeal will be decided on the record and briefs. See 37 CFR §2.142(e)(2). An oral hearing is particularly useful in ex parte cases involving complex issues, or where an issue on appeal is not clearly defined. In addition, the oral hearing sometimes provides

an opportunity for the applicant and Trademark Examining Attorney to work out an agreement that results in approval of the application for publication (or for registration, in the case of a Supplemental Register application).

If the applicant desires an oral hearing in an ex parte appeal to the Board, the applicant should file a written request therefor, by separate paper, not later than 10 days after the due date for the applicant's reply brief. When a proper request for an oral hearing has been filed by the applicant, the Board sets the date and time for the hearing, and sends the applicant a notice of hearing specifying the date, time, and location of the hearing. The hearing will be set for a time which is convenient for both the applicant and the Examining Attorney, and will be held at the offices of the Board, before at least three Board members (i.e., administrative trademark judges). The time for oral hearing may be reset if the Board is prevented from holding the hearing at the specified time, or, so far as is convenient and proper, to meet the wishes of the applicant (or the applicant's attorney or other authorized representative) or the Examining Attorney. See 37 CFR §2.142(e)(1).

If the applicant requests an oral hearing, the Examining Attorney who issued the Office action from which the appeal was taken, or another Examining Attorney from the same PTO law office who has been designated for the purpose by the managing attorney of that law office, must appear at the hearing and present an oral argument. See 37 CFR §2.142(e)(2).

The applicant is allowed 20 minutes for its oral argument, and the Examining Attorney is allowed 10 minutes. If the applicant so desires, it may reserve a portion of its 20 minutes to use for rebuttal argument. See 37 CFR §2.142(e)(3). There is no requirement that the applicant and the Examining Attorney use all of their allotted time. Often, an ex parte appeal to the Board is of such nature that oral arguments thereon may be presented in considerably less than the allotted time. On the other hand, if, because of the complexity or novelty of the issues, an applicant feels that it needs more than 20 minutes for oral argument, it should file a written request with the Board for additional time. Cf. 37 CFR §2.129(a), and TBMP §802.05. If the request is granted, the Examining Attorney will also be allowed additional time.

For information concerning audiotaping, visual aids, and the nature of an oral hearing before the Board, see TBMP §§802.06, 802.07, and 802.08, respectively.

OLD EDITION

1217 Final Decision

For general information concerning final decisions in proceedings before the Board, see TBMP §803. What follows below is information pertaining specifically to final decisions in ex parte appeals to the Board.

In determining an ex parte appeal, the Board reviews the appealed decision of the Trademark Examining Attorney to determine if it was correctly made. The Board need not find that the Examining Attorney's rationale was correct in order to affirm the refusal to register, but rather may rely on a different rationale. See In re AFG Industries Inc., 17 USPQ2d 1162 (TTAB 1990); In re Avocet, Inc., 227 USPQ 566 (TTAB 1985); and In re D.B. Kaplan Delicatessen, 225 USPQ 342 (TTAB 1985). Cf. Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988); Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 188 USPQ 485 (CCPA 1976); and Hunt v. Treppschuh and Hentrich, 523 F.2d 1386, 187 USPQ 426 (CCPA 1975). Thus, while the Examining Attorney may not raise a new ground for refusal of registration during appeal, except upon remand by the Board for the purpose (see TBMP §1209), the Examining Attorney is not precluded from raising, during appeal, new arguments and/or additional case citations in support of a ground for refusal which was timely raised and is a subject of the appeal. See In re D.B. Kaplan Delicatessen, supra.

When the Board has issued its final decision in an ex parte appeal, the Examining Attorney is without jurisdiction to take any further action therein. See, for example, In re Hamilton Bank, 222 USPQ 174 (TTAB 1984); In re Mercedes Slacks, Ltd., 213 USPQ 397 (TTAB 1982); and TMEP §1501.05. Similarly, the Board has no authority, either in its final decision on appeal or thereafter, to remand the case to the Examining Attorney for further examination. A case which has been considered and decided on appeal to the Board may be reopened only as provided in 37 CFR §2.142(g). See In re Johanna Farms, Inc., 223 USPQ 459 (TTAB 1984), and In re Mercedes Slacks, Ltd., supra. That is, while the Board, in its final decision in an opposition, concurrent use, or interference proceeding, may include a remand to the Examining Attorney for further examination with respect to a matter which appears to render the mark of an applicant unregistrable but which was not tried under the pleadings in the case (see 37 CFR §2.131, and TBMP §515), the Board cannot include such a remand in its final decision in an ex parte appeal.

OLD EDITION

However, if, at final decision in an ex parte appeal, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may, without deciding the issue(s) on appeal, suspend the appeal and remand the application to the Examining Attorney for further examination. See 37 CFR §2.142(f)(1), and TBMP §1209.01. Alternatively, if the issue not previously raised is an application defect which can easily be corrected by the applicant, the Board may elect to decide the issue(s) on appeal, and include in its decision a recommendation that applicant voluntarily correct the defect if it prevails on the appealed issue(s). See In re Lativ Systems, Inc., 223 USPQ 1037 (TTAB 1984), and In re Wallyball, Inc., 222 USPQ 87 (TTAB 1984).

1218 Reopening (Amendment, etc., After Final Decision)

37 CFR §2.142(g) An application which has been considered and decided on appeal will not be reopened except for the entry of a disclaimer under section 6 of the Act of 1946 or upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only upon a showing of sufficient cause for consideration of any matter not already adjudicated.

Once an application has been considered and decided by the Board on appeal, applicant's course of action normally is limited to a request for reconsideration of the Board's decision, and/or the filing of an appeal therefrom (either by way of an appeal to the Court of Appeals for the Federal Circuit, or by way of a civil action seeking review of the Board's decision). See TBMP §1219. An application may not be "reopened," that is, an applicant may not amend its application, or submit additional evidence, at this stage, except in two very limited situations. See 37 CFR §2.142(g); In re Hines, 32 USPQ2d 1376 (TTAB 1994); and In re Bercut-Vandervoort & Co., 229 USPQ 763 (TTAB 1986). They are as follows:

(1) The application may be reopened by the Board for entry of a disclaimer under Section 6 of the Act, 15 U.S.C. §1056. See 37 CFR §2.142(g); In re Petite Suites Inc., 21 USPQ2d 1708 (Comm'r 1991) (Board has authority to remand application, after decision by Board on appeal, for entry of a disclaimer); and In re S. D. Fabrics, Inc., 223 USPQ 56 (TTAB 1984) (Board accepts disclaimers after decision by Board on appeal where the disclaimer puts the application in condition for publication without the need for any further examination); and

(2) The application may be reopened upon order of the Commissioner, but a petition to the Commissioner to reopen an application will be considered only

OLD EDITION

upon a showing of sufficient cause for consideration of any matter not already adjudicated. See 37 CFR §2.142(g); In re Vycom Electronics Ltd., 21 USPQ2d 1799 (Comm'r 1986) (petition to reopen to allow applicant to file and litigate petition to cancel cited registration denied); In re Vesper Corp., 8 USPQ2d 1788 (Comm'r 1988) (petitions to reopen are granted only when proposed amendment would place application in condition for publication, subject to updating search, and no other examination by Trademark Examining Attorney would be required); In re Taverniti, SARL, 228 USPQ 975 (TTAB 1985) (since applicant's registration was not part of evidentiary record before Board when it decided case, registration can be given no consideration in the absence of a successful petition to the Commissioner to reopen); In re Taverniti, SARL, 225 USPQ 1263 (TTAB 1985) (it has been practice of the Commissioner to refuse to reopen, after final decision, for amendment to the Supplemental Register); In re Johanna Farms, Inc., 223 USPQ 459 (TTAB 1984) (Board has no jurisdiction to remand an application, after final decision, for submission of new evidence; only Commissioner has authority, after final decision, to remand for the purpose of reopening the application); In re S. D. Fabrics, Inc., 223 USPQ 56 (TTAB 1984) (Board cannot accept an amendment to the Supplemental Register after a case has been decided on appeal; such an amendment may be accepted only by the Commissioner upon petition, and Commissioner has in past denied petitions to reopen to amend to the Supplemental Register); In re Dodd International, Inc., 222 USPQ 268 (TTAB 1983) (Board denies request to reopen application, after final decision, for amendment to Supplemental Register, quoting 37 CFR §2.142(g)); In re Mack Trucks, Inc., 189 USPQ 642 (Comm'r 1976) (petition to reopen for letter of consent and for amendment of identification of goods denied; applicant, having elected to proceed, prior to Board's decision, without letter of consent assumed the risk of an adverse decision by Board and does not establish sufficient cause to reopen; also, both the letter of consent and amendment would require further examination beyond an updating search); In re Hickory Manufacturing Co., 183 USPQ 789 (Comm'r 1974) (petition to reopen for disclaimer granted because subject only to updating search, mark would be ready for publication upon entry of disclaimer; no other examination by the Examining Attorney would be required--NOTE: this petition was filed under an earlier version of what is now 37 CFR §2.142(g); the earlier version did not provide for reopening by the Board for a disclaimer); and Ex parte Simoniz Co., 161 USPQ 365 (Comm'r 1969) (petition to reopen for amendment to Supplemental Register denied; applicant elected a course of action and had a hearing and an adjudication thereon); and TMEP §1501.05.

OLD EDITION

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence. See In re Lowrance Electronics Inc., 14 USPQ2d 1251 (TTAB 1989).

1219 Review of Final Decision

1219.01 By Request for Reconsideration

37 CFR §2.144 Reconsideration of decision on ex parte appeal.
Any request for rehearing or reconsideration, or modification of the decision, must be filed within one month from the date of the decision. Such time may be extended by the Trademark Trial and Appeal Board upon a showing of sufficient cause.

For general information concerning requests for rehearing, reconsideration, or modification of a final decision of the Board, see TBMP §544. What follows below is information pertaining specifically to requests for rehearing, reconsideration, or modification of a final decision of the Board in an ex parte appeal.

An applicant which has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may file a request for rehearing, reconsideration, or modification of the decision. The request must be filed by the applicant within one month from the date of the decision. The time for filing the request may be extended by the Board upon a showing of sufficient cause. See 37 CFR §2.144.

The Board may also rehear, reconsider, or modify its final decision, in an ex parte appeal, at the request of the Trademark Examining Attorney. See In re Ferrero S.p.A., 22 USPQ2d 1800 (TTAB 1992), recon. denied, 24 USPQ2d 1061 (TTAB 1992). The request must be filed by the Examining Attorney within one month of the date of the final decision, unless the time is extended by the Board upon a showing of sufficient cause. See In re Ferrero S.p.A., 24 USPQ2d 1061 (TTAB 1992).

OLD EDITION

If a request for rehearing, reconsideration, or modification of the Board's final decision in an ex parte appeal is timely filed, applicant's time for filing an appeal, or for commencing a civil action for review of the Board's decision, will expire two months after action on the request. See 37 CFR §2.145(d)(1).

1219.02 By Appeal

An applicant which has filed an ex parte appeal to the Board, received a final decision therein from the Board, and is dissatisfied with that decision, may have remedy by way of an appeal to the United States Court of Appeals for the Federal Circuit, or by way of a civil action for review of the decision of the Board. Section 21 of the Act, 15 U.S.C. §1071, and 37 CFR §2.145. For information concerning the taking of an appeal from a final decision of the Board, see TBMP §§901-904.

When a decision of the Board affirming a refusal to register in an ex parte case has been appealed to the United States Court of Appeals for the Federal Circuit, the Court, during the pendency of the appeal, may remand the application for further examination and the submission of additional evidence. See TBMP §1218.

OLD EDITION

APPENDIX

Format 1 Suggested Format for Ex parte Appeal From Trademark Examining Attorney to Trademark Trial and Appeal Board

Format 2 Suggested Format for Notice of Opposition

Format 3 Suggested Format for Petition to Cancel

Format 4 Suggested Format for Certificate of Mailing Under 37 CFR §1.8

Format 5 Suggested Format for Certificate of Transmission Under 37 CFR §1.8

Format 6 Suggested Format for Certificate of Mailing by "Express Mail" Under 37 CFR §1.10

Format 7 Suggested Format for Designation of Domestic Representative

OLD EDITION

APPENDIX

Format 1 Suggested Format for Ex Parte Appeal From Trademark Examining Attorney to Trademark Trial and Appeal Board

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

.....
(Name of applicant)
.....
(Serial Number of application)
.....
(Filing date of application)
.....
(Mark)

OLD EDITION

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.(1)

By.....
(Signature)(2)
.....
(Identification of person signing)(3)

FOOTNOTES

(1) The required fee must be submitted for each class for which an appeal is taken. If an appeal is taken for fewer than the total number of classes in the application, the classes in which the appeal is taken should be specified.
(2) The notice of appeal may be signed by the applicant or by the applicant's attorney or other authorized representative. If an applicant signing for itself is a partnership, the signature must be made by a partner; if an applicant signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(3) State the capacity in which the signing individual signs, e.g., attorney for applicant, applicant (if applicant is an individual), partner of applicant (if applicant is a partnership), officer of applicant identified by title (if applicant is a corporation), etc.

OLD EDITION

Format 2 Suggested Format for Notice of Opposition

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark application Serial No.....
Filed.....
For the mark.....
Published in the Official Gazette on.....
(Date)

.....
(Name of opposer)
v.
.....
(Name of applicant)

Opposition No. .....
(To be inserted by Patent & Trademark Office)

OLD EDITION

NOTICE OF OPPOSITION

(State opposer's name, address, and entity information)(1)

.....
(Name of individual as opposer, and business trade name, if any)
.....
(Business address)
OR.....
(Name of partnership as opposer)
.....
(Names of partners)
.....
(Business address of partnership)
OR.....
(Name of corporation as opposer)
.....
(State or country of incorporation)

.....
(Business address of corporation)

The above-identified opposer believes that it/he/she will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.(2)

The grounds for opposition are as follows:(3)

By.....
(Signature)(4)
.....
(Identification of person signing)(5)

FOOTNOTES

(1) If opposer is an individual, state the opposer's name, business trade name, if any, and business address. If opposer is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If opposer is a corporation, state the name of the corporation, the state (or country, if opposer is a foreign corporation) of incorporation, and the business address of the corporation. If opposer is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

(2) The required fee must be submitted for each party joined as opposer for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.

(3) Set forth a short and plain statement here showing why the opposer believes it/he/she would be damaged by the registration of the opposed mark, and state the grounds for opposing.

(4) The opposition need not be verified, and may be signed by the opposer or by the opposer's attorney or other authorized representative. If an opposer signing for itself is a partnership, the signature must be made by a partner; if an opposer signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for opposer, opposer (if opposer is an individual), partner of opposer (if opposer is a partnership), officer of opposer identified by title (if opposer is a corporation), etc.

OLD EDITION

REPRESENTATION INFORMATION

If the opposer is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the opposer wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

OLD EDITION

Format 3 Suggested Format for Petition to Cancel

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark Registration
No.....
For the mark.....
Date
registered.....

.....
(Name of petitioner)
v.
.....
(Name of registrant)

Cancellation No. .....
(To be inserted by Patent & Trademark Office)

PETITION TO CANCEL
(State petitioner's name, address, and entity information)(1)

.....
(Name of individual as petitioner, and business trade name, if any)
.....
(Business address)
OR.....
(Name of partnership as petitioner)
.....
(Names of partners)
.....
(Business address of partnership)
OR.....
(Name of corporation as petitioner)
.....
(State or country of incorporation)
.....
(Business address of corporation)

OLD EDITION

To the best of petitioner's knowledge, the name and address of the current owner of the registration are.....
.....

The above-identified petitioner believes that it/he/she will be damaged by the above-identified registration, and hereby petitions to cancel the same.(2)

The grounds for cancellation are as follows:(3)

By.....
(Signature)(4)
.....
(Identification of person signing)(5)

FOOTNOTES

(1) If petitioner is an individual, state the petitioner's name, business trade name, if any, and business address. If petitioner is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If petitioner is a corporation, state the name of the corporation, the state (or country, if petitioner is a foreign corporation) of incorporation, and the business address of the corporation. If petitioner is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

(2) The required fee must be submitted for each party joined as petitioner for each class sought to be cancelled, and if cancellation is sought for fewer than the total number of classes in the registration, the classes sought to be cancelled should be specified.

(3) Set forth a short and plain statement here showing why the petitioner believes it/he/she would be damaged by the registration, and state the grounds for cancellation.

(4) The petition need not be verified, and may be signed by the petitioner or by the petitioner's attorney or other authorized representative. If a petitioner signing for itself is a partnership, the signature must be made by a partner; if a petitioner signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for petitioner, petitioner (if petitioner is an individual), partner of petitioner (if petitioner is a partnership), officer of petitioner identified by title (if petitioner is a corporation), etc.

OLD EDITION

REPRESENTATION INFORMATION

If the petitioner is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the petitioner wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.

OLD EDITION

Format 4 Suggested Format for Certificate of Mailing by First-Class Mail Under 37 CFR §1.8

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

on _____ _____
Date Signature

_____
Typed or printed name of person signing certificate .

OLD EDITION

Format 5 Suggested Format for Certificate of Transmission Under 37 CFR §1.8

Certificate of Transmission

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on _____
Date

_____
Signature

_____
Typed or printed name of person signing certificate .

.

OLD EDITION

Format 6 Suggested Format for Certificate of Mailing by "Express Mail" Under 37 CFR §1.10

Certificate of Mailing by "Express Mail"

"Express Mail" mailing label number _____

I hereby certify that this correspondence is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on _____.
Date

_____
Signature of person mailing correspondence

_____
Typed or printed name of person mailing correspondence

OLD EDITION

Format 7 Suggested Format for Designation of Domestic Representative

Designation of Domestic Representative

(Name of domestic representative), whose postal address is _____

_____,

is hereby designated (Name of designating party)'s representative upon whom notice or process in this proceeding may be served.

_____

(Signature of designating party)

_____

(Identification of person signing)

_____

(Date of signature)

OLD EDITION

TABLE OF CASES CITED

A. H. Robins Co. v. Evsco Pharmaceutical Corp., 190 USPQ 340 (TTAB 1976)--710

A-1-A Corp. v. The Gillette Co., 199 USPQ 118 (TTAB 1978)--313

Abbott Laboratories v. Tac Industries, Inc., 217 USPQ 819 (TTAB 1981)--706.02; 712.01

ABC Moving Co. v. Brown, 218 USPQ 336 (TTAB 1983)--507.03(b)

Abolio y Rubio S.A.C.I. y G., In re, 24 USPQ2d 1152 (TTAB 1992)--1201.02; 1205

Abraham's Seed v. John One Ten, 1 USPQ2d 1230 (TTAB 1986)--602.02(b)

Acme Boot Co. v. Tony and Susan Alamo Foundation, Inc., 213 USPQ 591 (TTAB 1980)--703.02(a)

Adolphe Lafont, S.A. v. S.A.C.S.E. Societa Azioni Confezioni Sportive Ellera, S.p.A., 228 USPQ 589 (TTAB 1985)--419

Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc., 988 F.2d 1157, 26 USPQ2d 1038 (Fed. Cir. 1993)--503.02; 503.04

AFG Industries Inc., In re, 17 USPQ2d 1162 (TTAB 1990)--1217

Alabama Board of Trustees v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB 1986)--710; 718.02(b)

Alappat, In re, 33 F.3d 1526, 31 USPQ2d 1545 (Fed. Cir. 1994)--541; 802.04; 803

Alberto-Culver Co. v. F.D.C. Wholesale Corp., 16 USPQ2d 1597 (TTAB 1990)--319.03

Alcan Aluminum Corp. v. Alcar Metals Inc., 200 USPQ 742 (TTAB 1978)--703.02(a)

Alfred Dunhill Ltd., In re, 4 USPQ2d 1383 (Comm'r 1987)--514.03; 1101.02; 1101.03; 1113

Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 124 USPQ 343 (TTAB 1960), rev'd on other grounds, 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962)--502.04

Alfred Dunhill of London, Inc. v. Dunhill Tailored Clothes, Inc., 293 F.2d 685, 130 USPQ 412 (CCPA 1961), cert. denied, 369 U.S. 864, 133 USPQ 702 (1962)-- 1101.03; 1102.02(a)(3); 1102.02(b)

All England Lawn Tennis Club, Ltd. v. Creations Aromatiques, Inc., 220 USPQ 1069 (TTAB 1983)--419

Allegro High Fidelity, Inc. v. Zenith Radio Corp., 197 USPQ 550 (TTAB 1977)--510.02(a); 528.02; 535.02

OLD EDITION

Alliance Manufacturing Co. v. ABH Diversified Products, Inc., 226 USPQ 348 (TTAB 1985)--321

Allied Mills, Inc. v. Kal Kan Foods, Inc., 203 USPQ 390 (TTAB 1979)--308.02(a); 703.03; 704

Allstate Insurance Co. v. DeLibro, 6 USPQ2d 1220 (TTAB 1988)--703.02(b)

Allstate Insurance Co. v. Healthy America Inc., 9 USPQ2d 1663 (TTAB 1988)--407.03

Allstate Life Insurance Co. v. Cuna International, Inc., 169 USPQ 313 (TTAB 1971), aff'd without opinion, 487 F.2d 1407, 180 USPQ 48 (CCPA 1973)--405.01; 534.02; 713.05

Alltrade Inc. v. Uniweld Products Inc., 946 F.2d 622, 20 USPQ2d 1698 (9th Cir. 1991)--416.05; 901.01; 901.02(a); 903.03

Aloe Creme Laboratories, Inc. v. Aloe 99, Inc., 188 USPQ 316 (TTAB 1975)--512.01

Aloe Creme Laboratories, Inc. v. Bonne Bell, Inc., 168 USPQ 246 (TTAB 1970)--703.02(a)

Aloe Creme Laboratories, Inc. v. Johnson Products Co., 183 USPQ 447 (TTAB 1974)--703.02(a)

Aloe Creme Laboratories, Inc. v. Magic of Aloe, Inc., 182 USPQ 45 (Comm'r 1973)--905

Alpha Industries, Inc. v. Alpha Microsystems, 220 USPQ 67 (TTAB 1983)--534.02

Alpha Industries, Inc. v. Alpha Microsystems, 223 USPQ 96 (TTAB 1984)--704

Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank, 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988)--712.01; 712.05; 1109

Amaturo Group, Inc. v. Greater Media, Inc., 201 USPQ 617 (Comm'r 1978)--317.02

Amerace Corp. v. USM Corp., 183 USPQ 506 (TTAB 1974)--402.02; 419; 523.02

American Automobile Ass'n v. AAA Legal Clinic of Jefferson Crooke, P.C., 930 F.2d 1117, 19 USPQ2d 1142 (5th Cir. 1991)--411.04; 525

American Bakeries Co. v. Pan-O-Gold Baking Co., 650 F Supp 563, 2 USPQ2d 1208 (D.Minn. 1986)--510.02(a)

American Crucible Products Co. v. Kenco Engineering Co., 188 USPQ 529 (TTAB 1975)--705.02

American Home Products Corp., In re, 226 USPQ 327 (TTAB 1985)--1215

American Home Products Corp. v. David Kamenstein, Inc., 172 USPQ 376 (TTAB 1971)--509.01

American Hygienic Labs, Inc. v. Tiffany & Co., 228 USPQ 855 (TTAB 1986)--503.03; 507.02

American Manufacturing Co. v. Phase Industries, Inc., 192 USPQ 498 (TTAB 1976)--703.02(a)

OLD EDITION

American Meat Institute v. Horace W. Longacre, Inc., 211 USPQ 712 (TTAB 1981)--528.02; 528.05(a)

American Olean Tile Co., In re, 1 USPQ2d 1823 (TTAB 1986)--101.02; 101.03

American Optical Corp. v. American Olean Tile Co., 168 USPQ 471 (TTAB 1971)--507.02; 507.03(a)

American Optical Corp. v. American Olean Tile Co., 169 USPQ 123 (TTAB 1971)--707; 718.02(b); 718.02(c)

American Optical Corp. v. Atwood Oceanics, Inc., 177 USPQ 585 (Comm'r 1973)--540; 801.03

American Optical Corp. v. Exomet, Inc., 181 USPQ 120 (TTAB 1974)--419

American Rice, Inc. v. H.I.T. Corp., 231 USPQ 793 (TTAB 1986)--704

American Security Bank v. American Security and Trust Co., 571 F.2d 564, 197 USPQ 65 (CCPA 1978)--712.05; 1101.02

American Skein & Foundry Co. v. Stein, 165 USPQ 85 (TTAB 1970)--709; 717

American Society of Oral Surgeons v. American College of Oral & Maxillofacial Surgeons, 201 USPQ 531 (TTAB 1979)--419

American Speech-Language-Hearing Ass'n v. National Hearing Aid Society, 224 USPQ 798 (TTAB 1984)--303.03

American Standard Inc. v. Scott & Fetzer Co., 200 USPQ 457 (TTAB 1978)--703.02(a)

American Vitamin Products Inc. v. DowBrands Inc., 22 USPQ2d 1313 (TTAB 1992)--303.03; 312.03; 403.04; 506.01; 506.02; 509.01

American-International Travel Service, Inc. v. AITS, Inc., 174 USPQ 175 (TTAB 1972)--102.01

AMF Inc. v. American Leisure Products, Inc., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973)--703.02(b)

Amoco Oil Co. v. Amerco, Inc., 201 USPQ 126 (TTAB 1978)--544; 545

AMP Inc. v. Raychem Corp., 179 USPQ 857 (TTAB 1973)--403.02

An Evening at the Trotters, Inc. v. A Nite at the Races, Inc., 214 USPQ 737 (TTAB 1982)--713.12

Analog Devices Inc., In re, 6 USPQ2d 1808 (TTAB 1988), aff'd, 871 F.2d 1097, 10 USPQ2d 1879 (Fed. Cir. 1989)--1215

Anania Associates, Inc., In re, 223 USPQ 740 (TTAB 1984)--703.02(a); 1215

Andersen Corp. v. Therm-O-Shield Int'l, Inc., 226 USPQ 431 (TTAB 1985)--102.01; 412.03; 709

OLD EDITION

Anderson v. Liberty Lobby, Inc., 477 U.S. 242 (1986)--528.01

Andrea Radio Corp. v. Premium Import Co., 191 USPQ 232 (TTAB 1976)--703.02(a); 703.03; 708

Angelica Corp. v. Collins & Aikman Corp., 183 USPQ 378 (TTAB 1974)--523.02

Angelica Corp. v. Collins & Aikman Corp., 192 USPQ 387 (TTAB 1976)--540; 703.02(a); 705.02; 717

Anheuser-Busch, Inc. v. Major Mud & Chemical Co., 221 USPQ 1191 (TTAB 1984)--502.06; 709; 710; 713.12

Anheuser-Busch, Inc. v. Martinez, 185 USPQ 434 (TTAB 1975)--503.02; 507.02; 507.03(a)

Anschuetz & Co., GmbH, In re, 838 F.2d 1362 (5th Cir. 1988)--404.03(c)(2)

Antillian Cigar Corp. v. Benedit Cigar Corp., 218 USPQ 187 (TTAB 1983)--515

Anton/Bauer Inc., In re, 7 USPQ2d 1380 (TTAB 1988)--1214

Appetito Provisions Co., In re, 3 USPQ2d 1553 (TTAB 1987)--1101.02

Application Papers Filed November 12, 1965, In re, 152 USPQ 194 (Comm'r 1966)--202.01; 310.04; 312.01; 509.02

A.R.A. Manufacturing Co. v. Equipment Co., 183 USPQ 558 (TTAB 1974)--535.02; 703.02(a)

Arbrook, Inc. v. La Citrique Belge, Naamloze Vennootschap, 184 USPQ 505 (TTAB 1974)--206.03; 303.05(c); 512.04

Argo & Co. v. Carpetsheen Mfg., Inc., 187 USPQ 366 (TTAB 1975)--206.02; 510.02(a)

Argo & Co. v. Springer, 189 USPQ 581 (TTAB 1976)--206.03; 303.05(c); 512.04

Argo & Co. v. Springer, 198 USPQ 626 (TTAB 1978)--206.03; 303.05(c); 512.04

Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742 (TTAB 1992), summ. judgment granted, in part, 26 USPQ2d 1926 (TTAB 1993)--319.02

Aries Systems Corp. v. World Book Inc., 26 USPQ2d 1926 (TTAB 1993)--318.02(b); 319.03; 514.01

Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd., 175 USPQ 250 (TTAB 1972)--540; 801.02(b)

Arkwright-Boston Manufacturers Mutual Insurance Co. v. Aries Marine Corp., 932 F.2d 442, 19 Fed. R. Serv.3d 1290 (5th Cir. 1991)--528.08

Arman's Systems, Inc. v. Armand's Subway, Inc., 215 USPQ 1048 (TTAB 1982)--308.02(c)(1); 319.03

OLD EDITION

Armour & Co., In re, 220 USPQ 76 (TTAB 1983)--1214

Aromatique Inc. v. Lang, 25 USPQ2d 1359 (TTAB 1992)--602.01

Aruba v. Excelsior Inc., 5 USPQ2d 1685 (TTAB 1987)--303.02; 303.03

Astec Industries, Inc. v. Barber-Greene Co., 196 USPQ 578 (TTAB 1977)--705.02

Atlanta Blue Print Co., In re, 19 USPQ2d 1078 (Comm'r 1990)--206.03; 303.05(c); 512.04

Atwood Vacuum Machine Co. v. Automation Industries, Inc., 181 USPQ 606 (TTAB 1974)--403.02; 414

Autac Inc. v. Viking Industries, Inc., 199 USPQ 367 (TTAB 1978)--711

Autac Inc. v. Walco Systems, Inc., 195 USPQ 11 (TTAB 1977)--527.05

Avedis Zildjian Co. v. D. H. Baldwin Co., 180 USPQ 539 (TTAB 1973)--502.04; 507.02

Avedis Zildjian Co. v. D. H. Baldwin Co., 181 USPQ 736 (Comm'r 1974)--518

Avia Group International Inc. v. Faraut, 25 USPQ2d 1625 (TTAB 1992)--304; 406.03(d); 512.01; 529.01

Avia Group International Inc. v. L.A. Gear California Inc., 853 F.2d 1557, 7 USPQ2d 1548 (Fed. Cir. 1988)--528.01; 528.06

Avocet, Inc., In re, 227 USPQ 566 (TTAB 1985)--1217

Avon Products, Inc. v. MarCon, Ltd., 225 USPQ 977 (TTAB 1985)--502.03

Babies Beat Inc., In re, 13 USPQ2d 1729 (TTAB 1990)--1201.04

Bacardi & Co. v. Ron Castillo, S.A., 178 USPQ 242 (TTAB 1973)--502.04

BAF Industries v. Pro-Specialties, Inc., 206 USPQ 166 (TTAB 1980)--711

Bakers Franchise Corp. v. Royal Crown Cola Co., 404 F.2d 985, 160 USPQ 192 (CCPA 1969)--706.01

Bank America Corp., In re, 229 USPQ 852 (TTAB 1986)--1207.05

Bank of America National Trust & Savings Ass'n v. First National Bank of Allentown, 220 USPQ 892 (TTAB 1984)--602.02(b)

BankAmerica Corp. v. International Travelers Cheque Co., 205 USPQ 1233 (TTAB 1979)--411.01; 525

Bankamerica Corp. v. Invest America, 5 USPQ2d 1076 (TTAB 1987)--303.03; 319.03

OLD EDITION

Barash Co. v. Vitafoam Ltd., 155 USPQ 267 (TTAB 1967), aff'd, 427 F.2d 810, 166 USPQ 88 (CCPA 1970)--703.02(a)

Baroid Drilling Fluids Inc. v. Sun Drilling Products, 24 USPQ2d 1048 (TTAB 1992)--504.02

Baron Phillippe De Rothschild S.A. v. S. Rothschild & Co., 16 UPSQ2d 1466 (TTAB 1990)--406.03(b); 406.03(e); 519

BASF Wyandotte Corp. v. Polychrome Corp., 586 F.2d 238, 200 USPQ 20 (CCPA 1978)--709; 710

Bass Anglers Sportsman Society of America, Inc. v. Bass Pro Lures, Inc., 200 USPQ 819 (TTAB 1978)--545; 601.01; 601.02; 602.01

Bauhaus Designs Canada Ltd., In re, 12 USPQ2d 2001 (TTAB 1989)--1208

Bausch & Lomb Inc. v. Gentex Corp., 200 USPQ 117 (TTAB 1978)--710

Bausch & Lomb Inc. v. Leupold & Stevens Inc., 1 USPQ2d 1497 (TTAB 1986)--528.02

Bayley's Restaurant v. Bailey's of Boston, Inc., 170 USPQ 43 (Comm'r 1971)--905

Beatrice Foods Co., In re, 429 F.2d 466, 166 USPQ 431 (CCPA 1970)--1101.01; 1102.02(a)(2); 1109

Bed & Breakfast Registry, In re, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986)--1207.01

Bee Pollen From England Ltd., In re, 219 USPQ 163 (TTAB 1983)--1207.03

Beech Aircraft Corp. v. Lightning Aircraft Co., 1 USPQ2d 1290 (TTAB 1986)--534.02; 708; 712.01; 718.02(b); 718.03(c)

Beecham Inc. v. Helene Curtis Industries, Inc., 189 USPQ 647 (TTAB 1976)--710

Bekaert Steel Wire Corp. v. S.p.A. Officine Maccaferri Gia' Raffaele Maccaferri & Figli, 196 USPQ 558 (TTAB 1977)--507.03(b)

Bellanca Aircraft Corp. v. Bellanca Aircraft Engineering, Inc., 190 USPQ 158 (TTAB 1976)--507.03(b)

Bercut-Vandervoort & Co., In re, 229 USPQ 763 (TTAB 1986)--1207.02; 1207.03; 1218

Berman Bros. Harlem Furniture Inc., In re, 26 USPQ2d 1514 (TTAB 1993)--1208

Best Western Family Steak House, Inc., In re, 222 USPQ 827 (TTAB 1984)--1204; 1207.01; 1207.02

Big Daddy's Lounges, Inc., In re, 200 USPQ 371 (TTAB 1978)--1201.04

Big Wrangler Steak House, Inc., In re, 230 USPQ 634 (TTAB 1986)--1207.02

Bigfoot 4x4 Inc. v. Bear Foot Inc., 5 USPQ2d 1444 (TTAB 1987)--306; 511; 523.04; 527.05

OLD EDITION

Binney & Smith Inc. v. Magic Marker Industries, Inc., 222 USPQ 1003 (TTAB 1984)--512.01; 512.02; 540; 705.02; 717

Bison Corp. v. Perfecta Chemie B.V., 4 USPQ2d 1718 (TTAB 1987)--402.02; 403.03; 407.01; 409.01; 411.01; 412.02; 412.03; 419; 527.03; 710; 718.02(b)

BL Cars Ltd. v. Puma Industria de Veiculos S/A, 221 USPQ 1018 (TTAB 1983)--705.02; 706.02

Blansett Pharmaceutical Co. v. Carmrick Laboratories Inc., 25 USPQ2d 1473 (TTAB 1992)--528.01; 528.02; 528.06; 528.07(b)

Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann, 231 USPQ 408 (TTAB 1986)--303.02

Bonaventure Associates v. Westin Hotel Co., 218 USPQ 537 (TTAB 1983)--308.02(a)

Bongrain International (American) Corp. v. Moquet Ltd., 230 USPQ 626 (TTAB 1986)--528.01; 528.05(d)

Bonni Keller Collections Ltd., In re, 6 USPQ2d 1224 (TTAB 1987)--1207.01

Bonomo Culture Institute, Inc. v. Mini-Gym, Inc., 188 USPQ 415 (TTAB 1975)--703.02(a)

Books on Tape Inc. v. Booktape Corp., 836 F.2d 519, 5 USPQ2d 1301 (Fed. Cir. 1987)--303.03

Borden, Inc. v. Kerr-McGee Chemical Corp., 179 USPQ 316 (TTAB 1973), aff'd without opinion, 182 USPQ 307 (CCPA 1974)--703.02(a)

Bordenkircher v. Solis Entrialgo y Cia., S. A., 100 USPQ 268 (Comm'r 1953)--404.02; 415.03; 718.03(d)

Bose Corp., In re, 772 F.2d 866, 227 USPQ 1 (Fed. Cir. 1985)--541; 802.04; 803

Bottega Veneta, Inc. v. Volume Shoe Corp., 226 USPQ 964 (TTAB 1985)--703.02(b)

BPJ Enterprises Ltd., In re, 7 USPQ2d 1375 (Comm'r 1988)--202.03; 215; 307.02; 307.07

Brawn of California Inc. v. Bonnie Sportswear Ltd., 15 USPQ2d 1572 (TTAB 1990)--406.03(d); 406.03(e); 519

Bristol-Myers Co. v. Texize Chemicals, Inc., 168 USPQ 670 (TTAB 1971)--712.01

British Seagull Ltd. v. Brunswick Corp., 28 USPQ2d 1197 (TTAB 1993), aff'd, Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994)--402.02; 419; 523.04; 704

Brittains Tullis Russell Inc., In re, 23 USPQ2d 1457 (Comm'r 1991)--512.02

Brown Co. v. American Stencil Manufacturing Co., 180 USPQ 344 (TTAB 1973)--706.01

BRT Holdings Inc. v. Homeway, Inc., 4 USPQ2d 1952 (TTAB 1987)--303.03

OLD EDITION

Brunswick Corp. v. British Seagull Ltd., 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir. 1994)--318.02(b)

Budge Manufacturing Co., In re, 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir. 1988)--1208

Buffett v. Chi-Chi's, Inc., 226 USPQ 428 (TTAB 1985)--504.01; 507.02; 507.03(a); 528.02

Bureau National Interprofessionnel Du Cognac v. International Better Drinks Corp., 6 USPQ2d 1610 (TTAB 1988)--703.02(a)

Burns Philip Food Inc. v. Modern Products Inc., 24 USPQ2d 1157 (TTAB 1992), aff'd, 28 USPQ2d 1687 (Fed. Cir. 1993)--707

B.V.D. Licensing Corp. v. Body Action Design Inc., 846 F.2d 727, 6 USPQ2d 1719 (Fed. Cir. 1988)--712.01; 712.05

C & G Corp. v. Baron Homes, Inc., 183 USPQ 60 (TTAB 1974)--528.05(b)

C. H. Stuart Inc. v. Carolina Closet, Inc., 213 USPQ 506 (TTAB 1980)--402.03; 412.01

C. H. Stuart Inc. v. S. S. Sarna, Inc., 212 USPQ 386 (TTAB 1980)--402.03; 412.01

Cadence Industries Corp. v. Kerr, 225 USPQ 331 (TTAB 1985)--703.02(a); 707; 713.14

Cambridge Digital Systems, In re, 1 USPQ2d 1659 (TTAB 1986)--303.02

Canadian Pacific Ltd., In re, 222 USPQ 533 (TTAB 1984), aff'd, 754 F.2d 992, 224 USPQ 971 (Fed. Cir. 1985)--1214

Canovas v. Venezia 80 S.R.L., 220 USPQ 660 (TTAB 1983)--419; 502.04

Cantatore, In re, 231 USPQ 742 (Comm'r 1986)--118.03

Capital Formation Counselors, Inc., In re, 219 USPQ 916 (TTAB 1983)--1215

Carl Karcher Enterprises, Inc. v. Gold Star Chili, Inc., 222 USPQ 979 (TTAB 1983), recon. denied, 222 USPQ 727 (TTAB 1983)--1102.02(a)(4)

Caron Corp. v. Helena Rubinstein, Inc., 193 USPQ 113 (TTAB 1976)--503.02; 507.02

Carvel Corp., In re, 223 USPQ 65 (TTAB 1984)--1207.01; 1207.02

Case v. BASF Wyandotte, 737 F.2d 1034, 222 USPQ 737 (Fed. Cir. 1984)--545

Cass Logistics Inc. v. McKesson Corp., 27 USPQ2d 1075 (TTAB 1993)--201; 206.03; 303.05(c); 512.01; 512.04

Caterpillar Tractor Co. v. Catfish Anglers Together, Inc., 194 USPQ 99 (TTAB 1976)--527.01

CBS Inc. v. Mercandante, 23 USPQ2d 1784 (TTAB 1992)--504.02; 505.01; 507.02

OLD EDITION

CCI Corp. v. Continental Communications, Inc., 184 USPQ 445 (TTAB 1974)--321

Celotex Corp. v. Catrett, 477 U.S. 317 (1986)--528.01; 528.08

Century 21 Real Estate Corp. v. Century Life of America, 15 USPQ2d 1079 (TTAB 1990), corrected, 19 USPQ2d 1479 (TTAB 1990)--520; 521; 532; 713.02; 714.15

Certified Burglar Alarm Systems, In re, 191 USPQ 47 (TTAB 1976)--703.02(b)

Cerveceria India Inc. v. Cerveceria Centroamericana, S.A., 10 USPQ2d 1064 (TTAB 1989), aff'd, Cerveceria Centroamericana, S.A. v. Cerveceria India Inc., 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989)--106.02

C.H. Guenther & Son Inc. v. Whitewing Ranch Co., 8 USPQ2d 1450 (TTAB 1988)--602.02(b)

Charrette Corp. v. Bowater Communication Papers Inc., 13 USPQ2d 2040 (TTAB 1989)--419; 527.05

Chase Manhattan Bank, N.A. v. Life Care Services Corp., 227 USPQ 389 (TTAB 1985)--713.02; 718.03(c); 718.04

Checkers of North America Inc., In re, 23 USPQ2d 1451 (Comm'r 1992)--510.03(a); 602.02(b)

Chemetron Corp. v. Self-Organizing Systems, Inc., 166 USPQ 495 (TTAB 1970)--509.01; 709

Chemical New York Corp. v. Conmar Form Systems, Inc., 1 USPQ2d 1139 (TTAB 1986)--304; 703.02(b); 704

Chesebrough-Pond's Inc. v. Faberge, Inc., 618 F.2d 776, 205 USPQ 888 (CCPA 1980)--502.03; 509.01; 509.02; 905

Chesebrough-Pond's Inc. v. Soulful Days, Inc., 228 USPQ 954 (TTAB 1985)--709; 718.02(b)

Chicago Corp. v. North American Chicago Corp., 16 USPQ2d 1479 (TTAB 1990)--413; 519

Chicago Corp. v. North American Chicago Corp., 20 USPQ2d 1715 (TTAB 1991)--321

Chichi's, Inc. v. Chi-Chi's, Inc., 222 USPQ 831 (Comm'r 1984)--1101.03; 1102.01; 1111

Chicken Delight, Inc. v. Delight Wholesale Co., 197 USPQ 630 (TTAB 1977)--708

Chocoladefabriken Lindt & Sprungli Aktiengesellschaft v. Rykoff-Sexton Inc., 24 USPQ2d 1236 (S.D.N.Y. 1992)--903.03

Chromalloy American Corp. v. Kenneth Gordon (New Orleans), Ltd., 736 F.2d 694, 222 USPQ 187 (Fed. Cir. 1984)--605.03(e)

Chung, Jeanne & Kim Co., In re, 226 USPQ 938 (TTAB 1985)--1207.02; 1207.03

Citibank, N.A., In re, 225 USPQ 612 (TTAB 1085)--1201.01; 1201.04

OLD EDITION

Cities Service Co. v. WMF of America, Inc., 199 USPQ 493 (TTAB 1978)--313; 710; 712.01

Cities Service Oil Co. v. Perfection American, Inc., 157 USPQ 209 (TTAB 1968)--502.01

Clairol Inc. v. Holland Hall Products, Inc., 161 USPQ 616 (TTAB 1969)--502.01; 509.01

Clairol Inc. v. Holland Hall Products, Inc., 165 USPQ 214 (TTAB 1970)--1004; 528.05(a); 709

Classic Beverage Inc., In re, 6 USPQ2d 1383 (TTAB 1988)--703.02(b)

Cleveland-Detroit Corp. v. Comco (Machinery) Ltd., 277 F.2d 958, 125 USPQ 586 (CCPA 1960)--703.01

Clorox Co. v. State Chemical Manufacturing Co., 197 USPQ 840 (TTAB 1977)--318.02(b); 319.01

Clubman's Club Corp. v. Martin, 188 USPQ 455 (TTAB 1975)--528.05(b)

Coach House Restaurant, Inc. v. Coach & Six Restaurants, Inc., 223 USPQ 176 (TTAB 1984)--502.03; 509.01

Coach Leatherware Co. v. AnnTaylor Inc., 933 F.2d 162, 18 USPQ2d 1907 (2d Cir. 1991)--528.08

Coca-Cola Co. v. Seven-Up Co., 175 USPQ 491 (Comm'r 1972)--709

Colony Foods, Inc. v. Sagemark, Ltd., 735 F.2d 1336, 222 USPQ 185 (Fed. Cir. 1984)--507.03(b)

Color Key Corp. v. Color 1 Associates, Inc., 219 USPQ 936 (TTAB 1983)--507.03(b); 515

Colt Industries Operating Corp. v. Olivetti Controllo Numerico S.p.A., 221 USPQ 73 (TTAB 1983)--419; 707; 708; 718.02(b)

Columbia Broadcasting System, Inc. v. De Costa, 165 USPQ 95 (TTAB 1970)--545

Commodore Electronics Ltd. v. CBM Kabushiki Kaisha, 26 USPQ2d 1503 (TTAB 1993)--507.02; 528.01; 528.07(a)

Communications Technology Corp., In re, 182 USPQ 695 (TTAB 1974)--601.01; 601.02; 602.01

Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull, In re, 223 USPQ 363 (TTAB 1984)--1207.01; 1207.02

Computer Associates International Inc. v. Computer Automation Inc., 678 F. Supp. 424, 6 USPQ2d 1459 (S.D.N.Y. 1987)--513.02

Comserv Corp. v. Comserv, 179 USPQ 124 (TTAB 1973)--523.04

ConAgra Inc. v. Saavedra, 4 USPQ2d 1245 (TTAB 1987)--527.05

Conde Nast Publications, Inc. v. Miss Quality, Inc., 507 F.2d 1404, 184 USPQ 422 (CCPA 1975)--703.02(b)

OLD EDITION

Conde Nast Publications Inc. v. Vogue Travel, Inc., 205 USPQ 579 (TTAB 1979)--707; 708

Consolidated Foods Corp., In re, 218 USPQ 184 (TTAB 1983)--1207.02

Consolidated Foods Corp. v. Berkshire Handkerchief Co., 229 USPQ 619 (TTAB 1986)--509.01; 528.07(a)

Consolidated Foods Corp. v. Big Red, Inc., 231 USPQ 744 (TTAB 1986)--319.04

Consolidated Foods Corp. v. Ferro Corp., 189 USPQ 582 (TTAB 1976)--404.03(b)(1); 404.03(b)(2); 509.01; 713.06(a); 713.06(b)

Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd., 228 USPQ 752 (TTAB 1985)--303.02; 312.03; 503.02

Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc., 23 USPQ2d 1894 (TTAB 1992)--545; 801.03

Consultants & Designers, Inc. v. Control Data Corp., 221 USPQ 635 (TTAB 1984)--528.03

Continental Gummi-Werke AG v. Continental Seal Corp., 222 USPQ 822 (TTAB 1984)--308.02(c)(2); 318.02(b); 506.01

Continental Specialties Corp. v. Continental Connector Corp., 192 USPQ 449 (TTAB 1976)--510.02(a); 703.03

Contour Chair-Lounge Co. v. Englander Co., 324 F.2d 186, 139 USPQ 285 (CCPA 1963)--318.02(b); 319.01

Conwood Corp. v. Loew's Theatres, Inc., 173 USPQ 829 (TTAB 1972)--507.03(b)

Cook's Pest Control, Inc. v. Sanitas Pest Control Corp., 197 USPQ 265 (TTAB 1977)--1111

Cool-Ray, Inc. v. Eye Care, Inc., 183 USPQ 618 (TTAB 1974)--402.02; 419; 502.03; 507.02

Cooper, In re, 209 USPQ 670 (Comm'r 1980)--202.01; 202.05; 206.02; 303.05(a); 303.05(b); 307.01; 307.04

Copelands' Enterprises Inc. v. CNV Inc., 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991)--528.01

Copelands' Enterprises Inc. v. CNV Inc., 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1989)--901.02(a)

Copperweld Corp. v. Arcair Co., 200 USPQ 470 (TTAB 1978)--703.02(a); 704

Copperweld Corp. v. Astralloy-Vulcan Corp., 196 USPQ 585 (TTAB 1977)--321; 507.03(b); 718.04

Cord Crafts Inc., In re, 11 USPQ2d 1157 (TTAB 1989)--1201.04

Corning Glass Works, In re, 229 USPQ 65 (TTAB 1985)--1204

Cosmetically Yours, Inc., In re, 171 USPQ 563 (TTAB 1971)--544

OLD EDITION

Cotter & Co., In re, 228 USPQ 202 (TTAB 1985)--1207.03

Coup v. Vornado Inc., 9 USPQ2d 1824 (TTAB 1988)--528.01

Cowan, In re, 18 USPQ2d 1407 (Comm'r 1990)--106.02

C.R. Bard Inc. v. Advanced Cardiovascular Systems Inc., 911 F.2d 670, 15 USPQ2d 1540 (Fed. Cir. 1990)--528.01

Crane Co. v. Shimano Industrial Co., 184 USPQ 691 (TTAB 1975)--402.01; 403.03; 407.01; 409.01; 411.01; 527.03

Crocker National Bank v. Canadian Imperial Bank of Commerce, 223 USPQ 909 (TTAB 1984)--528.08; 541

Crown Radio Corp. v. Soundscriber Corp., 506 F.2d 1392, 184 USPQ 221 (CCPA 1974)--703.02(a)

Crown Wallcovering Corp. v. Wall Paper Manufacturers Ltd., 188 USPQ 141 (TTAB 1975)--403.01; 403.02; 404.01; 521; 526

CTS Corp. v. Cronstoms Manufacturing, Inc., 515 F.2d 780, 185 USPQ 773 (CCPA 1975)--703.02(a)

Cudahy Co. v. August Packing Co., 206 USPQ 759 (TTAB 1979)--507.02

Cudahy Packing Co. v. York Pharmacal Co., 93 USPQ 227 (Comm'r 1952)--1002

Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 182 USPQ 572 (Comm'r 1974)--502.01; 504.01; 528.02

Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 185 USPQ 61 (TTAB 1975), aff'd, 530 F.2d 1396, 189 USPQ 138 (CCPA 1976)--705.02

Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 185 USPQ 176 (TTAB 1975)--544

Curtice-Burns, Inc. v. Northwest Sanitation Products, Inc., 530 F.2d 1396, 189 USPQ 138 (CCPA 1976)--704

Cutter Laboratories, Inc. v. Air Products & Chemicals, Inc., 189 USPQ 108 (TTAB 1975)--703.02(b)

Daggett & Ramsdell, Inc. v. Procter & Gamble Co., 119 USPQ 350 (TTAB 1958), rev'd on other grounds, 275 F.2d 955, 125 USPQ 236 (CCPA 1960)--602.02(b)

Daimler-Benz Aktiengesellschaft v. Hibner Products Mfg., Inc., 189 USPQ 479 (TTAB 1976)--523.02

Dan Robbins & Associates, Inc. v. Questor Corp., 599 F.2d 1009, 202 USPQ 100 (CCPA 1979)--901.02(a)

Dana Corp., In re, 12 USPQ2d 1748 (TTAB 1989)--1207.03

Dana Corp. v. Belvedere International Inc., 950 F.2d 1555, 21 USPQ2d 1047 (Fed. Cir. 1991)--528.01

OLD EDITION

Danskin, Inc. v. Dan River, Inc., 498 F.2d 1386, 182 USPQ 370 (CCPA 1974)--605.03(e)

Dap, Inc. v. Century Industries Corp., 183 USPQ 122 (TTAB 1974)--704

Dap, Inc. v. Litton Industries, Inc., 185 USPQ 177 (TTAB 1975)--321; 507.03(b)

Data Packaging Corp. v. Morning Star, Inc., 212 USPQ 109 (TTAB 1981)--718.03(d)

DataNational Corp. v. BellSouth Corp., 18 USPQ2d 1862 (TTAB 1991)--502.03; 1101.01

Davco Inc. v. Chicago Rawhide Mfg. Co., 224 USPQ 245 (TTAB 1984)--303.03

David Crystal, Inc. v. Glamorise Foundations, Inc., 189 USPQ 740 (TTAB 1975)--703.02(a)

Davidoff Extension S.A. v. Davidoff International, Inc., 221 USPQ 465 (SD Fla 1983)--419

Davidson v. Instantype, Inc., 165 USPQ 269 (TTAB 1970)--206.03; 303.05(c); 512.04

D.B. Kaplan Delicatessen, In re, 225 USPQ 342 (TTAB 1985)--1217

DBMS Consultants Ltd. v. Computer Associates International, Inc., 18 FR Serv3d 33, 131 FRD 367 (D. Mass. 1990)--404.03(c)(2)

Deere & Co. v. Deerfield Products Corp., 176 USPQ 422 (TTAB 1973)--403.02

De Luxe N.V., In re, 990 F.2d 607, 26 USPQ2d 1475 (Fed. Cir. 1993)--1203.02(b)

Del E. Webb Corp., In re, 16 USPQ2d 1232 (TTAB 1990)--1214

Delta Tire Corp. v. Sports Car Club of America, Inc., 186 USPQ 431 (TTAB 1975)--503.02

Del-Viking Publications Inc. v. Estate of Johnson, 31 USPQ2d 1063 (W.D.Pa. 1994)--903.03

Development Dimensions International, Inc., In re, 219 USPQ 161 (TTAB 1983)--1207.01; 1207.02; 1207.03

Devries v. NCC Corp., 227 USPQ 705 (TTAB 1985)--102.01; 502.01; 507.03(b)

Diet Tabs, Inc., In re, 231 USPQ 587 (TTAB 1986)--1207.05; 1209.01

Direct Access Communications (M.C.G.) Inc., In re, 30 USPQ2d 1393 (Comm'r 1993)--1201.05

Djeredjian v. Kashi Co., 21 USPQ2d 1613 (TTAB 1991)--114.03; 117.01; 317.01; 317.03; 545

Dodd International, Inc., In re, 222 USPQ 268 (TTAB 1983)--1218

Domino's Pizza Inc. v. Little Caesar Enterprises Inc., 7 USPQ2d 1359 (TTAB 1988)--319.03

Donut Shops Management Corp. v. Mace, 209 USPQ 615 (TTAB 1981)--718.03(d)

OLD EDITION

Double J of Broward Inc. v. Skalony Sportswear GmbH, 21 USPQ2d 1609 (TTAB 1991)--404.03(c)(2); 419; 526

Dow Corning Corp. v. Doric Corp., 183 USPQ 126 (TTAB 1974)--414; 523.01

Dow Corning Corp. v. Doric Corp., 192 USPQ 106 (TTAB 1976)--711

Downtowner Corp. v. Uptowner Inns, Inc., 178 USPQ 105 (TTAB 1973), aff'd without opinion, Uptowner Inns, Inc. v. Downtowner Corp., 508 F.2d 847, 183 USPQ 427 (CCPA 1974)--507.03(b)

Dubost v. U.S. Patent and Trademark Office, 777 F.2d 1561, 227 USPQ 977 (Fed. Cir. 1985), on remand, Dubost, In re, 231 USPQ 887 (Comm'r 1986)--118.03

Duffy-Mott Co. v. Borden, Inc., 201 USPQ 846 (TTAB 1978)--703.02(a)

Dunkin' Donuts of America Inc. v. Metallurgical Exoproducts Corp., 840 F.2d 917, 6 USPQ2d 1026 (Fed. Cir. 1988)--503.04; 504.03

Duofold, Inc., In re, 184 USPQ 638 (TTAB 1974)--703.02(b)

Dynamark Corp. v. Weed Eaters, Inc., 207 USPQ 1026 (TTAB 1980)--709

Dynamet Technology, Inc. v. Dynamet Inc., 197 USPQ 702 (TTAB 1977), aff'd, 593 F.2d 1007, 201 USPQ 129 (CCPA 1979)--1004

E S Robbins Corp., 30 USPQ2d 1540 (TTAB 1992)--1215

Economics Laboratory, Inc. v. Scott's Liquid Gold, Inc., 224 USPQ 512 (TTAB 1984)--704

Econo-Travel Motor Hotel Corp. v. Econ-O-Tel of America, Inc., 199 USPQ 307 (TTAB 1978)--703.02(a)

Edison Brothers Stores, Inc. v. Brutting E.B. Sport-International GmbH, 230 USPQ 530 (TTAB 1986)--703.02(a); 703.02(b); 704

E.E. Dickinson Co. v. T.N. Dickinson Co., 221 USPQ 713 (TTAB 1984)--512.01

E.I. du Pont de Nemours & Co. v. G.C. Murphy Co., 199 USPQ 807 (TTAB 1978)--510.02(a); 710

E.I. duPont de Nemours & Co., In re, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973)--1207.02

Eikonix Corp. v. CGR Medical Corp., 209 USPQ 607 (TTAB 1981)--704

El Chico Corp., In re, 159 USPQ 740 (TTAB 1968)--1102.02(a)(3)

Electric Storage Battery Co. v. Mine Safety Appliances Co., 140 USPQ 671 (TTAB 1963)--502.04

Electronic Data Systems Corp. v. EDSA Micro Corp., 23 USPQ2d 1460 (TTAB 1992)--703.02(a); 706.02

Electronic Realty Associates, Inc. v. Extra Risk Associates, Inc., 217 USPQ 810 (TTAB 1982)--512.01

OLD EDITION

Electronic Water Conditioners, Inc. v. Turbomag Corp., 221 USPQ 162 (TTAB 1984)--102.01

Engineering Systems Corp., In re, 2 USPQ2d 1075 (TTAB 1986)--1215

Entex Industries, Inc. v. Milton Bradley Co., 213 USPQ 1116 (TTAB 1982)--713.11; 713.14; 718.03(d)

Envirotech Corp. v. Compagnie Des Lampes, 219 USPQ 448 (TTAB 1979)--403.03; 407.01; 409.01; 411.01; 523.02; 527.03

Envirotech Corp. v. Solaron Corp., 211 USPQ 724 (TTAB 1981)--511

Epic Metals Corp. v. H.H. Robertson Co., 870 F.2d 1574, 10 USPQ2d 1296 (Fed. Cir. 1989)--605.03(e)

Era Corp. v. Electronic Realty Associates, Inc., 211 USPQ 734 (TTAB 1981)--527.05

Ercona Corp. v. JENAer Glaswerk Schott & Gen., 182 USPQ 573 (TTAB 1974)--507.03(a)

Estate of Biro v. Bic Corp., 18 USPQ2d 1382 (TTAB 1991)--303.03; 507.02; 511; 528.07(a)

Estee Lauder Inc. v. Aloe Creme Laboratories, Inc., 178 USPQ 254 (TTAB 1973)--601.01; 601.02

Ethicon, Inc. v. American Cyanamid Co., 192 USPQ 647 (TTAB 1976)--709

Ethicon, Inc. v. American Cyanamid Co., 193 USPQ 374 (Comm'r 1977)--541; 802.04; 803

Eucryl, Ltd., In re, 193 USPQ 377 (TTAB 1976)--206.03; 303.05(c); 512.04

Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG, Spezialfabrik Fur Reitbekleidung, 34 USPQ2d 1266 (TTAB 1994)--311

Exxon Corp. v. Fill-R-Up Systems, Inc., 182 USPQ 443 (TTAB 1974)--708

Exxon Corp. v. Motorgas Oil & Refining Corp., 219 USPQ 440 (TTAB 1983)--709

Exxon Corp. v. National Foodline Corp., 196 USPQ 444 (TTAB 1977), aff'd, 579 F.2d 1244, 198 USPQ 407 (CCPA 1978)--503.04; 504.03

Exxon Corp. v. National Foodline Corp., 579 F.2d 1244, 198 USPQ 407 (CCPA 1978)--528.01

F. Jacobson & Sons, Inc. v. Excelled Sheepskin & Leather Coat Co., 140 USPQ 281 (Comm'r 1963)--206.02

Faces, Inc. v. Face's, Inc., 222 USPQ 918 (TTAB 1983)--1107; 1112; 514.03

Family Inns of America, Inc., In re, 180 USPQ 332 (Comm'r 1974)--1002

Faultless Starch Co. v. Sales Producers Associates, Inc., 530 F.2d 1400, 189 USPQ 141 (CCPA 1976)--703.02(a)

OLD EDITION

Federal Trade Commission v. Formica Corp., 200 USPQ 182 (TTAB 1978)--303.04; 502.04

Federated Department Stores, Inc. v. Gold Circle Insurance Co., 226 USPQ 262 (TTAB 1985)--306; 511

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976)--303.03

Feed Flavors Inc. v. Kemin Industries, Inc., 209 USPQ 589 (TTAB 1980)--520; 521; 532; 713.02; 714.15

Ferrero S.p.A., In re, 22 USPQ2d 1800 (TTAB 1992), recon. denied, 24 USPQ2d 1061 (TTAB 1992)--541; 1219.01

Ferrero S.p.A., In re, 24 USPQ2d 1061 (TTAB 1992)--1219.01

Ferro Corp. v. SCM Corp., 219 USPQ 346 (TTAB 1983)--404.02; 415.03; 718.03(d)

Fidelity Prescriptions, Inc. v. Medicine Chest Discount Centers, Inc., 191 USPQ 127 (TTAB 1976)--414; 523.01; 523.02

Fioravanti v. Fioravanti Corrado S.R.L., 230 USPQ 36 (TTAB 1986), recon. denied, 1 USPQ2d 1304 (TTAB 1986)--507.02; 510.02(a)

First International Services Corp. v. Chuckles Inc., 5 USPQ2d 1628 (TTAB 1988)--515; 709

First National Bank of Boston, In re, 199 USPQ 296 (TTAB 1978)--218; 307.11; 602.01; 602.02(a)

Fischer Gesellschaft m.b.H. v. Molnar & Co., 203 USPQ 861 (TTAB 1979)--401; 402.01; 404.02; 405.03; 413; 532; 701; 702; 709; 713.02; 714.07; 714.15; 718.04

Fisons Ltd. v. Capability Brown Ltd., 209 USPQ 167 (TTAB 1980)--402.02; 419; 502.06

Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989)--502.03; 503.02; 507.02; 528.01

Fleming Companies v. Thriftway Inc., 21 USPQ2d 1451 (TTAB 1991), aff'd, 26 USPQ2d 1551 (S.D.Ohio 1992)--528.06; 602.01; 603; 1106; 1107

Fleming Companies v. Thriftway Inc., 26 USPQ2d 1551 (S.D.Ohio 1992)--1101.01; 1102.02(a)(1)

Fleming v. County of Kane, 855 F.2d 496 (7th Cir. 1988)--538

Floralife, Inc. v. Floraline International Inc., 225 USPQ 683 (TTAB 1984)--515; 703.02(a)

Flow Technology Inc. v. Picciano, 18 USPQ2d 1970 (TTAB 1991)--318.02(b); 514.03; 528.01

Flowers Industries Inc. v. Interstate Brands Corp., 5 USPQ2d 1580 (TTAB 1987)--1211

Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha, 22 USPQ2d 1316 (TTAB 1992)--507.02; 513.02; 531; 715

OLD EDITION

Food Producers, Inc. v. Swift & Co., 194 USPQ 299 (TTAB 1977)--708

Food Specialty Co. v. Carnation Co., 170 USPQ 522 (TTAB 1971)--308.02(a)

Food Specialty Co. v. Kal Kan Foods, Inc., 487 F.2d 1389, 180 USPQ 136 (CCPA 1973)--712.05

Food Specialty Co. v. Standard Products Co., 406 F.2d 1397, 161 USQP 46 (CCPA 1969)--318.02(b); 319.01

Foodland, Inc. v. Foodtown Super Markets, Inc., 138 USPQ 591 (TTAB 1963)--528.02

Forbo, In re, 4 USPQ2d 1415 (Comm'r 1984)--514.03; 1101.02; 1101.03; 1113

Ford Motor Co. v. Shelby International, Inc., 193 USPQ 236 (TTAB 1976)--523.02

Formica Corp. v. Lefkowitz, 590 F.2d 915, 200 USPQ 641 (CCPA 1979), cert. denied, 442 U.S. 917, 202 USPQ 159 (1979)--303.04; 901.02(a)

Fort Howard Paper Co. v. C.V. Gambina Inc., 4 USPQ2d 1552 (TTAB 1987)--403.03; 416.05; 502.06; 502.07(a); 514.03; 529.01; 709

Fort Howard Paper Co. v. Georgia-Pacific Corp., 189 USPQ 537 (TTAB 1975)--703.02(a)

Fort Howard Paper Co. v. Kimberly-Clark Corp., 216 USPQ 617 (TTAB 1982)--317.02; 509.01; 535.02

Fortunoff Silver Sales, Inc. v. Norman Press, Inc., 225 USPQ 863 (TTAB 1985)--540

Foundry Products, Inc., In re, 193 USPQ 565 (TTAB 1976)--101.02

4U Company of America, Inc. v. Naas Foods, Inc., 175 USPQ 251 (TTAB 1972)--528.05(b)

Franklin Pierce Law Center v. Georgetown University, 14 USPQ2d 1255 (Fed. Cir. 1990)--101.03

Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc., 21 USPQ2d 1556 (TTAB 1991)--317.01; 317.02; 317.03

Fuld Brothers, Inc. v. Carpet Technical Service Institute, Inc., 174 USPQ 473 (TTAB 1972)--703.02(b); 704

GAF Corp. v. Anatox Analytical Services, Inc., 192 USPQ 576 (TTAB 1976)--528.05(b); 703.02(a)

Gagliardi Bros., Inc., In re, 218 USPQ 181 (TTAB 1983)--1207.01

Gal v. Israel Military Industries of the Ministry of Defense of the State of Israel, 1 USPQ2d 1424 (Comm'r 1986)--901.02(a)

Gale Hayman Inc., In re, 15 USPQ2d 1478 (TTAB 1990)--1203.02(c)

Gallagher's Restaurants Inc, v. Gallagher's Farms Inc., 3 USPQ2d 1864 (TTAB 1986)--1102.02(a)(3); 1103

OLD EDITION

Gammon Reel, Inc., In re, 227 USPQ 729 (TTAB 1985)--1208

Gastown Inc. of Delaware v. Gas City, Ltd., 180 USPQ 477 (TTAB 1974)--402.03; 412.01

Gates Rubber Co. v. Western Coupling Corp., 179 USPQ 186 (TTAB 1973)--703.02(a)

Gemini Engine Co. v. Solar Turbines Inc., 225 USPQ 620 (TTAB 1985)--507.02

Gena Laboratories, Inc., In re, 230 USPQ 382 (TTAB 1985)--1203.02(c)

General Electric Co. v. Graham Magnetics Inc., 197 USPQ 690 (TTAB 1977)--710

General Foods Corp. v. Ito Yokado Co., 219 USPQ 822 (TTAB 1983)--308.02(a)

General Mills Fun Group, Inc. v. Tuxedo Monopoly, Inc., 204 USPQ 396 (TTAB 1979), aff'd, Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986 (CCPA 1981)--712.01

General Mills Inc. v. Health Valley Foods, 24 USPQ2d 1270 (TTAB 1992)--101.03

General Mills, Inc. v. Nature's Way Products, Inc., 202 USPQ 840 (TTAB 1979)--319.03

General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992)--510.02(a); 545

General Sealer Corp. v. H. H. Robertson Co., 193 USPQ 384 (TTAB 1976)--523.01; 527.01

General Tire & Rubber Co. v. Gendelman Rigging & Trucking Inc., 189 USPQ 425 (TTAB 1975)--502.03; 518

Genesco, Inc. v. Levi Strauss & Co., 219 USPQ 1205 (TTAB 1983), aff'd, Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984)--528.07(a)

Georgia-Pacific Corp. v. Great Plains Bag Co., 190 USPQ 193 (TTAB 1976)--408.03; 419; 522; 527.05

Georgia-Southern Oil Inc. v. Richardson, 16 USPQ2d 1723 (TTAB 1990)--1101.01; 1103; 1106; 1107

Giant Food Inc. v. Malone & Hyde, Inc., 522 F.2d 1386, 187 USPQ 374 (CCPA 1975)--1004; 1101.02

Giant Food, Inc. v. Standard Terry Mills, Inc., 229 USPQ 955 (TTAB 1986)--318.02(b); 319.01; 321; 502.04; 510.03(a); 528.01; 528.03; 529.01

Giant Food, Inc. v. Standard Terry Mills, Inc., 231 USPQ 626 (TTAB 1986)--403.03; 518; 523.02; 528.07(a); 529.01

Gibson Greeting Cards, Inc. v. Associated Crafts, Inc., 182 USPQ 625 (TTAB 1974)--502.03

Gillette Co. v. "42" Products Ltd., 396 F.2d 1001, 158 USPQ 101 (CCPA 1968)--318.02(b); 319.01

Gilman Corp. v. Gilman Brothers Co., 20 USPQ2d 1238 (Comm'r 1991)--114.08

OLD EDITION

Glamorene Products Corp. v. Earl Grissmer Co., 203 USPQ 1090 (TTAB 1979)--703.03; 708

Global Maschinen GmbH v. Global Banking Systems, Inc., 227 USPQ 862 (TTAB 1985)--602.02(b)

Globe-Union Inc. v. Raven Laboratories Inc., 180 USPQ 469 (TTAB 1973)--540; 718.03(c)

Gold Eagle Products Co. v. National Dynamics Corp., 193 USPQ 109 (TTAB 1976)--315.01; 414; 512.01; 521; 526

Golden Griddle Pancake House Ltd., In re, 17 USPQ2d 1074 (TTAB 1990)--703.02(b)

Gold's Gym Enterprises Inc., In re, 3 USPQ2d 1716 (TTAB 1987)--1207.01

Goodway Corp. v. International Marketing Group Inc., 15 USPQ2d 1749 (TTAB 1990)--602.01; 602.02(a)

Goodyear Tire & Rubber Co. v. Tyrco Industries, 186 USPQ 207 (TTAB 1975)--402.02; 419

Goodyear Tire & Rubber Co. v. Uniroyal, Inc., 183 USPQ 372 (TTAB 1974)--402.02; 502.03

Gould Inc. v. Sanyo Electric Co., 179 USPQ 313 (TTAB 1973)--402.01; 406.02; 506.01

Goya Foods Inc. v. Tropicana Products Inc., 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988)--510.02(a)

Gravel Cologne, Inc. v. Lawrence Palmer, Inc., 469 F.2d 1397, 176 USPQ 123 (CCPA 1972)--708

Gray v. Daffy Dan's Bargaintown, 823 F.2d 522, 3 USPQ2d 1306 (Fed. Cir. 1987)--1101.01; 1102.02(a)(2); 1107

Grinnell Corp. v. Grinnell Concrete Pavingstones Inc., 14 USPQ2d 2065 (TTAB 1990)--317.02; 602.01; 602.02(a)

Grobet File Co. of America Inc. v. Associated Distributors Inc., 12 USPQ2d 1649 (TTAB 1989)--535.02

Groveton Papers Co. v. Anaconda Co., 197 USPQ 576 (TTAB 1977)--703.02(a)

H & H Products, In re, 228 USPQ 771 (TTAB 1986)--703.02(b)

H. Wittur & Co., Ex parte, 153 USPQ 362 (Comm'r 1966)--1002

Hag Aktiengesellschaft, In re, 155 USPQ 598 (TTAB 1967)--703.02(a)

Halcon International, Inc. v. Werbow, 228 USPQ 611 (Comm'r 1980)--114.08

Hamilton Bank, In re, 222 USPQ 174 (TTAB 1984)--1201.02; 1217

Hamilton Burr Publishing Co. v. E. W. Communications, Inc., 216 USPQ 802 (TTAB 1982)--405.01; 512.01; 534.02; 709; 710; 713.05

OLD EDITION

Handy Spot Inc. v. J. D. Williams Co., 181 USPQ 351 (TTAB 1974)--1107; 1109

Harjo v. Pro Football Inc., 30 USPQ2d 1828 (TTAB 1994)--102.01; 506.01

Harley-Davidson Motor Co. v. Pierce Foods Corp., 231 USPQ 857 (TTAB 1986)--518

Harrington, In re, 219 USPQ 854 (TTAB 1983)--1215

Harsco Corp. v. Electrical Sciences Inc., 9 USPQ2d 1570 (TTAB 1988)--312.03; 318.02(c); 506.01

Hart, In re, 199 USPQ 585 (Comm'r 1978)--1201.05

Hartley v. Mentor Corp., 869 F.2d 1469, 10 USPQ2d 1138 (Fed. Cir. 1989)--605.03(e)

Hartwell Co. v. Shane, 17 USPQ2d 1569 (TTAB 1990)--303.03; 502.03; 503.02; 535.02

Harvey Hubbell, Inc. v. Red Rope Industries, Inc., 191 USPQ 119 (TTAB 1976)--711

Harzfeld's, Inc. v. Joseph M. Feldman, Inc., 184 USPQ 692 (TTAB 1974)--703.02(a); 707

Haworth Inc. v. Herman Miller Inc., 998 F.2d 975, 27 USPQ2d 1469 (Fed. Cir. 1993)--402.02

Hayes Microcomputer Products, Inc. v. Business Computer Corp., 219 USPQ 634 (TTAB 1983)--707; 708

Health-Tex Inc. v. Okabashi (U.S.) Corp., 18 USPQ2d 1409 (TTAB 1990)--404.03(b)(2); 502.07(a); 713.02; 713.06(a); 713.06(b); 714.04; 714.07; 714.13; 718.03(c); 718.03(d)

Heaton Enterprises of Nevada Inc. v. Lang, 7 USPQ2d 1842 (TTAB 1988)--533; 710; 718.02(b)

Hechinger Investment Co. of Delaware Inc., In re, 24 USPQ2d 1053 (TTAB 1991)--1201.01

Hecon Corp. v. Magnetic Video Corp., 199 USPQ 502 (TTAB 1978)--706.02

Helene Curtis Industries, Inc. v. John H. Breck, Inc., 183 USPQ 126 (TTAB 1974)--523.02

Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989)--511; 704

Henry Siegel Co. v. M & R International Mfg. Co., 4 USPQ2d 1154 (TTAB 1987)--710

Hershey Foods Corp. v. Cerreta, 195 USPQ 246 (TTAB 1977)--102.01; 321

Hertz System, Inc. v. A-Drive Corp., 222 USPQ2d 625 (TTAB 1984)--712.01

Hester Industries Inc. v. Tyson Foods Inc., 2 USPQ2d 1646 (TTAB 1987)--535.02

Hewlett-Packard Co. v. Healthcare Personnel Inc., 21 USPQ2d 1552 (TTAB 1991)--404.05; 502.07(a); 702; 713.08

Hewlett-Packard Co. v. Human Performance Measurement, Inc., 23 USPQ2d 1390 (TTAB 1991)--713.11; 713.12; 713.14

OLD EDITION

Hewlett-Packard Co. v. Olympus Corp., 931 F.2d 1551, 18 USPQ2d 1710 (Fed. Cir. 1991)--317.02; 318.02(a); 509.01; 535.02; 703.02(a); 901.02(a)

Hickory Manufacturing Co., In re, 183 USPQ 789 (Comm'r 1974)--1218

Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993)--321; 502.01; 511; 529.01; 709; 713.02; 718.03(c)

Hines, In re, 32 USPQ2d 1376 (TTAB 1994)--1218

Hiram Walker & Sons, Inc. v. Milstone, 130 USPQ 274 (TTAB 1961)--703.02(b)

Historic Wharf's Associates, Inc., In re, 222 USPQ 92 (TTAB 1984)--1207.02

Hobie Designs Inc. v. Fred Hayman Beverly Hills Inc., 14 USPQ2d 2064 (TTAB 1990)--411.01; 509.01; 525

Holiday Inn v. Holiday Inns, Inc., 534 F.2d 312, 189 USPQ 630 (CCPA 1976)--1101.03; 1102.02(a)(3); 1102.02(b); 1104

Holiday Inns, Inc. v. Monolith Enterprises, 212 USPQ 949 (TTAB 1981)--710; 718.02(b)

Holland American Wafer Co., In re, 737 F.2d 1015, 222 USPQ 273 (Fed. Cir. 1984)--202.01; 310.04; 312.01; 509.02

Hollister Inc. v. Downey, 565 F.2d 1208, 196 USPQ 118 (CCPA 1977)--703.02(a)

Hollister Inc. v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976)--710

Hollowform, Inc. v. Delma Aeh, 180 USPQ 284 (TTAB 1973), aff'd, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975)--503.01; 1102.01

Hollowform, Inc. v. Delma AEH, 515 F.2d 1174, 185 USPQ 790 (CCPA 1975)--1101.02

Home Federal Savings & Loan Ass'n, In re, 213 USPQ 68 (TTAB 1982)--1102.01; 1102.02(a)(2)

Home Federal Savings & Loan Ass'n v. Home Federal Savings & Loan Ass'n of Chicago, 205 USPQ 467 (TTAB 1979)--1111

Home Juice Co. v. Runglin Cos., 231 USPQ 897 (TTAB 1986)--312.03; 313; 318.02(b); 534.02; 605.03(c)

Honeywell Inc., In re, 8 USPQ2d 1600 (TTAB 1988)--1211

Houlihan v. Parliament Import Co., 921 F.2d 1258, 17 USPQ2d 1208 (Fed. Cir. 1990)--1101.01; 1109

House of Windsor, Inc., In re, 221 USPQ 53 (TTAB 1983)--1215

Hovnanian Enterprises, Inc. v. Covered Bridge Estates, Inc., 195 USPQ 658 (TTAB 1977)--707; 710

OLD EDITION

Hub Distributing, Inc., In re, 218 USPQ 284 (TTAB 1983)--703.02(b)

Hudson Pharmaceutical Corp. v. Laboratorios Hosbon, S.A., 177 USPQ 707 (Comm'r 1973)--905

Huffy Corp. v. Geoffrey Inc., 18 USPQ2d 1240 (Comm'r 1990)--507.02; 512.01

Humana Inc. v. Humanomics Inc., 3 USPQ2d 1696 (TTAB 1987)--312.03; 318.02(b); 318.02(c)

Humble Oil & Refining Co. v. Sekisui Chemical Company Ltd. of Japan, 165 USPQ 597 (TTAB 1970)--308.02(c)(1); 319.03

Hunt v. Treppschuh and Hentrich, 523 F.2d 1386, 187 USPQ 426 (CCPA 1975)--1217

Hunter Publishing Co. v. Caulfield Publishing Ltd., 1 USPQ2d 1996 (TTAB 1986)--707; 708

Hunt-Wesson Foods, Inc. v. Riceland Foods, Inc., 201 USPQ 881 (TTAB 1979)--707; 708; 709; 710

Hydro-Dynamics Inc. v. George Putnam & Co., 811 F.2d 1470, 1 USPQ2d 1772 (Fed. Cir. 1987)--704

Hydrotechnic Corp. v. Hydrotech International, Inc., 196 USPQ 387 (TTAB 1977)--540

Hy-Pure Laboratories, Inc. v. Foley & Co., 98 USPQ 280 (Chief Examiner 1953)--1002

Identicon Corp. v. Williams, 195 USPQ 447 (Comm'r 1977)--317.01; 317.02

ILC Products Co. v. ILC, Inc., 175 USPQ 722 (TTAB 1972)--704

Ilco Corp. v. Ideal Security Hardware Corp., 527 F.2d 1221, 188 USPQ 485 (CCPA 1976)--1217

Illinois Bronze Powder & Paint Co., In re, 188 USPQ 459 (TTAB 1975)--703.02(a)

Imperial Tobacco Ltd. v. Philip Morris Inc., 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990)--308.01; 308.02(b)

INB National Bank v. Metrohost Inc., 22 USPQ2d 1585 (TTAB 1992)--528.01

Industrial Adhesive Co. v. Borden, Inc., 218 USPQ 945 (TTAB 1983)--703.02(a); 717

Information Resources Inc. v. X*Press Information Services, 6 USPQ2d 1034 (TTAB 1988)--512.01

Ingalls Shipbuilding, Inc. v. United States, 857 F.2d 1448, 11 Fed. R. Serv.3d 1342 (Fed. Cir. 1988)--527.01

Inland Oil & Transport Co. v. IOT Corp., 197 USPQ 562 (TTAB 1977)--1102.01; 1107; 1112

Insta-Foam Products, Inc. v. Instapak Corp., 189 USPQ 793 (TTAB 1976)--530; 709

Interbank Card Ass'n v. United States National Bank of Oregon, 197 USPQ 123 (TTAB 1977)--528.05(d); 703.02(b)

Interbank Card Ass'n v. United States National Bank of Oregon, 197 USPQ 127 (TTAB 1975)--419

OLD EDITION

Intermed Communications, Inc. v. Chaney, 197 USPQ 501 (TTAB 1977)--507.03(b); 528.07(a)

International Ass'n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp., 225 USPQ 940 (TTAB 1985), rev'd on other grounds, 782 F.2d 987, 228 USPQ 528 (Fed. Cir. 1986)--708

International Environmental Corp., In re, 230 USPQ 688 (TTAB 1986)--1207.01

International Mobile Machines Corp. v. International Telephone and Telegraph Corp., 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986)--308.02(a)

International Order of Job's Daughters v. Lindeburg & Co., 727 F.2d 1087, 220 USPQ 1017 (Fed. Cir. 1984)--303.03; 308.02(a); 312.03

International Telephone and Telegraph Corp. v. International Mobile Machines Corp., 218 USPQ 1024 (TTAB 1983)--319.01; 504.02; 504.03

International Visual Corp. v. Crown Metal Manufacturing Co., 991 F.2d 768, 26 USPQ2d 1588 (Fed. Cir. 1993)--528.08

Intersat Corp. v. International Telecommunications Satellite Organization, 226 USPQ 154 (TTAB 1985)--312.03; 313; 503.02; 503.03

Interstate Brands Corp. v. Celestial Seasonings, Inc., 576 F.2d 926, 198 USPQ 151 (CCPA 1978)--704

Inter-State Oil Co., In re, 219 USPQ 1229 (TTAB 1983)--703.02(a)

Investigacion Y Desarrollo de Cosmeticos S.A., In re, 19 USPQ2d 1717 (Comm'r 1991)--104

Ipco Corp. v. Blessings Corp., 5 USPQ2d 1974 (TTAB 1988)--303.03

Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc., 180 USPQ 794 (TTAB 1974)--312.03; 506.01

Izod, Ltd. v. La Chemise Lacoste, 178 USPQ 440 (TTAB 1973)--306; 511; 715

J. B. Williams Co. v. Pepsodent G.m.b.H., 188 USPQ 577 (TTAB 1975)--319.04; 321; 402.01; 402.02; 419; 523.02

Jan Bell Marketing Inc. v. Centennial Jewelers Inc., 19 USPQ2d 1636 (TTAB 1990)--406.03(d); 406.03(e); 501.03; 701; 801.02(e)

Jean Patou Inc. v. Theon Inc., 18 USPQ2d 1072 (TTAB 1990)--534.02; 703.02(a); 713.05; 718.02(a); 718.02(c)

Jeanne-Marc, Inc. v. Cluett, Peabody & Co., 221 USPQ 58 (TTAB 1984)--707; 708; 711

Jeep Corp., In re, 222 USPQ 333 (TTAB 1984)--1207.01; 1207.02

Jerrold Electronics Corp. v. Magnavox Co., 199 USPQ 751 (TTAB 1978)--710

Jet-Pak, Inc. v. United States Plywood Corp., 124 USPQ 385 (TTAB 1960)--310.02; 319.02

OLD EDITION

Jet-Pak, Inc. v. United States Plywood Corp., 125 USPQ 491 (Comm'r 1960)--310.02; 319.02

Jetzon Tire & Rubber Corp. v. General Motors Corp., 177 USPQ 467 (TTAB 1973)--707; 708; 718.02(c)

Jewelers Vigilance Committee, Inc. v. Ullenberg Corp., 229 USPQ 860 (TTAB 1986), rev'd on other grounds, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1987), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988)--502.03

Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), on remand, 5 USPQ2d 1622 (TTAB 1987), rev'd, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988)--303.03

Jewelers Vigilance Committee Inc. v. Ullenberg Corp., 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988)--901.02(a)

J.I. Case Co. v. F.L. Industries, Inc., 229 USPQ 697 (TTAB 1986)--528.06

Jim Dandy Co. v. Martha White Foods, Inc., 458 F.2d 1397, 173 USPQ 673 (CCPA 1972)--1005

Jimlar Corp. v. Army and Air Force Exchange Service, 24 USPQ2d 1216 (TTAB 1992)--703.02(a)

Jockey International, Inc. v. Bette Appel Unltd., 216 USPQ 359 (TTAB 1982)--541; 802.04; 803

Jockey International, Inc. v. Frantti, 196 USPQ 705 (TTAB 1977)--703.02(a)

Jockey International Inc. v. Mallory & Church Corp., 25 USPQ2d 1233 (TTAB 1992)--507.03(b)

Johanna Farms, Inc., In re, 223 USPQ 459 (TTAB 1984)--1207.02; 1209.01; 1217; 1218

Johanna Farms Inc., In re, 8 USPQ2d 1408 (TTAB 1988)--541

John T. Clark Co. v. Colgate-Palmolive Co., 176 USPQ 93 (TTAB 1972)--312.03; 318.02(b); 528.05(b)

Johnson & Johnson, In re, 59 F.R.D. 174, 178 USPQ 201 (D.Del. 1973)--404.03(b)(2); 713.06(b)

Johnson & Johnson v. American Hospital Supply Corp., 187 USPQ 478 (TTAB 1975)--502.03; 718.02(b)

Johnson & Johnson v. Bio-Medical Sciences, Inc., 179 USPQ 765 (TTAB 1973)--601.01; 601.02; 602.01

Johnson & Johnson v. Cenco Medical Health Supply Corp., 177 USPQ 586 (Comm'r 1973)--507.02; 905

Johnson & Johnson v. Diamond Medical, Inc., 183 USPQ 615 (TTAB 1974)--502.03; 523.01; 523.03; 527.01

Johnson & Johnson v. Diaz, 339 F.Supp. 60, 172 USPQ 35 (CD Cal 1971)--419

OLD EDITION

Johnson & Johnson v. E. I. du Pont de Nemours & Co., 181 USPQ 790 (TTAB 1974)--703.02(a)

Johnson & Johnson v. Rexall Drug Co., 186 USPQ 167 (TTAB 1975)--319.04; 321; 402.01; 402.02; 419

Johnson & Johnson v. Salve S.A., 183 USPQ 375 (TTAB 1974)--419

Johnson Publishing Co. v. Cavin & Tubiana OHG, 196 USPQ 383 (TTAB 1977)--709

Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 10 USPQ2d 1671 (TTAB 1988)--402.01; 402.02; 402.03; 405.03; 406.02; 412.01; 416.04; 419; 502.03; 509.01; 526; 527.05

Johnston Pump/General Valve Inc. v. Chromalloy American Corp., 13 USPQ2d 1719 (TTAB 1989)--411.01; 412.01; 502.03; 525; 529.01

Jonergin Co. v. Jonergin Vermont Inc., 222 USPQ 337 (Comm'r 1983)--404.03(c)(1); 520

Jos. Schlitz Brewing Co., In re, 223 USPQ 45 (TTAB 1983)--1207.01; 1207.02

Jos. Schlitz Brewing Co. v. United Vintners, Inc., 166 USPQ 493 (TTAB 1970)--528.05(b); 1004

Joseph S. Finch & Co. v. E. Martinoni Co., 157 USPQ 394 (TTAB 1968)--703.02(b)

Joy Manufacturing Co. v. Robbins Co., 181 USPQ 408 (TTAB 1974)--502.03; 518

JSB International, Inc. v. Auto Sound North, Inc., 215 USPQ 60 (TTAB 1982)--412.03

Juleigh Jeans Sportswear Inc., In re, 24 USPQ2d 1694 (TTAB 1992)--1204; 1205; 1207.01; 1207.02

Kalil, In re, 2 USPQ2d 1614 (Dep't Comm. 1986)--115.02

Kasco Corp. v. Southern Saw Service Inc., 27 USPQ2d 1501 (TTAB 1993)--502.01; 507.03(b)

Kassnar Imports v. Plastilite Corp., 180 USPQ 156 (TTAB 1973), aff'd, 508 F.2d 824, 184 USPQ 348 (CCPA 1975)--308.02(a)

Katz v. Batavia Marine & Sporting Supplies Inc., 984 F.2d 422, 25 USPQ2d 1549 (Fed. Cir. 1993)--402.02

Keebler Co. v. Murray Bakery Products, 866 F.2d 1386, 9 USPQ2d 1736 (Fed. Cir. 1989)--528.01; 528.06

Kellogg Co. v. New Generation Foods Inc., 6 USPQ2d 2045 (TTAB 1988)--404.03(b)(2); 414; 521

Kellogg Co. v. Nugget Distributors' Cooperative of America, Inc., 16 USPQ2d 1468 (TTAB 1990)--406.03(d); 406.03(e)

Kellogg Co. v. Pack'Em Enterprises Inc., 14 USPQ2d 1545 (TTAB 1990), aff'd, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)--308.02(a); 413; 528.01; 528.05(a); 703.01; 703.02(b); 704; 706.01

OLD EDITION

Kellogg Co. v. Pack'Em Enterprises Inc., 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991)--528.01

Kelly Services Inc. v. Greene's Temporaries Inc., 25 USPQ2d 1460 (TTAB 1992)--102.01; 312.03; 503.02

Kemin Industries, Inc. v. Watkins Products, Inc., 192 USPQ 327 (TTAB 1976)--308.02(a)

Key West Fragrance & Cosmetic Factory, Inc. v. Mennen Co., 216 USPQ 168 (TTAB 1982)--507.03(b)

Kimbell Foods, Inc., In re, 184 USPQ 172 (Comm'r 1974)--1002

Kimberly-Clark Corp. v. Fort Howard Paper Co., 772 F.2d 860, 227 USPQ 36 (Fed. Cir. 1985)--605.03(e)

Kimberly-Clark Corp. v. Paper Converting Industry, Inc., 21 USPQ2d 1875 (Comm'r 1991)--207.02; 209.04

Klein, In re, 6 USPQ2d 1528 (Dep't Comm. 1986)--109

Klein, In re, 6 USPQ2d 1547 (Comm'r 1987), aff'd sub nom. Klein v. Peterson, 696 F. Supp. 695, 8 USPQ2d 1434 (D.D.C. 1988), aff'd 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989), cert. denied, 490 U.S. 1091, 109 S.Ct. 2432 (1989)--110.01

Klein v. Peterson, 866 F.2d 412, 9 USPQ2d 1558 (Fed. Cir. 1989)--115.02

Knickerbocker Toy Co. v. Faultless Starch Co., 467 F.2d 501, 175 USPQ 417 (CCPA 1972)--102.01; 802.04; 803

Kraft, Inc. v. Balin, 209 USPQ 877 (TTAB 1981)--703.02(a)

Kroger Co., In re, 177 USPQ 715 (TTAB 1973)--544

L. Leichner (London) Ltd. v. Robbins, 189 USPQ 254 (TTAB 1975)--540; 705.02

La Jolla Sportswear Co. v. Maskuline Underwear Co., 114 USPQ 130 (Comm'r 1957)--1004

La Maur, Inc. v. Andis Clipper Co., 181 USPQ 783 (Comm'r 1974)--203.03; 203.04

La Maur, Inc. v. Bagwells Enterprises, Inc., 193 USPQ 234 (Comm'r 1976)--102.03; 502.01; 504.01; 528.02; 702

Laboratoires du Dr. N.G. Payot Etablissement v. Southwestern Classics Collection Ltd., 3 USPQ2d 1600 (TTAB 1987)--507.03(b)

Lacoste Alligator S.A. v. Everlast World's Boxing Headquarters Corp., 204 USPQ 945 (TTAB 1979)--710

Land v. Regan, 342 F.2d 92, 144 USPQ 661 (CCPA 1965)--718.03(d)

OLD EDITION

Larry Harmon Pictures Corp. v. Williams Restaurant Corp., 929 F.2d 662, 18 USPQ2d 1292 (Fed. Cir. 1991)--528.01

Lasek & Miller Associates v. Rubin, 201 USPQ 831 (TTAB 1978)--703.03

Lativ Systems, Inc., In re, 223 USPQ 1037 (TTAB 1984)--1217

Le Sorbet, Inc., In re, 228 USPQ 27 (TTAB 1985)--1214

Lee Byron Corp. v. H.D. Lee Co. 203 USPQ 1097 (TTAB 1979)--545

Legendary Inc., In re, 26 USPQ2d 1478 (Comm'r 1992)--116.02; 513.01

Leon Shaffer Golnick Advertising, Inc. v. William G. Pendill Marketing Co., 177 USPQ 401 (TTAB 1973)--506.01

Lever Brothers Co. v. Shaklee Corp., 214 USPQ 654 (TTAB 1982)--511

Levi Strauss & Co. v. Genesco, Inc., 742 F.2d 1401, 222 USPQ 939 (Fed. Cir. 1984)--528.01

Levi Strauss & Co. v. R. Josephs Sportswear Inc., 28 USPQ2d 1464 (TTAB 1993)--321; 528.05(a); 540; 704

Liberty & Co. v. Liberty Trouser Co., 216 USPQ 65 (TTAB 1982)--512.01

Liberty Trouser Co. v. Liberty & Co., 222 USPQ 357 (TTAB 1983)--308.02(a)

Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 22 USPQ2d 1594 (TTAB 1992)--319.04; 503.02; 503.04

Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd., 24 USPQ2d 1376 (TTAB 1992)--319.04

Lillian Vernon Corp., In re, 225 USPQ 213 (TTAB 1985)--1215

Lipton Industries, Inc. v. Ralston Purina Co., 670 F.2d 1024, 213 USPQ 185 (CCPA 1982)--303.03; 312.03; 503.02

Liqwacon Corp. v. Browning-Ferris Industries, Inc., 203 USPQ 305 (TTAB 1979)--528.05(b); 718.03(c)

Little Caesar Enterprises Inc. v. Domino's Pizza Inc., 11 USPQ2d 1233 (Comm'r 1989)--513.02

Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 428 (TTAB 1976), recon. denied, 190 USPQ 431 (TTAB 1976)--509.01; 535.02

Litton Business Systems, Inc. v. J. G. Furniture Co., 190 USPQ 431 (TTAB 1976)--535.03; 702; 712.02; 712.03; 712.04

Litton Business Systems, Inc. v. J. G. Furniture Co., 196 USPQ 711 (TTAB 1977)--706.01

Litton Business Systems, Inc. v. JG Furniture Co., 188 USPQ 509 (TTAB 1976)--509.01; 535.02

OLD EDITION

Litton Industries, Inc. v. Litronix, Inc., 188 USPQ 407 (TTAB 1975)--708

Litton Industries, Inc. v. Litronix Inc., 577 F.2d 709, 198 USPQ 280 (CCPA 1978)--528.01

Lloyd's Food Products Inc. v. Eli's Inc., 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993)--528.01; 528.05(d)

Local Trademarks Inc. v. Handy Boys Inc., 16 USPQ2d 1156 (TTAB 1990)--703.02(a)

Loew's Theatres, Inc., In re, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985)--1208

Logicon, Inc. v. Logisticon, Inc., 205 USPQ 767 (TTAB 1980)--708

Loglan Institute Inc. v. Logical Language Group Inc., 962 F.2d 1038, 22 USPQ2d 1531 (Fed. Cir. 1992)--102.01

Lone Star Manufacturing Co. v. Bill Beasley, Inc., 176 USPQ 426 (TTAB 1972), rev'd on other grounds, 498 F.2d 906, 182 USPQ 368 (CCPA 1974)--512.04

Long John Silver's, Inc. v. Lou Scharf Inc., 213 USPQ 263 (TTAB 1982)--321; 507.02

Loren Cook Co. v. Acme Engineering and Manufacturing Corp., 216 USPQ 517 (TTAB 1982)--535.02

Los Angeles Bonaventure Co. v. Bonaventure Associates, 4 USPQ2d 1882 (TTAB 1987)--712.01

Lotus Development Corp. v. Narada Productions, Inc., 23 USPQ2d 1310 (Comm'r 1991)--112; 202.01; 207.01; 207.02; 207.03; 209.04

Lowrance Electronics Inc., In re, 14 USPQ2d 1251 (TTAB 1989)--1218

L.R. Sport Inc., In re, 25 USPQ2d 1533 (Comm'r 1992)--202.01; 310.04; 312.01; 509.02

LS Bedding, In re, 16 USPQ2d 1451 (Comm'r 1990)--110.01

Luehrmann v. Kwik Kopy Corp., 2 USPQ2d 1303 (TTAB 1987)--402.03; 403.03; 403.04; 404.03(b)(2); 407.01; 409.01; 411.01; 412.01; 502.06; 509.01; 521; 527.03; 713.06(b)

Lukens Inc. v. Vesper Corp., 1 USPQ2d 1299 (TTAB 1986), aff'd, Vesper Corp. v. Lukens Inc., 831 F.2d 306 (Fed. Cir. 1987)--504.01; 528.02; 1211

Lutz Superdyne, Inc. v. Arthur Brown & Bro., Inc., 221 USPQ 354 (TTAB 1984)--509.01; 530; 709

M. Aron Corp. v. Remington Products, Inc., 222 USPQ 93 (TTAB 1984)--319.03; 319.04

Mack Trucks, Inc., In re, 189 USPQ 642 (Comm'r 1976)--1218

Mack Trucks, Inc. v. California Business News, Inc., 223 USPQ 164 (TTAB 1984)--707; 708

Mack Trucks, Inc. v. Hydra-Mac, Inc., 180 USPQ 147 (TTAB 1973), aff'd, Hydra-Mac, Inc. v. Mack Trucks, Inc., 507 F.2d 1399, 184 USPQ 351 (CCPA 1975)--514.03

OLD EDITION

Mack Trucks, Inc. v. Monroe Auto Equipment Co., 181 USPQ 286 (TTAB 1974)--402.01; 402.02; 419

Mack Trucks, Inc. v. Monroe Auto Equipment Co., 182 USPQ 511 (TTAB 1974)--507.02

MacMillan Bloedel Ltd. v. Arrow-M Corp., 203 USPQ 952 (TTAB 1979)--403.03; 407.01; 409.01; 411.01; 502.06; 510.03(a); 510.03(b); 523.01; 523.02; 527.01; 527.03

Maine Savings Bank v. First Banc Group of Ohio, Inc., 220 USPQ 736 (TTAB 1983)--512.02

Manco Inc., In re, 24 USPQ2d 1938 (TTAB 1992)--1208

Manpower, Inc. v. Manpower Information Inc., 190 USPQ 18 (TTAB 1976)--708; 718.02(b)

Marcal Paper Mills, Inc. v. American Can Co., 212 USPQ 852 (TTAB 1981)--319.03; 502.01; 502.03; 507.03(b); 712.01

MarCon Ltd. v. Avon Products Inc., 4 USPQ2d 1474 (TTAB 1987)--715

Marcon, Ltd. v. Merle Norman Cosmetics, Inc., 221 USPQ 644 (TTAB 1984)--101.03

Maremont Corp. v. Air Lift Co., 463 F.2d 1114, 174 USPQ 395 (CCPA 1972)--706.01

Marie Claire Album S.A. v. Kruger GmbH & Co. KG, 29 USPQ2d 1792 (TTAB 1993)--510.02(a)

Marion Laboratories Inc. v. Biochemical/Diagnostics Inc., 6 USPQ2d 1215 (TTAB 1988)--709

Marmark Ltd. v. Nutrexpa S.A., 12 USPQ2d 1843 (TTAB 1989)--507.02

Marriott Corp. v. Pappy's Enterprises, Inc., 192 USPQ 735 (TTAB 1976)--317.03; 509.01; 545; 703.02(a)

Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1154 (TTAB 1989)--602.02(b)

Marshall Field & Co. v. Mrs. Fields Cookies, 11 USPQ2d 1355 (TTAB 1989)--319.04

Marshall Field & Co. v. Mrs. Field's Cookies, 17 USPQ2d 1652 (TTAB 1990)--521; 714.04; 714.06

Marshall Field & Co. v. Mrs. Fields Cookies, 25 USPQ2d 1321 (TTAB 1992)--709; 713.14; 718.03(c)

Martahus v. Video Duplication Services Inc., 3 F.3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993)--706.02

Martin Beverage Co. v. Colita Beverage Corp., 169 USPQ 568 (TTAB 1971)--510.02(a)

Martin Marietta Corp. v. Lith-Kem Corp., 184 USPQ 492 (Comm'r 1974)--905

Mason Engineering & Design Corp. v. Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985)--512.01; 512.04; 514.03; 704

OLD EDITION

Massey Junior College, Inc. v. Fashion Institute of Technology, 492 F.2d 1399, 181 USPQ 272 (CCPA 1974)--703.02(a)

Mastic Inc., In re, 829 F.2d 1114, 4 USPQ2d 1292 (Fed. Cir. 1987)--1207.02

Mastic Inc. v. Mastic Corp., 230 USPQ 699 (TTAB 1986)--419

May Department Stores Co. v. Prince, 200 USPQ 803 (TTAB 1978)--707; 710; 718.02(a); 1101.02

Maybelline Co. v. Matney, 194 USPQ 438 (TTAB 1977)--703.02(a)

Mayer-Beaton Corp., In re, 223 USPQ 1347 (TTAB 1984)--1207.01; 1207.02

Maytag Co. v. Luskin's, Inc., 228 USPQ 747 (TTAB 1986)--318.02(c); 530; 701; 705.02; 709

McCandlish v. Doe, 22 USPQ2d 1223 (Comm'r 1992)--115.02

McCormick & Co. v. Hygrade Food Products Corp., 124 USPQ 16 (TTAB 1959)--310.02; 312.03; 318.02(b); 318.02(c); 319.02; 506.01

McCormick & Co. v. Summers, 354 F.2d 668, 148 USPQ 272 (CCPA 1966)--703.02(a)

McDonald's Corp., In re, 230 USPQ 210 (TTAB 1986)--541

McDonald's Corp. v. McKinley, 13 USPQ2d 1895 (TTAB 1989)--704; 713.02

McDonnell Douglas Corp. v. National Data Corp., 228 USPQ 45 (TTAB 1985)--312.03; 318.02(b); 503.03; 506.01

MCI Communications Corp., In re, 21 USPQ2d 1534 (Comm'r 1991)--212.01; 212.04; 212.05

McNeil v. Mini Mansions, Inc., 178 USPQ 312 (TTAB 1973)--1005

Mead Johnson & Co. v. Peter Eckes, 195 USPQ 187 (TTAB 1977)--703.02(b)

Medical Disposables Co., In re, 25 USPQ2d 1801 (TTAB 1992)--703.02(a)

Medtronic, Inc. v. Medical Devices, Inc., 204 USPQ 317 (TTAB 1979)--718.04

Medtronic, Inc. v. Pacesetter Systems, Inc., 222 USPQ 80 (TTAB 1984)--402.03; 412.01; 414; 507.03(b); 528.07(a)

Meijer, Inc. v. Purple Cow Pancake House, 226 USPQ 280 (TTAB 1985)--1109

Melville Corp., In re, 228 USPQ 970 (TTAB 1986)--1208

Mercedes Slacks, Ltd., In re, 213 USPQ 397 (TTAB 1982)--1201.02; 1217

Merck & Co., In re, 24 USPQ2d 1317 (Comm'r 1992)--104; 203.02

Merker Counter Co. v. Central Counter Co., 310 F.2d 746, 135 USPQ 433 (CCPA 1962)--535.03

OLD EDITION

Metromedia Steakhouses Inc. v. Pondco II Inc., 28 USPQ2d 1205 (TTAB 1993)--507.02

Meyers v. Brooks Shoe Inc., 912 F.2d 1459, 16 USPQ2d 1055 (Fed. Cir. 1990)--528.01

Micro Motion Inc. v. Kane Steel Co., 894 F.2d 1318, 13 USPQ2d 1696 (Fed. Cir. 1990)--402.02; 402.03; 412.01

Microsoft Corp. v. Qantel Business Systems Inc., 16 USPQ2d 1732 (TTAB 1990)--507.02

Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 5 USPQ2d 1067 (TTAB 1987)--413; 503.03; 507.02; 535.02; 539

Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc., 12 USPQ2d 1267 (TTAB 1989), aff'd, 906 F.2d 1568, 15 USPQ2d 1359 (Fed. Cir. 1990)--507.02; 507.03(b); 707; 708

Miles Laboratories, Inc. v. Instrumentation Laboratory, Inc., 185 USPQ 432 (TTAB 1975)--402.02; 419

Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc., 1 USPQ2d 1445 (TTAB 1986)--709; 710; 711

Miles Laboratories, Inc. v. Smith Kline Corp., 189 USPQ 290 (TTAB 1975)--709

Miller & Fink Corp. v. Servicemaster Hospital Corp., 184 USPQ 495 (TTAB 1975)--402.02; 419

Miller Brewing Co., In re, 226 USPQ 666 (TTAB 1985)--1203.02(b); 1203.02(d)

Miller Brewing Co. v. Anheuser-Busch Inc., 27 USPQ2d 1711 (TTAB 1993)--503.02; 503.03

Miller Brewing Co. v. Coy International Corp., 230 USPQ 675 (TTAB 1986)--601.01; 601.02; 602.01

Miller v. N. V. Cacao-En Chocoladefabrieken Boon, 142 USPQ 364 (E.D.N.Y. 1964)--404.03(c)(1)

Minnesota Mining & Manufacturing Co. v. Stryker Corp., 179 USPQ 433 (TTAB 1973)--707

Miss America Pageant v. Petite Productions, Inc., 17 USPQ2d 1067 (TTAB 1990)--402.03; 403.03; 403.04; 412.01

Miss Nude Florida, Inc. v. Drost, 193 USPQ 729 (TTAB 1976), pet. to Comm'r den., 198 USPQ 485 (Comm'r 1977)--405.01; 710; 718.02(a); 718.02(b); 718.03(c)

Miss Nude Florida, Inc. v. Drost, 198 USPQ 485 (Comm'r 1977)--905

Mission Pharmacal Co., Inc., In re, 33 USPQ2d 1060 (Comm'r 1993)--1201.05

Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media, Inc., 6 USPQ2d 1028 (TTAB 1988)--528.05(b); 1102.02(a)(4)

Mohawk Air Services Inc., In re, 196 USPQ 851 (TTAB 1977)--303.02

OLD EDITION

Monocraft, Inc. v. Leading Jewelers Guild, 173 USPQ 506 (TTAB 1972)--703.02(a)

Moore Business Forms Inc., In re, 24 USPQ2d 1638 (TTAB 1992)--1201.02; 1203.02(b)

Morehouse Manufacturing Corp. v. J. Strickland and Co., 407 F.2d 881, 160 USPQ 715 (CCPA 1969)--303.02

Morgan Services Inc. v. Morgan Linen Services Inc., 12 USPQ2d 1841 (TTAB 1989)--1101.02; 1101.03; 1102.02(a)(2); 1103; 1113

Mother's Restaurant Inc. v. Mama's Pizza, Inc., 723 F.2d 1566, 221 USPQ 394 (Fed. Cir. 1983)--510.02(a); 1101.02

Mother's Restaurants, Inc. v. Mother's Other Kitchen, Inc., 218 USPQ 1046 (TTAB 1983)--419

Motorola, Inc., In re, 3 USPQ2d 1142 (TTAB 1986)--1208

MRI Systems Corp. v. Wesley-Jessen Inc., 189 USPQ 214 (TTAB 1975)--711

M-Tek Inc. v. CVP Systems Inc., 17 USPQ2d 1070 (TTAB 1990)--502.03; 533; 534.01; 701; 710; 711; 718.02(b); 718.02(c); 718.03(c)

Murphy Door Bed Co., In re, 223 USPQ 1030 (TTAB 1984)--1208

My Aching Back Inc. v. Klugman, 6 USPQ2d 1892 (TTAB 1988)--1102.02(a)(2)

Nabisco Brands Inc. v. Keebler Co., 28 USPQ2d 1237 (TTAB 1993)--315.01; 316.01; 402.02; 403.02; 404.01; 502.06; 528.02

Nabisco, Inc. v. George Weston Ltd., 179 USPQ 503 (TTAB 1973)--703.02(a)

N.A.D. Inc., In re, 754 F.2d 996, 224 USPQ 969 (Fed. Cir. 1985)--1207.02

Narwood Productions, Inc., In re, 223 USPQ 1034 (TTAB 1984)--1215

National Aeronautics and Space Administration v. Bully Hill Vineyards Inc., 3 USPQ2d 1671 (TTAB 1987)--527.05

National Association of Blue Shield Plans v. Standard Mattress Co., 176 USPQ 29 (TTAB 1972)--503.02

National Blank Book Co. v. Leather Crafted Products, Inc., 218 USPQ 827 (TTAB 1983)--512.02

National Distillers and Chemical Corp. v. Industrial Condenser Corp., 184 USPQ 757 (TTAB 1974)--713.02

National Fidelity Life Insurance v. National Insurance Trust, 199 USPQ 691 (TTAB 1978)--530; 703.02(b); 709

National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212 (TTAB 1990)--528.01; 703.02(b)

OLD EDITION

National Patent Development Corp. v. Hercules Inc., 192 USPQ 491 (Comm'r 1976)--807

National Presto Industries, Inc., In re, 197 USPQ 188 (TTAB 1977)--703.02(b)

National Semiconductor Corp. v. Varian Associates, 184 USPQ 62 (TTAB 1974)--503.02

National Telefilm Associates, Inc. v. Craig Denney Productions, 228 USPQ 61 (Comm'r 1985)--545

Nationwide Industries Inc., In re, 6 USPQ2d 1882 (TTAB 1988)--1207.01

Nature's Way Products Inc. v. Nature's Herbs Inc., 9 USPQ2d 2077 (TTAB 1989)--528.06

Nestle Co. v. Joyva Corp., 227 USPQ 477 (TTAB 1985)--510.03(a); 528.03

Nestle Foods Corp. v. Kellogg Co., 6 USPQ2d 1145 (TTAB 1988)--527.05

Neville Chemical Co. v. Lubrizol Corp., 183 USPQ 184 (TTAB 1974)--319.04; 321; 402.01; 404.02; 405.03; 414; 415.03; 419; 523.01

Neville Chemical Co. v. Lubrizol Corp., 184 USPQ 689 (TTAB 1975)--402.02; 403.04; 416.04; 419; 509.01; 526

New York State Office of Parks and Recreation v. Atlas Souvenir & Gift Co., 207 USPQ 954 (TTAB 1980)--502.01; 507.03(b)

Newhoff Blumberg Inc. v. Romper Room Enterprises, Inc., 193 USPQ 313 (TTAB 1976)--502.03; 535.03

Newsday, Inc. v. Paddock Publications, Inc., 223 USPQ 1305 (TTAB 1984)--603; 1103; 1106

Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc., 9 USPQ2d 1061 (TTAB 1988), rev'd on other grounds, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989)--715

No Nonsense Fashions, Inc. v. Consolidated Foods Corp., 226 USPQ 502 (TTAB 1985)--502.01; 503.02

Northland Aluminum Products, Inc., In re, 221 USPQ 1110 (TTAB 1984), aff'd, 777 F.2d 1556, 227 USPQ 961 (Fed. Cir. 1985)--1207.02; 1207.03

Nuclear Research Corp., In re, 16 USPQ2d 1316 (TTAB 1990)--1207.03

NutraSweet Co. v. K & S Foods Inc., 4 USPQ2d 1964 (TTAB 1987)--512.02

O. M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976)--534.02; 703.02(a); 713.05

Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990)--507.02; 528.01

Of Counsel Inc. v. Strictly of Counsel Chartered, 21 USPQ2d 1555 (TTAB 1991)--405.01; 534.01; 701; 713.04; 718.02(a); 718.03(a)

OLD EDITION

Oland's Breweries [1971] Ltd. v. Miller Brewing Co., 189 USPQ 481 (TTAB 1975), aff'd, Miller Brewing Co. v. Oland's Breweries, 548 F.2d 349, 192 USPQ 266 (CCPA 1976)--419

Old Dutch Foods, Inc. v. Old Dutch Country House, Inc., 180 USPQ 659 (TTAB 1973)--703.02(a)

Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992)--528.01; 703.02(b)

Ole' Taco Inc. v. Tacos Ole, Inc., 221 USPQ 912 (TTAB 1984)--1101.01; 1106; 1107

O.M. Scott & Sons Co. v. Ferry-Morse Seed Co., 190 USPQ 352 (TTAB 1976)--405.01

Omaha National Corp., In re, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987)--101.02; 708

Omega SA v. Compucorp, 229 USPQ 191 (TTAB 1985)--704; 712.01

Opryland USA Inc., In re, 1 USPQ2d 1409 (TTAB 1986)--1209.01

Opryland USA Inc. v. Great American Music Show Inc., 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992)--303.02; 308.02(a); 528.01; 528.06

Opticians Ass'n of America v. Independent Opticians of America Inc., 734 F.Supp. 1176, 14 USPQ2d 2021 (D.N.J. 1990), rev'd on other grounds, 920 F.2d 187, 17 USPQ2d 1117 (3d Cir. 1990)--510.01; 510.02(a)

Original Appalachian Artworks Inc. v. Streeter, 3 USPQ2d 1717 (TTAB 1987)--707; 708

Original Red Plate Co., In re, 223 USPQ 836 (TTAB 1984)--1208

Orion Group Inc. v. Orion Insurance Co. P.L.C., 12 USPQ2d 1923 (TTAB 1989)--404.03(c)(1); 520; 528.06; 532; 713.02; 714.15

Ortho Pharmaceutical Corp. v. Hudson Pharmaceutical Corp., 178 USPQ 429 (TTAB 1973)--509.01; 510.02(a); 540; 705.02; 708

Ortho Pharmaceutical Corp. v. Schattner, 184 USPQ 556 (TTAB 1975)--402.02; 419; 509.01

Osage Oil & Transportation, Inc. v. Standard Oil Co., 226 USPQ 905 (TTAB 1985)--704; 707; 711

Other Telephone Co. v. Connecticut National Telephone Co., 181 USPQ 125 (TTAB 1974), petition denied, 181 USPQ 779 (Comm'r 1974)--510.02(a); 535.02

Otis Elevator Co. v. Echlin Manufacturing Co., 187 USPQ 310 (TTAB 1975)--708

Outdoor Sports Industries, Inc. v. Joseph & Feiss Co., 177 USPQ 533 (Comm'r 1973)--905

Over the Rainbow, Ltd. v. Over the Rainbow, Inc., 227 USPQ 879 (TTAB 1985)--1101.01; 1102.02(a)(2)

Oxford Pendaflex Corp. v. Roladex Corp., 204 USPQ 249 (TTAB 1979)--509.01

OLD EDITION

Oxy Metal Industries Corp. v. Technic, Inc., 189 USPQ 57 (TTAB 1975), summ. judgment granted, 191 USPQ 50 (TTAB 1976)--528.05(a); 528.05(e); 715

Oxy Metal Industries Corp. v. Transene Co., 196 USPQ 845 (TTAB 1977)--713.02

P.A.B. Produits et Appareils de Beaute v. Satinine Societa In Nome Collettivo di S.A. e.M. Usellini, 570 F.2d 328, 196 USPQ 801 (CCPA 1978)--321; 412.03; 507.03(b)

Packaging Industries Group, Inc. v. Great American Marketing, Inc., 227 USPQ 734 (TTAB 1985)--710

PacTel Teletrac v. T.A.B. Systems, 32 USPQ2d 1668 (TTAB 1994)--312.03

Pagan-Lewis Motors, Inc. v. Superior Pontiac, Inc., 216 USPQ 897 (TTAB 1982)--1107

Palisades Pageants, Inc. v. Miss America Pageant, 442 F.2d 1385, 169 USPQ 790 (CCPA 1971), cert. denied, 404 U.S. 938, 171 USPQ 641 (1971)--901.02(a); 905

Pamex Foods, Inc., In re, 209 USPQ 275 (Comm'r 1980)--514.01

Pamex Foods, Inc. v. Clover Club Foods Co., 201 USPQ 308 (TTAB 1978)--709; 710

Pan-O-Gold Baking Co., In re, 20 USPQ2d 1761 (TTAB 1991)--703.02(b)

Paolo's Associates Limited Partnership v. Paolo Bodo, 21 USPQ2d 1899 (Comm'r 1990)--317.01; 317.02; 317.03; 502.06

Paramount Pictures Corp. v. Romulan Invasions, 7 USPQ2d 1897 (TTAB 1988)--713.11

Paramount Pictures Corp. v. White, 31 USPQ2d 1768 (TTAB 1994)--102.01; 528.07(a)

Parker Brothers v. Tuxedo Monopoly, Inc., 225 USPQ 1222 (TTAB 1984)--528.04

Parker Brothers v. Tuxedo Monopoly, Inc., 757 F.2d 254, 226 USPQ 11 (Fed. Cir. 1985)--901.02(a)

Pass & Seymour, Inc. v. Syrelec, 224 USPQ 845 (TTAB 1984)--707; 708; 713.09; 718.03(c); 718.04

Pebble Beach Co., In re, 19 USPQ2d 1687 (TTAB 1991)--1214

Pegasus Petroleum Corp. v. Mobil Oil Corp., 227 USPQ 1040 (TTAB 1985)--311; 503.04; 504.03; 507.02; 510.03(a)

Pencils Inc., In re, 9 USPQ2d 1410 (TTAB 1988)--1207.03

Pennsylvania Fashion Factory, Inc. v. Fashion Factory, Inc., 215 USPQ 1133 (TTAB 1982)--512.01; 1102.02(a)(3)

Pennwalt Corp. v. Sentry Chemical Co., 219 USPQ 542 (TTAB 1983)--308.02(a)

Pennzoil Products Co., In re, 20 USPQ2d 1753 (TTAB 1991)--1207.01; 1207.02; 1207.03

OLD EDITION

Penthouse International Ltd. v. Dyn Electronics, Inc., 184 USPQ 117 (TTAB 1974)--523.02

Perfect Film & Chemical Corp. v. Society Ordinastral, 172 USPQ 696 (TTAB 1972)--509.01; 535.02

Perfect Fit Industries, Inc., In re, 223 USPQ 92 (TTAB 1984)--1215

Perma Ceram Enterprises Inc. v. Preco Industries Ltd., 23 USPQ2d 1134 (TTAB 1992)--321; 512.02; 512.03; 528.07(b)

Permatex Co. v. California Tube Products, Inc., 175 USPQ 764 (TTAB 1972)--313

Personnel Data Systems Inc. v. Parameter Driven Software Inc., 20 USPQ2d 1863 (TTAB 1991)--318.02(b); 514.03

Person's Co. v. Christman, 900 F.2d 1565, 14 USPQ2d 1477 (Fed. Cir. 1990)--102.01; 308.02(a); 312.03; 419; 901.02(a); 1107

Pet Inc. v. Bassetti, 219 USPQ 911 (TTAB 1983)--528.05(a)

Peters Sportswear Co. v. Peter's Bag Corp., 187 USPQ 647 (TTAB 1975)--703.02(a)

Petersen Manufacturing Co., In re, 2 USPQ2d 2032 (TTAB 1987)--1214

Peterson Manufacturing Co., In re, 229 USPQ 466 (TTAB 1986)--1208

Peterson's Ltd. v. Consolidated Cigar Corp., 183 USPQ 559 (TTAB 1974)--504.01; 528.02

Petite Suites Inc., In re 21 USPQ2d 1708 (Comm'r 1991)--1218

Pfaltzgraf v. William Davies Co., 175 USPQ 620 (TTAB 1972)--535.02; 535.03

Philip Morris Inc. v. Brown & Williamson Tobacco Corp., 230 USPQ 172 (TTAB 1986)--531; 715

Philip Morris Inc. v. Liggett & Myers Tobacco Co., 139 USPQ 240 (TTAB 1963)--703.02(a)

Philip Morris Inc. v. Reemtsma Cigarettenfabriken GmbH, 14 USPQ2d 1487 (TTAB 1990)--703.02(a)

Phillips Petroleum Co. v. C. J. Webb, Inc., 442 F.2d 1376, 170 USPQ 35 (CCPA 1971)--704

Phillips-Van Heusen Corp., In re, 228 USPQ 949 (TTAB 1986)--703.02(a); 703.02(b)

Pickering & Co. v. Bose Corp., 174 USPQ 172 (Comm'r 1972)--209.03

Pierce Foods Corp., In re, 230 USPQ 307 (TTAB 1986)--1201.02; 1205

Pierce Foods Corp. v. Mountain Mamma, Inc., 183 USPQ 380 (TTAB 1974)--535.02

Pierre Fabre S.A., In re, 221 USPQ 1210 (TTAB 1984)--1207.01

Pillsbury Co., In re, 174 USPQ 318 (TTAB 1972)--1208

OLD EDITION

Pinocchio's Pizza Inc. v. Sandra Inc., 11 USPQ2d 1227 (TTAB 1989)--712.01; 1101.01; 1102.02(a)(3)

Place for Vision, Inc. v. Pearle Vision Center, Inc., 218 USPQ 1022 (TTAB 1983)--1102.02(a)(4)

Plak-Shack, Inc. v. Continental Studios of Georgia, Inc., 204 USPQ 242 (TTAB 1979)--703.02(a)

Plus Products v. Con-Stan Industries, Inc., 221 USPQ 1071 (Comm'r 1984)--114.08

Plus Products v. Don Hall Laboratories, 191 USPQ 584 (TTAB 1976)--709; 710

Plus Products v. General Mills, Inc., 188 USPQ 520 (TTAB 1975)--717

Plus Products v. Medical Modalities Associates, Inc., 211 USPQ 1199 (TTAB 1981), set aside on other grounds and new decision entered, 217 USPQ 464 (TTAB 1983)--511

Plus Products v. Medical Modalities Associates, Inc., 217 USPQ 464 (TTAB 1983)--541; 802.04; 803

Plus Products v. Natural Organics, Inc., 204 USPQ 773 (TTAB 1979)--703.02(a); 707; 708; 710

Plus Products v. Physicians Formula Cosmetics, Inc., 198 USPQ 111 (TTAB 1978)--540; 705.02; 706.02

Plus Products v. Redken Laboratories, Inc., 199 USPQ 111 (TTAB 1978)--507.03(b)

Plus Products v. Sterling Food Co., 188 USPQ 586 (TTAB 1975)--710; 712.01

Pohn, In re, 3 USPQ2d 1700 (Comm'r 1987)--215; 307.07

Polaroid Corp. v. Opto Specs, Ltd., 181 USPQ 542 (TTAB 1974)--419

Pony International Inc., In re, 1 USPQ2d 1076 (Comm'r 1986)--1201.05

PRD Electronics Inc. v. Pacific Roller Die Co., 169 USPQ 318 (TTAB 1971)--404.03(b)(2); 713.06(b)

Precision Tune Inc. v. Precision Auto-Tune Inc., 4 USPQ2d 1095 (TTAB 1987)--603; 1106; 1109

Presto Products Inc. v. Nice-Pak Products Inc., 9 USPQ2d 1895 (TTAB 1988)--527.05

Primal Feeling Center of New England, Inc. v. Janov, 201 USPQ 44 (TTAB 1978)--718.03(c)

Procter & Gamble Co. v. Keystone Automotive Warehouse, Inc., 191 USPQ 468 (TTAB 1976)--523.04; 527.05

Procter & Gamble Co. v. Sentry Chemical Co., 22 USPQ2d 1589 (TTAB 1992)--901.02(a)

Proctor & Gamble Co. v. Johnson & Johnson Inc., 485 F. Supp. 1185, 205 USPQ 697 (S.D.N.Y. 1979), aff'd without opinion, 636 F.2d 1203 (2d Cir. 1980)--535.02

Pro-Cuts v. Schilz-Price Enterprises Inc., 27 USPQ2d 1224 (TTAB 1993)--512.01; 513.01; 1102.02(a)(3); 1103; 1106; 1107; 1112

OLD EDITION

Professional Learning Centers, Inc., In re, 230 USPQ 70 (TTAB 1986)--1215

Pure Gold, Inc. v. Syntex (U.S.A.) Inc., 221 USPQ 151 (TTAB 1983), aff'd, 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984)--503.03; 528.05(d); 703.02(b)

Pure Gold, Inc. v. Syntex (U.S.A.), Inc., 739 F.2d 624, 222 USPQ 741 (Fed. Cir. 1984)--528.01; 528.06

Pyco, Inc. v. Pico Corp., 165 USPQ 221 (TTAB 1969)--206.03; 303.05(c); 512.04

Pyttronic Industries Inc. v. Terk Technologies Corp., 16 USPQ2d 2055 (TTAB 1990)--319.01; 406.03(d); 406.03(e)

Quaker Oats Co. v. Acme Feed Mills, Inc., 192 USPQ 653 (TTAB 1976)--707; 712.01; 718.02(b)

Questor Corp. v. Dan Robbins & Associates, Inc., 199 USPQ 358 (TTAB 1978), aff'd, 599 F.2d 1009, 202 USPQ 100 (CCPA 1979)--411.01; 707; 708; 718.02(a)

R. J. Reynolds Tobacco Co. v. Brown & Williamson Tobacco Corp., 226 USPQ 169 (TTAB 1985)--708

Rainbow Carpet, Inc. v. Rainbow International Carpet Dyeing & Cleaning Co., 226 USPQ 718 (TTAB 1985)--502.01; 504.01; 528.02

Raker Paint Factory v. United Lacquer Mfg. Corp., 141 USPQ 407 (TTAB 1964)--206.03; 303.05(c); 512.04

Randall and Hustedt, In re, 226 USPQ 1031 (TTAB 1985)--1203.02(c)

Ratny, In re, 24 USPQ2d 1713 (Comm'r 1992)--1002

Red Carpet Corp. v. Johnstown American Enterprises, Inc., 7 USPQ2d 1404 (TTAB 1988)--703.02(b)

Refac International Ltd. v. Hitachi Ltd., 921 F.2d 1247, 16 USPQ2d 1347 (Fed. Cir. 1990)--529.01

Reflange Inc. v. R-Con International, 17 USPQ2d 1125 (TTAB 1990)--311; 321; 507.03(b); 514.03; 718.04; 802.07

Refreshment Machinery Inc. v. Reed Industries, Inc., 196 USPQ 840 (TTAB 1977)--527.05

Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991)--317.01; 317.03; 511; 545

Regent Baby Products Corp. v. Dundee Mills, Inc., 199 USPQ 571 (TTAB 1978)--317.02

Regent Standard Forms, Inc. v. Textron Inc., 172 USPQ 379 (TTAB 1971)--707

Rent A Boxx Moving Systems Inc., In re, 25 USPQ2d 1399 (Comm'r 1992)--905

Republic Steel Co. v. M.P.H. Manufacturing Corp., 312 F.2d 940, 136 USPQ 447 (CCPA 1963)--313

OLD EDITION

Revco, D.S., Inc. v. Armour-Dial, Inc., 170 USPQ 48 (TTAB 1971)--312.03; 318.02(b)

R.G. Barry Corp. v. Mushroom Makers, Inc., 609 F.2d 1002, 204 USPQ 195 (CCPA 1979)--901.02(a)

Rhone-Poulenc Industries v. Gulf Oil Corp., 198 UPSQ 372 (TTAB 1978)--403.01; 403.02; 404.01; 404.02; 404.03(c)(1); 521

Riceland Foods Inc. v. Pacific Eastern Trading Corp., 26 USPQ2d 1883 (TTAB 1993)--321; 507.03(b); 703.02(b); 707; 710

Riddle, In re, 225 USPQ 630 (TTAB 1985)--1201.04

Riko Enterprises, Inc. v. Lindsley, 198 USPQ 480 (Comm'r 1977)--509.01

Rimmel, Ltd. v. Romel Cosmetics, Inc., 172 USPQ 186 (TTAB 1971)--312.03; 318.02(b)

Rite Aid Corp. v. Rite-Way Discount Corp., 182 USPQ 698 (TTAB 1974), aff'd, 508 F.2d 828, 184 USPQ 351 (CCPA 1975)--528.05(b)

Roberts Properties, Inc. v. Rumby International, Inc., 212 USPQ 302 (TTAB 1981)--101.03

Rogers Corp. v. Fields Plastics & Chemicals, Inc., 172 USPQ 377 (TTAB 1972)--709; 718.02(b)

Rolex Watch U.S.A., Inc. v. Madison Watch Co., 211 USPQ 352 (TTAB 1981)--206.02

Ronson Corp. v. Ronco Teleproducts, Inc., 197 USPQ 492 (Comm'r 1978)--541; 802.04; 803

Rosso & Mastracco, Inc. v. Giant Food Inc., 720 F.2d 1263, 219 USPQ 1050 (Fed. Cir. 1983)--303.03; 1101.02; 1102.02(a)(3)

Rowell Laboratories, Inc. v. Canada Packers Inc., 215 USPQ 523 (TTAB 1982)--509.01

Royal Hawaiian Perfumes, Ltd. v. Diamond Head Products of Hawaii, Inc., 204 USPQ 144 (TTAB 1979)
--703.02(a)

Royal Viking Line A/S, In re, 216 USPQ 795 (TTAB 1982)--1207.01; 1207.02

S & L Acquisition Co. v. Helene Arpels Inc., 9 USPQ2d 1221 (TTAB 1987)--319.04; 502.03; 512.01; 528.04

S. C. Johnson & Son, Inc. v. GAF Corp., 177 USPQ 720 (TTAB 1973)--506.01

S. D. Fabrics, Inc., In re, 223 USPQ 56 (TTAB 1984)--1218

S. Rudofker's Sons, Inc. v. "42" Products, Ltd., 161 USPQ 499 (TTAB 1969)--404.02; 415.03; 718.03(d)

S. S. Kresge Co. v. J-Mart Industries, Inc., 178 USPQ 124 (TTAB 1973)--713.13

Safeway Stores, Inc. v. Captn's Pick, Inc., 203 USPQ 1025 (TTAB 1979)--710

OLD EDITION

San Diego National League Baseball Club, Inc., In re, 224 USPQ 1067 (TTAB 1983)--1214

Sarkli, Ltd., In re, 721 F.2d 353, 220 USPQ 111 (Fed. Cir. 1983)--712.04

SCOA Industries Inc. v. Kennedy & Cohen, Inc., 188 USPQ 411 (TTAB 1975)--510.02(a); 1102.02(a)(3)

Scotch Whiskey Ass'n v. United States Distilled Products Co., 13 USPQ2d 1711 (TTAB 1989), recon. denied, 17 USPQ2d 1240 (TTAB 1990)--102.01

Scotch Whiskey Ass'n v. United States Distilled Products Co., 18 USPQ2d 1391 (TTAB 1991), rev'd on other grounds, 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991)--102.01; 502.04; 502.06

Scotch Whiskey Ass'n v. United States Distilled Products Co., 952 F.2d 1317, 21 USPQ2d 1145 (Fed. Cir. 1991)--312.03; 503.02

Scripps Clinic & Research Foundation v. Genentech Inc., 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991)--528.01

SDT Inc. v. Patterson Dental Co., 30 USPQ2d 1701 (TTAB 1994)--106.03; 206.02; 303.05(a); 303.05(b); 304; 307.01; 502.03; 510.03(a); 512.01

Seabrook Foods, Inc. v. Bar-Well Foods Ltd., 568 F.2d 1342, 196 USPQ 289 (CCPA 1977)--703.02(b)

Sealed Air Corp. v. Scott Paper Co., 190 USPQ 106 (TTAB 1975)--318.02(b); 319.01

Seaman & Associates Inc., In re, 1 USPQ2d 1657 (TTAB 1986)--1215

See's Candy Shops Inc. v. Campbell Soup Co., 12 USPQ2d 1395 (TTAB 1989)--319.04; 507.02

Selfway, Inc. v. Travelers Petroleum, Inc., 579 F.2d 75, 198 USPQ 271 (CCPA 1978)--1101.02

Seligman & Latz, Inc. v. Merit Mercantile Corp., 222 USPQ 720 (TTAB 1984)--523.04; 527.01; 718.03(d)

Selva & Sons, Inc. v. Nina Footwear, Inc., 705 F.2d 1316, 217 USPQ 641 (Fed. Cir. 1983)--102.01; 303.03; 503.04; 504.03; 528.04

Sentrol, Inc. v. Sentex Systems, Inc., 231 USPQ 666 (TTAB 1986)--402.03; 412.01

1776, Inc., In re, 223 USPQ 186 (TTAB 1984)--1214

Shakespeare Co. v. Silstar Corp. of America Inc., 9 F.3d 1091, 28 USPQ2d 1765 (4th Cir. 1993)--308.02(a)

Shalom Children's Wear Inc. v. In-Wear A/S, 26 USPQ2d 1516 (TTAB 1993)--528.01; 528.05(b)

Sheller-Globe Co. v. Scott Paper Co., 204 USPQ 329 (TTAB 1979)--703.02(a)

Shoe Factory Supplies Co. v. Thermal Engineering Co., 207 USPQ 517 (TTAB 1980)--527.05

OLD EDITION

Siemens Aktiengesellschaft, In re, 34 USPQ2d 1862 (Comm'r 1995)--216

Signal Companies v. Southwestern Petroleum Corp., 181 USPQ 599 (TTAB 1973)--514.03

Simoniz Co., Ex parte, 161 USPQ 365 (Comm'r 1969)--1218

Simulations Publications, Inc., In re, 521 F.2d 797, 187 USPQ 147 (CCPA 1975)--706.02

Sinclair Manufacturing Co. v. Les Parfums de Dana, Inc., 191 USPQ 292 (TTAB 1976)--703.02(a)

Slater, In re, 231 USPQ 497 (Comm'r 1985)--115.02

Small v. Weiffenbach, 10 USPQ2d 1898 (Comm'r 1989)--115.02

Smith & Mehaffey, In re, 31 USPQ2d 1531 (TTAB 1994)--703.02(b)

Smith International, Inc. v. Olin Corp., 201 USPQ 250 (TTAB 1978)--401; 403.01; 403.02; 404.01; 404.02; 408.01

Smith Kline & French Laboratories v. USV Pharmaceutical Corp., 175 USPQ 666 (TTAB 1972)--507.03(b)

Snuffer & Watkins Management Inc. v. Snuffy's Inc., 17 USPQ2d 1815 (TTAB 1990)--311; 318.02(b); 319.01; 1101.02

Societe Anonyme Marne et Champagne v. Myers, 250 F.2d 374, 116 USPQ 153 (CCPA 1957)--703.02(a)

Societe Des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L., 10 USPQ2d 1241 (TTAB 1989)--528.01; 528.07(a)

Societe Des Produits Nestle S.A., In re, 17 USPQ2d 1093 (Comm'r 1990)--202.01; 206.01; 207.02; 207.03; 208; 209.04

Societe des Produits Nestle S.A. v. Basso Fedele & Figli, 24 USPQ2d 1079 (TTAB 1992)--117.01; 218; 307.11; 512.01; 602.01

Societe Nationale Industrielle Aerospatiale v. U.S. District Court for the Southern District of Iowa, 482 U.S. 522 (1987)--404.03(c)(2)

Software Development Systems, Inc., In re, 17 USPQ2d 1094 (Comm'r 1989)--206.01; 207.02; 207.03; 208

Sotheby's Inc., In re, 18 USPQ2d 1969 (Comm'r 1989)--509.01; 545

Southwire Co. v. Kaiser Aluminum & Chemical Corp., 196 USPQ 566 (TTAB 1977)--711

Sovran Financial Corp., In re, 25 USPQ2d 1537 (Comm'r 1992)--104; 124; 219; 1206.01

Spa International, Inc. v. European Health Spa, Inc., 184 USPQ 747 (TTAB 1975)--523.01; 527.01

OLD EDITION

Space Base Inc. v. Stadis Corp., 17 USPQ2d 1216 (TTAB 1990)--318.02(b); 503.02; 507.02; 514.03; 529.01

Spang Industries, Inc., In re, 225 USPQ 888 (Comm'r 1985)--206.01; 206.02; 207.02; 207.03; 208

Specialty Brands, Inc. v. Coffee Bean Distributors, Inc., 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984)--703.01; 704

Spectra Corp. v. Lutz, 839 F.2d 1579, 5 USPQ2d 1867 (Fed. Cir. 1988)--528.06

Spice Islands, Inc. v. Frank Tea and Spice Co., 505 F.2d 1293, 184 USPQ 35 (CCPA 1974)--703.02(b)

Spoons Restaurants Inc. v. Morrison Inc., 23 USPQ2d 1735 (TTAB 1990)--709

Sprague Electric Co. v. Electrical Utilities Co., 209 USPQ 88 (TTAB 1980)--712.01; 712.03

Spraying Systems Co. v. Delavan Inc., 975 F.2d 387, 24 USPQ2d 1181 (7th Cir. 1992)--901.01

Springs Industries, Inc. v. Bumblebee Di Stefano Ottina & C.S.A.S., 222 USPQ 512 (TTAB 1984)--503.02

Sprinklets Water Center Inc. v. McKesson Corp., 25 USPQ2d 1441 (E.D.Mich. 1992)--528.08

Squirrel Brand Co. v. Barnard Nut Co., 101 USPQ 340 (Comm'r 1954)--510.02(a)

St. Louis Janitor Supply Co. v. Abso-Clean Chemical Co., 196 USPQ 778 (TTAB 1977)--703.03

Stabilisierrungsfonds fur Wein v. Zimmermann-Graeff KG, 199 USPQ 488 (TTAB 1978)--503.02

Stagecoach Properties, Inc. v. Wells Fargo & Co., 199 USPQ 341 (TTAB 1978), aff'd, 685 F.2d 302, 216 USPQ 480 (9th Cir. 1982)--701; 703.02(a)

Standard Brands Inc. v. Peters, 191 USPQ 168 (TTAB 1975)--321

Stanspec Co. v. American Chain & Cable Co., 531 F.2d 563, 189 USPQ 420 (CCPA 1976)--308.02(c)(2); 503.02; 901.02(a)

State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc., 190 USPQ 25 (TTAB 1976)--703.02(a)

Steiger Tractor, Inc. v. Steiner Corp., 221 USPQ 165 (TTAB 1984), different results reached on reh'g, 3 USPQ2d 1708 (TTAB 1984)--405.01; 534.02; 709; 710; 713.05

Steiger Tractor Inc. v. Steiner Corp., 3 USPQ2d 1708 (TTAB 1984)--544

Stenographic Machines, Inc., In re, 199 USPQ 313 (Comm'r 1978)--1201.05

Sterling Drug Inc. v. Sebring, 515 F.2d 1128, 185 USPQ 649 (CCPA 1975)--419

OLD EDITION

Stockpot, Inc. v. Stock Pot Restaurant, Inc., 220 USPQ 52 (TTAB 1983), aff'd, Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984)--502.01; 713.06(a)

Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 222 USPQ 665 (Fed. Cir. 1984)--1101.02

Strang Corp. v. Stouffer Corp., 16 USPQ2d 1309 (TTAB 1990)--112; 308.02(a); 308.02(b); 403.01; 502.03; 528.06

Su Wung Chong, In re, 20 USPQ2d 1399 (Comm'r 1991)--206.01; 207.02; 207.03; 208

Sun Refining & Marketing Co., In re, 23 USPQ2d 1072 (TTAB 1991)--1102.02(a)(3)

Sunbeam Corp. v. Battle Creek Equipment Co., 216 USPQ 1101 (TTAB 1982)--704

Sunbeam Corp. v. Duro Metal Products Co., 106 USPQ 385 (Comm'r 1955)--308.02(c)(1); 319.03

Sunkist Growers, Inc. v. Benjamin Ansehl Co., 221 USPQ 1077 (Comm'r 1984)--114.08

Sunkist Growers, Inc. v. Benjamin Ansehl Co., 229 USPQ 147 (TTAB 1985)--402.02; 419; 509.01; 527.05

Sunnen Products Co. v. Sunex International Inc., 1 USPQ2d 1744 (TTAB 1987)--703.02(a)

Sunway Fruit Products, Inc. v. Productos Caseros, S. A., 130 USPQ 33 (Comm'r 1960)--310.02; 319.02

Super Valu Stores Inc. v. Exxon Corp., 11 USPQ2d 1539 (TTAB 1989)--527.05

Sweats Fashions Inc. v. Pannill Knitting Co., 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987)--528.01; 528.05(b); 528.06

Syndicat de la Parfumerie Francaise v. Scaglia, 173 USPQ 383 (TTAB 1972)--503.02

Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc., 14 USPQ2d 1879 (TTAB 1990)--319.03; 535.03; 606

Syosset Laboratories, Inc. v. TI Pharmaceuticals, 216 USPQ 330 (TTAB 1982)--313; 317.03; 545

Taffy's of Cleveland, Inc. v. Taffy's, Inc., 189 USPQ 154 (TTAB 1975)--312.03; 318.02(b); 321; 507.03(b)

Tamarkin Co. v. Seaway Food Town Inc., 34 USPQ2d 1587 (TTAB 1995)--1101.01; 1102.02(a)(2); 1102.02(a)(3)

Taverniti, SARL, In re, 225 USPQ 1263 (TTAB 1985)--1218

Taverniti, SARL, In re, 228 USPQ 975 (TTAB 1985)--1218

Taylor Brothers, Inc. v. Pinkerton Tobacco Co., 231 USPQ 412 (TTAB 1986)--528.05(b); 528.06

TBC Corp. v. Grand Prix Ltd., 12 USPQ2d 1311 (TTAB 1989)--319.04; 502.04

OLD EDITION

TBC Corp. v. Grand Prix Ltd., 16 USPQ2d 1399 (TTAB 1990)--419

Techex, Ltd. v. Dvorkovitz, 220 USPQ 81 (TTAB 1983)--713.13

Techsonic Industries, Inc., In re, 216 USPQ 619 (TTAB 1982)--206.03; 303.05(c); 512.04

Tektronix, Inc. v. Daktronics, Inc., 534 F.2d 915, 189 USPQ 693 (CCPA 1976)--703.02(b)

Tektronix, Inc. v. Daktronics, Inc., 187 USPQ 588 (TTAB 1975), aff'd, 534 F.2d 915, 189 USPQ 693 (CCPA 1976)--509.01; 540; 705.02

Tektronix, Inc. v. Tek Associates, Inc., 183 USPQ 623 (TTAB 1974)--402.03; 412.01

Tel-E-Gift Corp. v. Teleflora Inc., 193 USPQ 254 (TTAB 1976)--535.02

Tennessee Walking Horse Breeders' and Exhibitors' Ass'n, In re, 223 USPQ 188 (TTAB 1984)--1203.02(b); 1203.02(d); 1209.01

Terra Products Corp. v. Comez, 206 USPQ 1033 (TTAB 1979)--509.01

Tetrafluor Inc., In re, 17 USPQ2d 1160 (Comm'r 1990)--1201.05

Texas Instruments Inc. v. Conklin Instrument Corp., 161 USPQ 740 (TTAB 1969)--312.01

Texsun Tire and Battery Stores, Inc., In re, 229 USPQ 227 (TTAB 1986)--1209.02

Textron Inc. v. Arctic Enterprises, Inc., 178 USPQ 315 (TTAB 1973)--704

Textron, Inc. v. Gillette Co., 177 USPQ 530 (Comm'r 1973)--512.04

Textron, Inc. v. Gillette Co., 180 USPQ 152 (TTAB 1973)--318.02(c); 506.01

Thriftimart, Inc. v. Scot Lad Foods, Inc., 207 USPQ 330 (TTAB 1980)--1102.02(a)(3); 1104

Thrifty Corp. v. Bomax Enterprises, 228 USPQ 62 (TTAB 1985)--317.02; 318.02(a)

Tiffany & Co. v. Classic Motor Carriages Inc., 10 USPQ2d 1835 (TTAB 1989)--713.08

Tiffany & Co. v. Columbia Industries, Inc., 455 F.2d 582, 173 USPQ 6 (CCPA 1972)--703.02(a)

Tilcon Warren, Inc., In re, 221 USPQ 86 (TTAB 1984)--703.02(a)

Times Mirror Magazines, Inc. v. Sutcliff, 205 USPQ 656 (TTAB 1979)--706.01

Tokaido v. Honda Associates Inc., 179 USPQ 861 (TTAB 1973)--206.02; 510.02(a)

Tong Yang Cement Corp., In re, 19 USPQ2d 1689 (TTAB 1991)--206.03; 303.05(c); 512.04

Tonka Corp. v. Tonka Tools, Inc., 229 USPQ 857 (TTAB 1986)--319.03; 512.01; 528.08

OLD EDITION

Toro Co. v. Hardigg Industries, Inc., 187 USPQ 689 (TTAB 1975), rev'd on other grounds, 549 F.2d 785, 193 USPQ 149 (CCPA 1977)--510.02(a)

Towers, Perrin, Forster & Crosby Inc. v. Circle Consulting Group Inc., 16 USPQ2d 1398 (TTAB 1990)--406.03(e); 519

Townley Clothes, Inc. v. Goldring, Inc., 100 USPQ 57 (Comm'r 1953)--510.02(a)

Trademark Registration of Mc Lachlan Touch Inc., In re, 6 USPQ2d 1395 (Comm'r 1987)--216; 307.10

Trans Union Corp. v. Trans Leasing International, Inc., 200 USPQ 748 (TTAB 1978)--321; 507.03(b)

Treadwell's Drifters Inc. v. Marshak, 18 USPQ2d 1318 (TTAB 1990)--308.02(a)

Triumph Machinery Co. v. Kentmaster Manufacturing Co., 1 USPQ2d 1826 (TTAB 1987)--710

Tudor Square Sportswear, Inc. v. Pop-Op Corp., 160 USPQ 50 (TTAB 1968)--1004

Tuvache, Inc. v. Emilio Pucci Perfumes International, Inc., 263 F.Supp. 104, 152 USPQ 574 (S.D.N.Y. 1967)--510.02(a)

Tuxedo Monopoly, Inc. v. General Mills Fun Group, Inc., 648 F.2d 1335, 209 USPQ 986 (CCPA 1981)--712.04

UMC Industries, Inc. v. UMC Electronics Co., 207 USPQ 861 (TTAB 1980)--308.02(c)(1); 319.03

Unico American Corp. v. Unico Banking Group, 223 USPQ 684 (Comm'r 1984)--114.08

Unicut Corp. v. Unicut, Inc., 220 USPQ 1013 (TTAB 1983)--408.03; 522; 527.01

Unicut Corp. v. Unicut, Inc., 222 USPQ 341 (TTAB 1984)--317.02; 412.01; 527.01

Unistar Radio Networks Inc., In re, 30 USPQ2d 1390 (Comm'r 1993)--905

Unitec Industries, Inc. v. Cumberland Corp., 176 USPQ 62 (TTAB 1972)--703.02(a)

United Foods Inc. v. J.R. Simplot Co., 4 USPQ2d 1172 (TTAB 1987)--703.02(b)

United Rum Merchants Ltd. v. Distillers Corp. (S.A.) Ltd., 9 USPQ2d 1481 (TTAB 1988)--602.02(b)

United Rum Merchants Ltd. v. Fregal, Inc., 216 USPQ 217 (TTAB 1982)--718.04

United States Mineral Products Co. v. GAF Corp., 197 USPQ 301 (TTAB 1977)--321

United States National Bank of Oregon v. Midwest Savings and Loan Ass'n, 194 USPQ 232 (TTAB 1977)--712.01; 712.02; 712.03

United States Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984)--601.01; 601.02; 602.01; 605.03(e)

OLD EDITION

United States Olympic Committee v. O-M Bread Inc., 26 USPQ2d 1221 (TTAB 1993)--507.02; 528.07(b)

United States Olympic Committee v. O-M Bread Inc., 29 USPQ2d 1555 (TTAB 1993)--528.01

United States Plywood Corp. v. Modiglass Fibers, Inc., 125 USPQ 144 (TTAB 1960)--509.01

United States Shoe Corp. v. Kiddie Kobbler Ltd., 231 USPQ 815 (TTAB 1986)--321; 703.02(a)

United States Tobacco Co., In re, 1 USPQ2d 1502 (TTAB 1986)--1209.01

Universal Card Group Inc., In re, 25 USPQ2d 1157 (Comm'r 1992)--209.03

University Book Store v. University of Wisconsin Board of Regents, 33 USPQ2d 1385 (TTAB 1994)--528.01

University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)--712.01

University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983)--718.03(d)

U.S. Navy v. United States Manufacturing Co., 2 USPQ2d 1254 (TTAB 1987)--303.02; 538; 542.02

U.S. Olympic Committee v. Bata Shoe Co., 225 USPQ 340 (TTAB 1984)--321

U.S. Pioneer Electronics Corp. v. Evans Marketing, Inc., 183 USPQ 613 (Comm'r 1974)--206.03; 303.05(c); 512.04

U.S. Soil, Inc. v. Colovic, 214 USPQ 471 (TTAB 1982)--1101.02; 1111

U.S. West Inc. v. BellSouth Corp., 18 USPQ2d 1307 (TTAB 1990)--707; 708

Van Dyk Research Corp. v. Xerox Corp., 181 USPQ 346 (TTAB 1974)--402.02; 419

Van Dyne-Crotty Inc. v. Wear-Guard Corp., 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991)--507.02

Variable Speech Control Co., In re, 209 USPQ 431 (TTAB 1980)--1201.02

Varian Associates v. Fairfield-Noble Corp., 188 USPQ 581 (TTAB 1975)--402.01; 402.02; 412.01; 419; 523.02

Vesper Corp., In re, 8 USPQ2d 1788 (Comm'r 1988)--807; 1218

Village Inn Pizza Parlors, Inc. v. Los Tios Mexican Restaurants, Inc., 215 USPQ 476 (TTAB 1982)--1101.02

Visa International Service Association v. Life-Code Systems, Inc., 220 USPQ 740 (TTAB 1983)--528.08

OLD EDITION

Visual Information Institute, Inc. v. Vicon Industries Inc., 209 USPQ 179 (TTAB 1980)--527.05

Vitaline Corp. v. General Mills Inc., 891 F.2d 273, 13 USPQ2d 1172 (Fed. Cir. 1989)--318.02(b); 319.01; 319.04

Vita-Pakt Citrus Products Co. v. Cerro, 195 USPQ 78 (TTAB 1977)--703.02(a)

Volkswagenwerk Aktiengesellschaft v. Advance Welding & Mfg. Corp., 184 USPQ 367 (TTAB 1974)--509.01

Volkswagenwerk Aktiengesellschaft v. Clement Wheel Co., 204 USPQ 76 (TTAB 1979)--523.04; 527.05; 703.02(a); 718.04

Volkswagenwerk Aktiengesellschaft v. MTD Products Inc., 181 USPQ 471 (TTAB 1974)--419

Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 188 USPQ 690 (TTAB 1975)--414; 524.01; 527.04

Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 201 USPQ 404 (TTAB 1978)--708

Volkswagenwerk Aktiengesellschaft v. Ridewell Corp., 201 USPQ 410 (TTAB 1979)--544

Volkswagenwerk Aktiengesellschaft v. Thermo-Chem Corp., 176 USPQ 493 (TTAB 1973)--419

Volkswagenwerk Aktiengesellschaft v. Wheeler, 814 F.2d 812, 2 USPQ2d 1264 (1st Cir. 1987)--1211

Volvo White Truck Corp., In re, 16 USPQ2d 1417 (TTAB 1990)--1207.01

Von Schorlemer v. Baron Herm. Schorlemer Weinkellerei GmbH, 5 USPQ2d 1376 (TTAB 1986)--504.01; 528.01; 528.02

Vycom Electronics Ltd., In re, 21 USPQ2d 1799 (Comm'r 1986)--1213; 1218

W. R. Grace & Co. v. Arizona Feeds, 195 USPQ 670 (Comm'r 1977)--318.02(b); 506.01; 507.02

W. R. Grace & Co. v. Herbert J. Meyer Industries, Inc., 190 USPQ 308 (TTAB 1976)--703.02(b); 710

W. R. Grace & Co. v. Red Owl Stores, Inc., 181 USPQ 118 (TTAB 1973)--535.02; 535.03; 703.02(a)

W. T. Grant Co. v. Grant Avenue Fashions, Inc., 135 USPQ 273 (TTAB 1962)--704

Wagner Electric Corp. v. Raygo Wagner, Inc., 192 USPQ 33 (TTAB 1976)--708

Waifersong Ltd. Inc. v. Classic Music Vending, 976 F.2d 290, 24 USPQ2d 1632 (6th Cir. 1992)--317.03; 545

Walker-Home Petroleum, Inc., In re, 229 USPQ 773 (TTAB 1985)--1201.04

Wallyball, Inc., In re, 222 USPQ 87 (TTAB 1984)--1214; 1217

Watercare Corp. v. Midwesco-Enterprise, Inc., 171 USPQ 696 (TTAB 1971)--524.01; 524.04; 527.04

OLD EDITION

Wear-Guard Corp. v. Van Dyne-Crotty Inc., 18 USPQ2d 1804 (TTAB 1990), aff'd, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991)--709

Weather Channel, Inc., In re, 229 USPQ 854 (TTAB 1985)--1207.03

Weber-Stephen Products Co., In re, 3 USPQ2d 1659 (TTAB 1987)--1214

Weiffenbach v. Frank, 18 USPQ2d 1397 (Comm'r 1991)--114.04; 115.02

Weiffenbach v. Klempay, 29 USPQ2d 2027 (Dep't Comm. 1993)--114.03; 114.04; 115.02

Weiffenbach v. Logan, 27 USPQ2d 1870 (Comm'r 1993)--115.02

Weiffenbach v. Turner, 20 USPQ2d 1103 (Comm'r 1991)--115.02

Weiner King, Inc. v. Wiener King Corp., 615 F.2d 512, 204 USPQ 820 (CCPA 1980)--527.05; 1101.01; 1102.02(a)(3)

Wella A.G., In re, 230 USPQ 77 (TTAB 1986)--1209.01

Wella A.G., In re, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988)--1209.01

Wella Corp. v. California Concept Corp., 192 USPQ 158 (TTAB 1976), rev'd on other grounds, 558 F.2d 1019, 194 USPQ 419 (CCPA 1977)--703.02(b); 710

Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419 (CCPA 1977)--419; 712.01; 712.05

Wells Cargo, Inc. v. Wells Cargo, Inc., 606 F.2d 961, 203 USPQ 564 (CCPA 1979)--605.03(e)

Wells Fargo & Co., In re, 231 USPQ 95 (TTAB 1986)--1102.02(a)(3); 1207.02; 1207.03; 1209.02

Wells Fargo & Co., In re, 231 USPQ 106 (TTAB 1986)--1102.02(a)(3); 1203.02(b)

Wells Fargo & Co., In re, 231 USPQ 116 (TTAB 1986)--1209.02

Wells Fargo & Co. v. Lundeen & Associates, 20 USPQ2d 1156 (TTAB 1991)--502.03; 503.04

West End Brewing Co. of Utica, N.Y. v. South Australian Brewing Co., 2 USPQ2d 1306 (TTAB 1987)--515; 709; 710

West Point-Pepperell, Inc. v. Borlan Industries Inc., 191 USPQ 53 (TTAB 1976)--703.02(a)

Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery, 17 USPQ2d 1137 (TTAB 1990)--308.01; 308.02(b); 502.03; 503.01; 504.01; 504.03; 506.01; 506.02; 512.01

Weyerhaeuser Co. v. Katz, 24 USPQ2d 1230 (TTAB 1992)--502.01; 703.02(a); 703.02(b); 703.03; 707; 708; 718.02(b); 718.02(c)

Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971)--510.02(a)

OLD EDITION

Wilderness Group, Inc. v. Western Recreational Vehicles, Inc., 222 USPQ 1012 (TTAB 1984)--515; 710

William & Scott Co. v. Earl's Restaurants Ltd., 30 USPQ2d 1871 (TTAB 1994)--503.01; 512.01

Williams v. Five Platters, Inc., 181 USPQ 409 (TTAB 1974), aff'd, 510 F.2d 963, 184 USPQ 744 (CCPA 1975)--317.03; 545

Williams v. Five Platters, Inc., 510 F.2d 963, 184 USPQ 744 (CCPA 1975)--509.01; 901.02(a)

Williamson-Dickie Manufacturing Co. v. Mann Overall Company, 359 F.2d 450, 149 USPQ 518 (CCPA 1966)--308.02(c)(1); 310.01; 310.02; 310.04; 312.01; 319.02; 319.03

Wilson Sporting Goods Co. v. Northwestern Golf Co., 169 USPQ 510 (TTAB 1971)--509.01

WMA Group Inc. v. Western International Media Corp., 29 USPQ2d 1478 (TTAB 1993)--512.02

Women's World Shops Inc. v. Lane Bryant Inc., 5 USPQ2d 1985 (TTAB 1988)--1101.01; 1107

World Hockey Ass'n v. Tudor Metal Products Corp., 185 USPQ 246 (TTAB 1975)--306; 511

Wright Line Inc. v. Data Safe Services Corp., 229 USPQ 769 (TTAB 1985)--712.03; 718.03(c); 718.04

WSM, Inc., In re, 225 USPQ 883 (TTAB 1985)--541

Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988)--101.01; 102.03; 301; 401; 702; 1217

Yamaha International Corp. v. Stevenson, 196 USPQ 701 (TTAB 1979)--703.02(b)

Yasutomo & Co. v. Commercial Ball Pen Co., 184 USPQ 60 (TTAB 1974)--102.01

Zimmerman v. Holiday Inns of America, Inc., 123 USPQ 86 (TTAB 1959)--1101.02

Zirco Corp. v. American Telephone and Telegraph Co., 21 USPQ2d 1542 (TTAB 1991)--102.01; 502.03; 703.02(a); 901.02(b); 902.02; 903.04

OLD EDITION

INDEX

Abandonment of Application:
- During Ex Parte Appeal--1211
- During Time to Oppose--218; 307.11
- During TTAB Inter Partes Proceeding:
  - Abandonment and Opposition Filed on Same Day --307.11; 602.01
  - After Rule 2.130 Remand to Examining Attorney --602.01; 603
  - Deletion of Class From Multi-Class Application --602.01; 603; 605.03(b)
  - During Concurrent Use Proceeding--603
  - During Interference--603
  - During Opposition--218; 307.11; 602.01
- Not During TTAB Inter Partes Proceeding --218
- Prior to Opposition, for Failure to Timely Respond to Office Action --602.01
- Procedure for--218; 307.11; 602.01; 603

Abandonment of Cancellation by Petitioner (see also Withdrawal of Proceeding by Plaintiff) --601
Abandonment of Opposition by Opposer (see also Withdrawal of Proceeding by Plaintiff) --601
Abandonment of Subject Registration During Inter Partes Proceeding --602.02
Abstracts of Title to Applications and Registrations --122
Access to Files:
- After TTAB Proceeding--121.03
- Confidential--121.02
- During Appeal From TTAB Decision --904
- During TTAB Proceeding--121.01; 121.02
- Files Not to be Removed From Offices of TTAB --121.01; 122
- Nonconfidential--121.01
- Terminated Proceeding--121.03

Access to Record During Appeal From TTAB Decision --904
Action by Assignee--125
Act of 1946 (see Trademark Act of 1946)
Additional Time for Argument at Oral Hearing, Motion for --542.02; 802.05
Additional Time for Taking Action After Service by Mail-- 113.05
Address Change of Party or Representative --117.07
Address of TTAB--103
Admission, Requests for (see also Discovery: Requests for Admission) --410; 411
Admissions Against Interest:
- In Application or Registration File--703.01; 704
- In Briefs on Case--706.02
- In Pleadings--706.01

Admissions to Requests for Admission (see Discovery: Requests for Admission; Evidence, Introduction of in Inter Partes Proceeding: Admissions to Requests for Admission)
Advisory Opinions Not Issued by TTAB --605.03(f)
Agreement, Settlement (see Settlement Agreement)
Allegations, Specimens, etc., in Application or Registration Not Evidence for Owner Unless Proved at Trial--703.01; 704
Alternative Pleading--312.03
Alternative Positions May be Taken by Applicant During Ex Parte Prosecution --1215
Amendment of Application:
- After Decision on Ex Parte Appeal--1205; 1217; 1218
- As Defense to Inter Partes Proceeding --318.02(b); 514.03

OLD EDITION

During Ex Parte Appeal--1205
During Inter Partes Proceeding--212.06; 514; 605.03(b); 605.03(c)
During Opposition, to Convert to Concurrent Use --1112
During or After Extension of Time to Oppose (see Extension of Time to Oppose: Amendment of Application During or After)
Geographic Limitations Considered Only in Concurrent Use Proceeding --311; 318.02(b); 319.01; 514.03; 1101.02
Motion to Amend (see also Motions, Types of)--514
Plaintiff's Pending--605.03(c)
Pursuant to Settlement--605.03(b); 605.03(c)
To Allege Use (see Amendment to Allege Use)
Amendment of Pleadings:
May be Amended as in Civil Action --322
Motion for (see also Motions, Types of)--507
Amendment of Registration:
As Defense to Inter Partes Proceeding --318.02(b); 514.03
During Inter Partes Proceeding --514; 605.03(b)
Effect on Time for Filing Cancellation --308.02(c)(2)
Geographic Limitations Considered Only in Concurrent Use Proceeding --311; 318.02(b); 319.01; 514.03; 1101.02
Motion to Amend (see also Motions, Types of)--514
Pursuant to Settlement--605.03(b)
Amendment or Withdrawal of Admission --411.04; 525
Amendment to Allege Use:
Disposition of Untimely--219
Filed, or Associated With File, During Ex Parte Appeal --1206.01
Filed, or Associated With File, During Extension of Time to Oppose --219
Filed, or Associated With File, During Opposition --219
Time for Filing--219
Amicus Brief--539; 801.04
Answer:
Admissions--318.02(a)
Affirmative Assertions Which Are No t Defenses--318.02(c)
Counterclaims, Generally (see also Counterclaim)--319
Defenses, Generally (see also Defenses)--318.02(b)
Denials--318.02(a)
Failure to Timely File (see also Default--Failure to Timely Answer Complaint) --317
Form of, Generally--318.01
Heading For--318.01
Must be Served--318.01
Need Not be Verified--318.01
Reply to Answer Should Not be Filed --320
Substantive Pleading of--318.02
Time for Filing:
Extension of--316.03; 509
Rule 2.119(c) 5-Day Addition Not Applica ble--316.02
To Complaint--316.01
To Counterclaim--316.01
Unsigned--318.01
Who May Sign--318.01

OLD EDITION

Appeal From Action of Examining Attorney (see Ex Parte Appeal)
Appeal From Decision of TTAB:
Access to Record During Appeal --904
Avenues of Appeal Described --901.01
By Appeal to Federal Circuit:
Access to Record During --904.01
Appeal Brief--902.06; 902.07
Appendix--902.07
Certified List--902.06
Described Generally --901.01
Docketing of Appeal --902.06
Ex Parte Cases, Special Provisions re--902.08; 1218; 1219.02
How to File Appeal--902.01
Notice of Appeal--902.01
Notice of Election to Have Review by Civil Action --901.01; 902.03; 902.04; 903.06
Oral Argument on Appeal --902.07
Requirements for Appeal --902.01
Time for Filing:
Appeal Brief--902.06
Certificate of "Express Mail" Available --902.02
Certificate of Mailing or Transmission Available --902.02
Commissioner Determines Timeliness of Notice of Appeal --902.02
Counting of Time --902.05
Cross-Appeal--902.02
Extension of Time --509.02; 902.02
If There is Request for Reconsideration of Subject Decision --902.02
In Case of Judgment Entered Subject to Prevailing Party's Establishment of Constructive Use --901.02(b)
Notice of Appeal--902.02
Notice of Election to Have Review by Civil Action --901.01; 902.03; 902.04; 903.06
Waives Appeal by Civil Action --902.03; 902.08
By Commencing Civil Action:
Access to Record During --904.02
Appeal to Federal Circuit Waives Appeal by Civil Action --903.06
Commencement of Action --903.04
Described Generally --901.01
Ex Parte Cases, Special Provisions re --903.07
Notice of Election to Have Review by Civil Action --901.01; 902.03; 902.04; 903.06
Parties to Action --903.02
Place of Action --903.03
Time for Filing:
Civil Action --903.04
Counting of Time --903.05
Cross-Action --903.04
Extension of Time --509.02; 903.04
If There is Request for Reconsideration of Subject Decision --903.04
In Case of Judgment Entered Subject to Prevailing Party's Establishment of Constructive Use --901.02(b); 903.04

OLD EDITION

Notice of Election to Have Review by Civil Action --901.01; 902.03; 902.04; 903.06
TTAB Should be Notified Promptly of Filing of Civil Action --806; 903.01
What is Appealable:
Court to Which Appeal is Taken Determines Appealability of Decision --901.02(a)
Decision Must be Final, Not Interlocutory --901.02(a); 905
Judgment Entered Subject to Prevailing Party's Establishment of Constructive Use --901.02(b)
Review of Interlocutory Decisions on Appeal From Final Decision --901.02(a); 905
What is Petitionable (see also Petition to the Commissioner) --901.02(a); 905
Application Files:
Access to (see also Access to Files) --121
Copies of Files or Parts Thereof --122; 123
Introduction as Evidence (see also Evidence, Introduction of) --703
Not to be Removed From Offices of TTAB --121.01; 122
Storage of (see also Storage of Files and Exhibits) --120.02
Application:
Abandonment of (see Abandonment of Application)
Abstract of Title to --122
Allegations, Specimens, etc., Not Evidence for Owner Unless Proved at Trial --703.01; 704
Amendment of (see Amendment of Application)
Appeal to TTAB From Final Action in (see Ex Parte Appeal)
Approval of, During Ex Parte Appeal, for Publication --1203.02(b)
Concurrent Use (see also Concurrent Use Proceeding):
Abandonment of, During Concurrent Use Proceeding (see also Abandonment of Application) --603
Amendment of Intent-to-use Application to Seek Concurrent Registration --1102.02(a)(1)
Applicant May be Required to Furnish Extra Copies of Application, etc --1102.02(a)(3); 1102.02(a)(4); 1102.02(b)
Application Based on Sec. 44 Only May Not Seek Concurrent Registration --1102.02(a)(1)
Described --1102.01
Geographic Restriction, Generally --1102.02(a)(3)
Intent-to-use Application Filed Also as Concurrent Use Application Void --1102.02(a)(1)
Info in Application Provides Notice of Scope of Registration Sought and Rights Conceded --1102.02(a)(3); 1105; 1106
Jurisdictional Requirement --1102.02(a)(2); 1102.02(b)
Mode of Use Restriction, Generally --1102.02(a)(3)
Must Assert Use in Commerce --1102.02(a)(1); 1102.02(a)(4); 1102.02(b)
Must State Area and/or Mode of Use for Which Registration Sought --1102.02(a)(3); 1102.02(a)(4); 1102.02(b)
Must State Info re Use by Exceptions --1102.02(a)(3); 1102.02(a)(4); 1102.02(b)
On Basis of Concurrent Use Proceeding --1101.03; 1102.01; 1102.02(a)
On Basis of Prior Court Decision --1102.01; 1102.02(b)
On Basis of TTAB Decision in Prior Concurrent Use Proceeding --1102.01; 1102.02(a)(4)
Publication Statement for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Request to Amend Application Must be Served Even Upon Excepted User Against Which Default Judgment Has Been Entered --1106
Requirements for --1102.02
Statement, Publication, for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105

OLD EDITION

Types of--1102.01
Who Must be Listed as Exception --1102.02(a)(3)
Wording of Publication Statement for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105

OLD EDITION

Deletion of Class From Multi-Class Application During Inter Partes Proceeding --602.01; 603; 605.03(b)
Evidentiary Value of--703.01; 703.03; 704
Introduction as Evidence (see also Evidence, Introduction of)--703
Motion to Amend (see also Motions, Types of)--514
Motion to Divide--516
Obtaining Status Information Concerning --124
Plaintiff's Pending, TTAB has no Jurisdiction Over --605.03(c)
Remand to Examining Attorney From Inter Partes Case --515; 805
Statements and Things in File Not Evidence for Owner Unless Proved at Trial --703.01; 704
Status of Application After Inter Partes Proceeding --807
When Assignee May Take Action In --125
Assignee:
Motion to Join or Substitute Assignee (see also Motions, Types of)--512
When May Take Action--125; 512.01
Assignment:
Action by Assignee--125; 512.01
Issuance of Registration in Name of Assignee --512.03
Motion to Join or Substitute Assignee (see also Motions, Types of)--512
Of Mark in Inter Partes Case--512.01
Attack, Collateral, on Registration Not Permitted --318.02(b); 319.01
Attending Deposition by Telephone--404.05; 713.08
Attorney:
Adverse Parties Represented by Same Attorney --114.08
Appearance as Representative of Party --114.03
Change of Address--117.07
Conduct of--115
Correspondence With (see Correspondence - With Whom Held)
Disciplinary Proceedings--115.02
Disqualification of--115.03
Eligibility to Represent Party--114.03
Foreign--114.05
Power of (see Power of Attorney)
Revocation of Authority to Represent Party --116.01
Selection of--114.02
Withdrawal (see Withdrawal as Representative of Party)
Attorneys' Fees, Not Awarded by TTAB --502.06; 529.01
Audiotape Oral Hearing, Motion for Leave to --543; 802.06
Augmented Panel Hearing, Motion for --541; 802.04
Authority of TTAB Members, Interlocutory Attorneys to Act (see Trademark Trial and Appeal Board)
Authority of TTAB to Schedule Proceedings --510.01
Bankruptcy Proceeding:
Resumption of TTAB Proceeding After--510.03(b)
Suspension of TTAB Proceeding Due to --510.03(a)
Briefs:
Ex Parte Appeal:
Form for--1203.01
No Provision for Reply Brief by Examining Attorney --1203.02(c)
Time for Filing:
Applicant's Main Brief--1203.02(a)

OLD EDITION

Applicant's Reply Brief--1203.02(c)
Examining Attorney's Brief--1203.02(b)
Extension of Time--1203.02(d)
Procedure Followed by TTAB When Amendment and Appeal Both Filed --1205
Procedure Followed by TTAB When Appeal and Request for Reconsideration of Appealed Action Both Filed--1202.02; 1203.02(a)
On Case:
Amicus--539; 801.04
Contents of--801.03
Exhibits to Not Evidence Unless Properly Introduced --705.02
Form of--801.03
May Not be Used to Introduce Evidence --705.02; 706.02; 801.01
Motion for Judgment for Failure of Plaintiff to File Main Brief [Rule 2.128(a)(3)] --537; 801.02(a)
Motion for Leave to Exceed Page Limit --538; 801.03
Motion for Leave to File Amicus Brief--539
Motion to Strike Brief or Attached Exhibits --540; 801.05
Not Mandatory for Defendant--801.02(b)
Order to Show Cause re Failure of Plaintiff to File Main Brief [Rule 2.128(a)(3)] --537; 801.02(a)
Page Limit Described--538; 801.03
Purpose of--801.01
Reply Brief Not Permitted for Defendant in Absence of Counterclaim --801.02(d)
Reply Brief Not Mandatory for Plaintiff--801.02(c)
Statements in, Evidentiary Value of--706.02
Time for Filing:
Defendant's Main--801.02(b)
Plaintiff's Main--801.02(a)
Plaintiff's Reply--801.02(c)
When Concurrent Use or Interference Proceeding Has More Than Two Parties 801.02(e); 1007; 1108
When Parties are in Reverse Positions in Consolidated Proceedings --801.02(e)
When There is Counterclaim--801.02(e)
On Motions:
Amicus--539; 801.04
Failure to File Brief in Opposition--502.03
Motion for Leave to File Amicus Brief--539
Motion to Strike Brief--517
Reply Briefs--502.03; 517.02
Requirement for Supporting Brief--502.03
Time for Filing--502.03; 517.02
Business to be Conducted in Writing--104
Cancellation, Under Sec. 8 or 9, During Case, of Defendant's Registration, Motion for Order to Show Cause due to [Rule 2.134(b)] --536; 602.02(b)
Cancellation Proceeding:
Abandonment of, by Petitioner (see also Withdrawal of Proceeding by Plaintiff) --601
Abandonment of Subject Registration During --602.02
Access to Files During (see also Access to Files)--121
Adverse Decision in, Effect of on Right to Seek Concurrent Registration --1111
Answer, Generally (see also Answer)--316; 318

OLD EDITION

Appeal From Decision of TTAB in (see Appeal From Decision of TTAB)
Briefing Schedule--801.02
Briefs on Case (see also Briefs: On Case)--801
Combined Complaint May be Filed--306
Commencement of--301; 403.02
Complaint (see also Complaint)--312
Consolidated Complaint May be Filed--306
"Conversion" to Concurrent Use Proceeding--1112
Decision, Adverse, in Cancellation, Effect of on Right to Seek Concurrent Registration--1111
Decision, Final (see also Final Decision)--803; 806
Defendant's Registration Cancelled Under Sec. 8 or 9 During Case, Motion for Order to Show Cause Due to [Rule 2.134(b)]--536; 602.02(b)
Described--102.02
Effect of Adverse Decision in Cancellation on Right to Seek Concurrent Registration --1111
Fee for Filing (see also Fee)--118.01; 310
Filing Date of Petition to Cancel--310.04
Final Decision in (see also Final Decision)--803; 806
Geographic Limitations Not Considered in--311
Grounds for Cancellation:
    Grounds Available at Any Time--308.01
    Grounds Available Only Within Five Years After Registration or Republication:
        Counting of Five-Year Period--308.02(a)
        Effect of Amendment of Registration--308.02(c)(2)
        Grounds Described--308.02(a)
        Limitation of Grounds After Five Years Is Independent of Sec. 15 Affidavit--308.02(b)
        Reliance on Registration by Plaintiff in Inter Partes Proceeding Tolls Five-Year Period as to Counterclaim--308.02(c)(1)
Identity of Defendant--315.01
Joint Petitioners May File--304
Late-filed--308.04
Multiple Class Registration, Cancellation Against--305
Notification of Proceeding (see also Notification of TTAB Proceeding)--315
Oral Hearing (see also Oral Hearing: On the Case)--802
Partial Cancellation--311
Petition to Cancel (see also Complaint)--312
Petition to Commissioner From Action of TTAB During (see Petition to the Commissioner)
Prematurely Filed--308.03
Registration Cancelled Under Sec. 8 or 9 During--536; 602.02(b)
Scope of--311
Storage of Files During and After (see Storage of Files and Exhibits)
Surrender of Registration During--602.02
Termination of--121.03; 806
Time for Filing Petition to Cancel:
    Late Petition--308.04
    Petition That May be Filed at Any Time After Registration or Republication --308.01
    Petition That Must be Filed Within Five Years After Registration or Republication:
        Counting of Five-Year Period--308.02(a)
        Effect of Amendment of Registration--308.02(c)(2)
        General Description of--308.02(a)

OLD EDITION

Limitation of Grounds After Five Years Is Independent of Sec. 15 Affidavit --308.02(b)
Reliance on Registration by Plaintiff in Inter Partes Proceeding Tolls Five-Year Period as to Counterclaim --308.02(c)(1); 319.03
Premature Petition --308.03
Trial Schedule --701
Voluntary Surrender of Registration During --602.02
Who is Defendant --315.01
Who May Petition to Cancel:
Damage, Meaning of --303.03
Described, Generally --303.01
Federal Trade Commission --303.04
Joint Petitioners --304
Person, Meaning of --303.02
Standing --303.03
Withdrawal of, by Petitioner (see also Withdrawal of Proceeding by Plaintiff) --601
Withdrawal of Subject Registration During --602.02
Caption of Papers Filed With TTAB, Proper --106.01
Cause, Order to Show:
Why Default Judgment Should Not be Entered Against Defendant for Failure to Answer --317; 508
Why Judgment Should Not be Entered Against Defendant for Permitting its Registration to be Cancelled Under Sec. 8 or 9 During Case [Rule 2.134(b)]--536; 602.02(b)
Why Judgment Should Not be Entered Against Plaintiff for Failure to File Main Brief [Rule 2.128(a)(3)]--537; 801.02(a)
Certificate of Express Mail:
Applying or Attaching --111.03
Available for Filing Any Paper With TTAB --111.01
Generally --111.01
Location of --111.03
Proving Mailing Date of Questionable --111.05
Requirements for --111.02
Suggested Format for --111.04
Certificate of Mailing By First-Class Mail:
Applying or Attaching --110.04
Available for Filing Any Paper With TTAB Except Petition to Cancel --110.01; 110.07
Described --110.01
Distinguished From Certificate of Service --110.08
Distinguished From Certified Mail --110.08
In General --110.01
Location of --110.04
Loss of --110.05
Nonreceipt by PTO of Paper or Fee Bearing --110.06
Papers to Which Not Applicable --110.07
Requirements for --110.02
Suggested Format for --110.03
Certificate of Service:
Distinguished From Certificate of Mailing or Transmission --113.06
Elements of --113.03
Requirement for Proof of Service --113.02
Certificate of Transmission:

OLD EDITION

Described--110.01
Distinguished From Certificate of Service --110.08
Generally Not Available for Filing Papers With TTAB --107; 110.01; 110.07; 1202.02
In General--110.01
Location of--110.04
Nonreceipt by PTO of Paper or Fee Bearing --110.06
Papers to Which Not Applicable --110.07
Requirements for--110.02
Suggested Format for--110.03
Certified Copies of Files or Parts Thereof:
Court Requirement for Certification --123.01
TTAB Verification Letter--123.01; 123.03
With Certification Seal--122; 123.01; 123.02
Certified Copies of Registrations --122
Change of Address--117.07
Change of Name of Party:
Issuance of Registration in New Name --512.03
Motion to Reflect Change of Name in Inter Partes Case --512.02
Proceeding May be Continued in Old Name --512.02
Change Oral Hearing Date, Motion to --542.01; 802.03
Change Title of Proceeding, Motion to --512
Checks, for Payment of Fees --118.03
Civil Procedure, Fed. Rules of, in TTAB Proceedings (see Fed. Rules of Civ. Procedure in TTAB Proceedings)
Code of Federal Regulations:
Obtaining Copies of--101.01
Rules Governing TTAB Proceedings --101.01
Collateral Attack on Registration Not Permitted --318.02(b); 319.01
Combined Complaint May be Filed --306
Commencement of TTAB Inter Partes Proceedings --301; 403.02; 1003; 1105
Commencement of TTAB Trial Period --701
Commissioner, Petition to (see Petition to Commissioner)
Commissioner's Orders and Notices, Effect on TTAB Proceedings of --101.04
Compel Discovery, Motion to (see also Motions, Types of: To Compel) --523
Complaint:
Alternative Pleading of Claims --312.03
Combined Complaint May be Filed --306
Defined--312.01
Evidentiary Matters Should Not be Pleaded --312.03
Fair Notice of Basis Required --312.03
Form of, Generally --312.01
Format, Suggested:
For Notice of Opposition --312.02(a)
For Petition to Cancel--312.02(b)
Heading For--312.01
Hypothetical Pleading of Claim --312.03
Inconsistent Claims --312.03
Must be Filed in Duplicate --312.01
Need Not be Served by Plaintiff Upon Defendant --312.01
Need Not be Verified--312.01

OLD EDITION

Substantive Pleading of--312.03
Unsigned--312.01
Who May Sign--312.01
Compulsory Counterclaim (see also Counterclaim)--319.04; 319.06
Concurrent Use Proceeding:
Abandonment of Subject Application During (see also Abandonment of Application)--603
Access to Files During (see also Access to Files)--121
Addition of Application or Registration to--1103
Addition of Party to--1103
Adverse Decision in Opposition or Cancellation, Effect of on Right to Seek Concurrent Registration--1111
Amend Application, Request to, Must be Served Even Upon Excepted User Against Which Default Judgment Has Been Entered--1106
Answer to Notice--1106
Appeal From Decision of TTAB in (see Appeal From Decision of TTAB)
Applicant, Concurrent Use, Must Prove Entitlement to Registration--1106; 1107; 1108; 1109
Applications Involved in Proceeding, Described--1103
Applications Not Subject to Proceeding, Described--1104
Briefing Schedule--801.02; 1108
Briefs on Case (see also Briefs: On Case)--801
Burden of Proof, Applicant's, When Default Judgment Has Been Entered Against Excepted User for Failure to File Answer to Notice of Institution--1106
Burden of Proof, Generally--1106; 1107; 1108; 1109
Cannot be Circumvented by Section 7(e) Amendment--1101.02
Cannot be Instituted Until All Oppositions Filed are Dismissed--1105
Commencement of--301; 403.02; 1105
Compared to Cancellation or Opposition--1108
Complaint, Has None--1102.02(a)(3); 1105; 1106; 1108
Concurrent Use Applicant Must Prove Entitlement to Registration--1106; 1107; 1108; 1109
Concurrent Use Application:
Abandonment of, During Concurrent Use Proceeding (see also Abandonment of Application)--603
Amendment of Intent-to-use Application to Seek Concurrent Registration--1102.02(a)(1)
Applicant May be Required to Furnish Extra Copies of Application, etc--1102.02(a)(3); 1102.02(a)(4); 1102.02(b)
Application Based on Sec. 44 Only May Not Seek Concurrent Registration--1102.02(a)(1)
Described--1102.01
Geographic Restriction, Generally--1102.02(a)(3)
Intent-to-use Application Filed Also as Concurrent Use Application Void--1102.02(a)(1)
Info in Application Provides Notice of Scope of Registration Sought and Rights Conceded--1102.02(a)(3); 1105; 1106
Jurisdictional Requirement--1102.02(a)(2); 1102.02(b)
Mode of Use Restriction, Generally--1102.02(a)(3)
Must Assert Use in Commerce--1102.02(a)(1); 1102.02(a)(4); 1102.02(b)
Must State Area and/or Mode of Use for Which Registration Sought--1102.02(a)(3); 1102.02(a)(4); 1102.02(b)
Must State Info re Use by Exceptions--1102.02(a)(3); 1102.02(a)(4); 1102.02(b)

SUPERSEDED

On Basis of Concurrent Use Proceeding --1101.03; 1102.01; 1102.02(a)
On Basis of Prior Court Decision --1102.01; 1102.02(b)
On Basis of TTAB Decision in Prior Concurrent Use Proceeding --1102.01; 1102.02(a)(4)
Publication Statement for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Request to Amend Application Must be Served Even Upon Excepted User Against Which Default Judgment Has Been Entered --1106
Requirements for --1102.02
Statement, Publication, for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Types of --1102.01
Who Must be Listed as Exception --1102.02(a)(3)
Wording of Publication Statement for --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Concurrent Use Registration:
Alteration of Restrictions on --1113
Bases for Issuance of --1101.03
Cannot be Obtained by Including Geographical Restriction in Identification of Goods --1102.01
How Obtained --1101; 1102
Registration Cannot be Geographically Restricted by Section 7(e) Amendment --1101.02; 1113
Conduct of Proceeding Described, In General --1108
"Conversion" of Opposition to --514.03; 1112
Decision, Adverse, in Opposition or Cancellation, Effect of on Right to Seek Concurrent Registration --1111
Decision, Final (see also Final Decision) --803; 806
Default Judgment for Failure to File Answer to Notice of Institution --1106
Defendant, Defined --1107
Described --102.02; 1101.01
Effect of Adverse Decision in Opposition or Cancellation on Right to Seek Concurrent Registration --1111
Entitlement to Registration Must be Proved by Concurrent Use Applicant --1106; 1107; 1108; 1109
Entitlement to Registration of Excepted User Which Does Not Own Involved Application or Registration Not Determined --1102.02(a)(4); 1107
Ex Parte Type Showing of Entitlement to Registration May be Submitted by Applicant in Certain Default Situations --1106
Final Decision in (see also Final Decision) --803; 806
Generated Only by Way of Application for Concurrent Registration --1102.01
Geographic Limitations Considered Only in --311; 318.02(b); 319.01; 514.03; 1101.02
Has No Complaint --1102.02(a)(3); 1105; 1106; 1108
Incontestable Registrations Are Subject to Concurrent Use Proceeding --1104
Info in Application and Notice of Institution Provides Notice of Scope of Registration Sought and Rights Conceded --1102.02(a)(3); 1105; 1106
Instituted Only as Result of Application for Concurrent Registration --1102.01
Intent-to-use Application Filed Seeking Concurrent Concurrent Use Application Void --1102.02(a)(1)
Intent-to-Use Applications Not Subject to Concurrent Use Proceeding Until After Acceptable Affidavit of Use Filed --1104
Involved Applications and/or Registrations, Described --1103
Issues in --1107
Judgment, Default, for Failure to File Answer to Notice of Institution --1106

OLD EDITION

Junior Party, Defined--1107
Mailing of Papers to Excepted User After Default Judgment Entered Against it --1106
Notice of Institution--1105; 1106
Opposition to Concurrent Use Application, Procedure When Filed --1105
Oral Hearing (see also Oral Hearing: On the Case)--802; 1108
Parties to, Described--1103
Petition to Commissioner From Action of TTAB During (see Petition to the Commissioner)
Plaintiff, Defined--1107
Pleadings (Has No Complaint)--1102.02(a)(3); 1105; 1106; 1108
Procedure When Application Published Subject to Concurrent Use Proceeding is Opposed --1105
Proof of Applicant's Entitlement to Registration May be Ex Parte in Nature in Certain Default Situations--1106
Proof of Applicant's Entitlement to Registration Must be Made Even if Default Judgment Entered Against Excepted User--1106
Publication Statement for Concurrent Use Application--1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Registration Cannot be Geographically Restricted by Section 7(e) Amendment --1101.02
Registrations Involved in Proceeding, Described --1103
Registrations Not Subject to Proceeding, Described --1104
Request to Amend Application Must be Served Even Upon Excepted User Against Which Default Judgment Has Been Entered--1106
Right to Registration Must be Proved by Concurrent Use Applicant --1106; 1107; 1108; 1109
Right to Registration of Excepted User Which Does Not Own Involved Application or Registration Not Determined--1102.02(a)(4); 1107
Senior Party, Defined--1107
Settlement Agreement Providing for Concurrent Registration --1109
Statement, Publication, for Concurrent Use Application --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Status of Application After Proceeding --807
Status of Excepted User After Default Judgment Entered Against it --1106
Storage of Files During and After (see Storage of Files and Exhibits)
Supplemental Register Applications and Registrations Not Subject to Concurrent Use Proceedings --1104
Termination of--121.03; 806
Trial Schedule for--701; 1108
Wording of Publication Statement for Concurrent Use Application --1102.02(a)(3); 1102.02(a)(4); 1102.02(b); 1105
Conduct of Practitioner:
Applicable Rules--115.01
Disciplinary Proceedings for Misconduct --115.02
Disqualification--115.03
Conferences:
Pre-Trial--417; 502.07(a)
Telephone--417; 502.07(b)
Confidential Materials:
Access to--121.02; 416.07; 904
Protective Order for (see also Discovery: Protective Orders)--416
Storage of--120.03; 416.07
Consent Orders Not Issued by TTAB --605.03(f)

OLD EDITION

Consent to Entry of Judgment Against Self --604
Consolidated Complaint May be Filed --306
Consolidation of Applications During Ex Parte Appeal --1214
Consolidation of Inter Partes Proceedings --511
Constructive Use, Judgment Entered Subject to Prevailing Party's Establishment of --901.02(b)
Contact With TTAB Personnel --105
Contempt, TTAB Cannot Hold Person in --502.06
Copies of Files or Parts Thereof:
    Certified Copies (see also Certified Copies of Files or Parts Thereof) --122; 123
    Plain Copies--122
    With TTAB Verification Letter --123.01; 123.03
Copies of Papers, Required Number of --106.03
Correction of Errors in Deposition Transcript --713.14
Correction of Inter Partes Proceeding Title --512
Correspondence - With Whom Held:
    After a Move--117.07
    After Revocation of Authority to Re present--117.05
    After Withdrawal From Representation --117.05
    Change of Address--117.07
    Generally--117.01
    Ineligible Representative --117.08
    More Than One Authorized Representative --117.02
    When Inter Partes Proceeding Commences --117.01; 117.03; 117.04
    With Foreign Party--117.06
Counterclaim:
    Answer to:
        Failure to Timely File--319.06
        Form for--319.06
        May Include Counterclaim --319.06
        Time for Filing--319.06
    Compulsory:
        Counterclaim Versus Separate Petition to Cancel --319.04
        Defined--319.04; 319.06
        Time for Filing--319.04
    Defense Attacking Validity of Plaintiff's Registration Requires Counterclaim --318.02(b); 319.01
    Defense Seeking Restriction of Plaintiff's Registration Requires Counterclaim --318.02(b)
    Effect on, When Main Claim Disposed of --606
    Fee for Filing (see also Fee)--118.01; 319.02
    Form of, Generally--319.03
    Legal Equivalent of Petition to Cancel --319.01
    May Seek Cancellation in Whole or in Part --319.01
    Must be Served Upon Every Other Party --319.03
    Must Seek Cancellation of Plaintiff's Registration --319.01
    Not Vehicle for Geographic Limitation --319.01
    Permissive, Defined--319.05; 319.06
    Reliance on Registration by Plaintiff in Inter Partes Proceeding Tolls Five-Year Grounds
      Limitation Period as to Counterclaim --308.02(c)(1); 319.03
    Rules 2.111-2.115 Applicable to --319.01
    Same Matter Should Not be Pleaded Both as Counterclaim and as Affirmative Defense --318.02(b)
    Standing Inherent, Need Not be Pleaded --319.03

OLD EDITION

Coupons, for Payment of Certain Fees --118.05
Damage, Meaning of--303.03
Damages, Not Awarded by TTAB --502.06; 529.01
Date for Oral Hearing, Motion to Change --542.01; 802.03
Date of Publication of Mark, Definition of --202.02
Dates of Use in Application or Registration Not Evidence for Owner Unless Proved at Trial --703.01; 704
Decision, Final (see Final Decision)
Decisions of the TTAB:
Appeal From (see Appeal From Decision of TTAB)
As Precedent--101.03
Authority of TTAB Members, Interlocutory Attorneys to Act (see Trademark Trial and Appeal Board)
Digest Decisions--101.03
Final (see Final Decision)
On Case (see Final Decision)
On Motions--502.05
Reconsideration of, Motion for:
Decision on Motion--518
Final Decision--544; 804
Unpublished Decisions--101.03
Where Published--101.03
Declaration of Interference (see also Interference Proceeding; Petition to Commissioner) --1002
Default--Failure to File Answer to Notice of Institution in Concurrent Use Proceeding --1106
Default--Failure to Timely Answer Complaint:
Generally--317.01
Methods of Raising Issue of Default --317.01; 508
Motion for Judgment for--508
Motion for Relief From Default Judgment --317.03; 545
Notice of Default--317.01
Setting Aside Default Judgment --317.03
Setting Aside Entry of Default --317.02
Defendent, Identity of:
In Concurrent Use Proceeding-- 1107
In Interference Proceeding-- 1005
In Opposition or Cancellation Proceeding --315.01
Defenses:
Affirmative Assertions Which Are Not Defenses --318.02(c)
Alternative Pleading of--318.02(b)
Counterclaims, Generally (see also Counterclaim)--319
Defendant at Least Entitled to Restricted Registration --318.02(b); 514.03
Defense Attacking Validity of Plaintiff's Registration Requires Counterclaim --318.02(b); 319.01
Defense Seeking Restriction of Plaintiff's Registration Requires Counterclaim --318.02(b)
Evidentiary Matters Should Not be Pleaded --318.02(b)
Fair Notice of Basis Required --318.02(b)
Hypothetical Pleading of--318.02(b)
Inconsistent--318.02(b)
Pleading of--318.02(b)
Same Matter Should Not be Pleaded Both as Counterclaim and as Affirmative Defense --318.02(b)
Types of, Listed--318.02(b)
Definite Statement, Motion for More (see also Motions, Types of)--505

OLD EDITION

Deletion of Class From Multi-Class Application During Inter Partes Proceeding --602.01; 603; 605.03(b)
Deletion of Class From Multi-Class Registration During Cancellation --602.02(a); 605.03(b)
Deposit Accounts, for Payment of Fees --118.04
Depositions, Discovery (see also Discovery: Depositions) --404; 405; 709
Depositions, Notice of (see Notice of Deposition, Requirements for)
Depositions, Testimony (see also Evidence, Introduction of) --713; 714
Depositions, Videotape, Not Entertained --713.08
Digest Decisions of the TTAB (see Decisions of the TTAB)
Directed Verdict, Motion for Not Available --502.01; 535.04
Disciplinary Proceedings for Practitioner Misconduct --115.02
Discovery:
- Attorney-Client Privilege --402.02
- Conferences:
  - Pre-Trial --417; 502.07
  - Telephone --417; 502.07
- Confidential Information --402.02
- Cooperate, Duty to --401; 412.01
- Depositions:
  - Attending by Telephone --404.05
  - Compared to Testimony Depositions --404.02
  - Described, Generally --404.02
  - Discovery Papers, When to be Filed --413; 709; 710
  - Exhibits to --713.08
  - Failure to Appear, Answer, etc --404.02; 404.03(b)(2); 415.03; 523
  - Hague Convention Procedure --404.03(c)(2)
  - Introduction of --404.02; 709
  - Letter Rogatory Procedure --404.03(c)(2)
  - Manner of Taking --404.03; 404.05; 713.08
  - May be Used in Exam or Cross-exam of Any Witness at Trial --709
  - Motion to Compel Appearance, Answer, etc --404.02; 404.03(b)(2); 415.03; 523
  - Motion to Offer Discovery Deposition of Self or Nonparty --530
  - Motion to Quash Notice of Deposition --521
  - Motion to Take Foreign Deposition Orally --520; 713.02; 714.01
  - Notice of, Requirements for --404.04
  - Objections to (see also Objections: To Discovery Deposition) --404.02; 404.03(b)(2); 405
  - Of Foreign Country Resident --Nonparty --404.03(c)(2)
  - Of Foreign Country Resident --Party --404.03(c)(1)
  - Of U.S. Resident --Nonparty --404.03(b); 404.03(b)(2)
  - Of U.S. Resident --Party --404.03(b); 404.03(b)(1); 520
  - Of Whom May be Taken --404.03
  - Offering of Exhibits to --713.08
  - Refusal to Answer Questions --404.02; 404.03(b)(2); 405.03; 415.03; 523
  - Securing Attendance of Deponent --404.03; 415.03
  - Subpoena:
    - Violation of --404.03(b)(2)
    - When Necessary --404.02; 404.03(b)(2); 415.03
  - Taking by Telephone --404.05
  - Telephone, Taking or Attending by --404.05
  - Time for Taking --403.02; 404.01; 404.02
  - Videotape Depositions Not Entertained --713.08

OLD EDITION

When Made of Record by One Party, May be Referred to by Any Party --709
Where Taken--404.03(b); 404.03(c); 404.04; 404.05
Who May Take--404.01
Discoverability Guidelines--419
Discovery Papers, When to be Filed--413; 709; 710
Discovery Response Made of Record by One Party May be Referred to by Any Party --709; 710
Discovery Response May be Used in Exam or Cross-exam of Any Witness at Trial --709; 710
Discovery Sanctions:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
Estoppel Sanction--527.05
For Failure to Comply With Order re Discovery --527.01
For Failure to Respond, or Respond Properly, to Admission Request --527.04
For Failure to Timely Respond--403.03; 527.03
If Party Says it Won't Respond to Discovery --527.02
Duty to Cooperate--401; 412.01
Duty to Search Records for Discovery Info --412.02
Duty to Serve Only Proper Request--402.02; 412.01
Duty to Supplement Responses--412.03
Early Initiation, Need for:
To Allow Time for Follow-up Discovery --403.05(a)
To Allow Time for Summary Judgment Motion --403.05(b)
To Aid Introduction of Produced Documents --403.05(c); 711
Failure to Provide Requested Discovery:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
Discovery Deposition--415.03; 523
Estoppel Sanction--527.05
Failure to Comply With Order re Discovery --527.01
Interrogatories--415.01; 523
Motion for Discovery Sanctions--527
Party Says it Will Not Respond to Discovery --527.02
Requests for Admission--411.01; 415.01; 524; 527.04
Requests for Production of Documents --415.01; 523
Untimely Discovery Response--403.03; 527.03
Failure to Timely Respond--403.03; 407.01; 409.01; 411.01
Filing Discovery Papers, When Appropriate --413; 709; 710
Goose-Gander Rule--402.02
Guidelines for Discoverability--419
Hague Convention Procedure--404.03(c)(2)
In Camera Inspection of Documents --416.03
In General--401
Interrogatories:
Answers May be Used in Exam or Cross-exam of Any Witness at Trial --710
Discovery Papers, When to be Filed--413; 709; 710
Documents Provided as Interrogatory Answer --710; 711
Excessive--406.03(e); 526
Motion for Leave to Serve More--406.03(c); 519
Motion to Compel Answer:
Generally--415.01; 523
TTAB Not Bound by Introduction or Preamble to Interrogatories --406.03(d)
When Interrogatories are Objected to as Excessive --406.03(e)

SAMPLE EDITION

Numerical Limit:
Consolidated Proceedings--406.03(c)
Counterclaim--406.03(c)
Described--406.03(a)
How Questions Counted--406.03(d)
Motion for Leave to Serve More--406.03(c); 519
Multiple Marks--406.03(c)
Remedy for Excessive--406.03(e); 414
Service of Revised Interrogatories--406.03(e)
Sets Added Together--406.03(b)
Objections to--406.03(e); 407.02; 414
Responses to:
Answers Must be Under Oath--407.02
Business Records Option--407.02
Documents Provided as Interrogatory Answer--710; 711
Failure to Timely Respond--403.03; 407.01
Generally--407.02; 414
Introduction in Evidence--710
May be Used in Exam or Cross-exam of Any Witness at Trial--710
Motion Attacking Interrogatories Generally Inappropriate--407.02; 414
Objections to--406.03(e); 407.02; 414
Requirements for--407.02
Signature of--407.03
Time for--403.03; 407.01
When Made of Record by One Party, May be Referred to by Any Party--710
Who Must Respond--407.03
Scope of--402; 406.02
Time for:
Responses to--403.03; 407.01
Service of--403.02; 406.01
Who May be Served--406.01
Who May Serve--406.01
Introduction of Discovery Responses in Evidence (see Evidence, Introduction of in Inter Partes Proceeding)
Letter Rogatory Procedure--404.03(c)(2)
Limitations on Right to:
Attorney-Client Privilege--402.02
Can't Limit Opponent's by Limiting Own--402.01
Confidential Information--402.02
In General--402.02
Representative Sampling--402.02
Where Unduly Burdensome, etc--402.02
Motion Attacking Discovery Request Generally Inappropriate--407.02; 409.02; 411.02; 414; 526
Motion for Discovery Sanctions (see also Motions, Types of)--527
Motion for Discovery to Respond to Summary Judgment Motion--528.06
Motion for Order re Manner or Place of Production of Documents--522
Motion for Protective Order--416.01; 526
Motion for Sanction for Failure to Comply With Protective Order--527.01
Motion to Compel Discovery:
Answer to Interrogatories, Generally--415.01; 523

OLD EDITION

Failure to File Motion--523.04
In General--523.01
Production of Documents--415.01; 523
Re Deposition--404.02; 415.03; 523
Requirements for Motion--523.02
Time for Filing--523.03
TTAB Not Bound by Introduction or Preamble to Interrogatories --406.03(d)
When Interrogatories are Objected to as Excessive --406.03(e)
Motion to Extend or Reopen Discovery Period (see also Motions, Types of)--502.02; 509
Motion to Offer Discovery Deposition of Self or Nonparty --530
Motion to Quash Notice of Deposition--521
Motion to Serve Additional Interrogatories --519
Motion to Take Foreign Deposition Orally --520; 713.02; 714.01
Motion to Test Sufficiency of Response to Admission Request --415.02; 524
Motion to Withdraw or Amend Admission --411.04; 525
Papers, Discovery, When to be Filed--413; 709; 710
Party Propounding Request Normally Estopped to Deny Propriety of Same Request by Opponent --402.02
Pre-Trail Conferences--417; 502.07
Produced Documents, Introduction of (see also Evidence, Introduction of in Inter Partes Proceeding)--403.05(c); 711
Protective Orders:
Access to Covered Materials at TTAB --121.02; 416.07; 904
Contents Described--416.04
Defined--416.01
Failure to Comply With--527.01
How to File Covered Materials With TTAB --416.06
In Camera Inspection of Documents --416.03
Marking Covered Materials--416.06
Material Which May be Filed Under --416.02; 416.06
Motion for--416.01; 526
Motion for Sanction for Failure to Comply With --527.01
Signature of--416.05
Stipulated--416.02
Storage of Covered Materials by TTAB --120.03; 416.07
Purposes of--401
Requests for Admission:
Admissions May be Used in Exam or Cross-Exam of Any Witness at Trial --710
Discovery Papers, When to be Filed--413; 709; 710
Effect of Admission--411.04
Generally--410.02
Motion to Test Sufficiency of Response --415.02; 524
Motion to Withdraw or Amend Admission --411.04; 525
Objections to--411.02
Requirements for--410.02
Responses to:
Failure to Timely Respond--403.03; 411.01
Generally--411.02; 414
Introduction in Evidence--710
May be Used in Exam or Cross-exam of Any Witness at Trial --710

OLD EDITION

Motion Attacking Request Generally Inappropriate --411.02; 414
Motion to Test Sufficiency of--415.02; 524
Objections to--411.02
Requirements for--411.02
Signature of--411.03
Time for--403.03; 411.01
When Made of Record by One Party, May be Referred to by Any Party --710
Scope of--402; 410.02
Time for:
Responses to--403.03; 411.01
Service of--403.02; 410.01
Usefulness of--410.02
Who May be Served--410.01
Who May Serve--410.01
Requests for Production of Documents:
Discovery Papers, When to be Filed--413; 709; 710
Documents Provided as Interrogatory Answer --710; 711
In Camera Inspection of Documents--416.03
Introduction of Produced Documents--403.05(c); 711
Motion re Place or Manner of Production --408.03; 522
Motion to Compel Production--415.01; 523
Objections to--409.02
Place of Production--408.03
Requirements for--408.03
Responses to:
Documents Provided as Interrogatory Answer --710; 711
Failure to Timely Respond--403.03; 409.01
Generally--409.02; 414
Introduction in Evidence--711
Motion Attacking Requests Generally Inappropriate --409.02; 414
Objections to--409.02
Requirements for--409.02
Time for--403.03; 409.01
Scope of--402; 408.02
Time for:
Responses to--403.03; 409.01
Service of--403.02; 408.01
Combined With Notice of Deposition--408.01
Who May be Served--408.01
Who May Serve--408.01
Responses, Discovery, Made of Record by One Party May be Referred to by Any Party --709; 710
Responses, Discovery, May be Used in Exam or Cross-exam of Any Witness at Trial --709; 710
Rules Governing--401
Sanctions:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
Estoppel Sanction--527.05
For Failure to Comply With Order re Discovery --527.01
For Failure to Respond, or Respond Properl y, to Admission Request--527.04
For Failure to Timely Respond--403.03; 527.03
If Party Says it Won't Respond to Discovery --527.02

OLD EDITION

Scope of:
Can't Limit Opponent's by Limiting Own --402.01
Discovery Not Limited to Pleaded Matters --402.01
Governed by FRCP --402.01
In General --402.01
Taking of Discovery Not Attack on Registration --402.01
Search Records for Discovery Info, Duty to --412.02
Should be Initiated Early:
To Allow Time for Follow-up Discovery --403.05(a)
To Allow Time for Summary Judgment Motion --403.05(b)
To Aid Introduction of Produced Documents --403.05(c); 711
Signature of Request or Response Certifies Propriety --106.02; 402.02; 412.01
Summary Judgment Motion, Discovery to Respond to --528.06
Supplement Responses, Duty to --412.03
Telephone Conferences --417; 502.07
Timing of:
Closing of Discovery Period --403.01
Commencement of Proceeding --301; 403.02
Depositions --403.02; 404.01
Extensions of Time --403.04; 501.03; 502.02; 509
Extension of Time to Respond to Discovery Requests Does Not Extend Trial Dates --403.04; 509.02
Failure to Timely Respond --403.03; 407.01; 409.01
In General --403.01
Interrogatories --403.02; 406.01; 407.01
Motion to Extend or Reopen (see also Motions, Types of) --502.02; 509
Need for Early Initiation of Discovery (see also Discovery: Should be Initiated Early) --403.05
Opening of Discovery Period --403.01
Priority of Discovery Concept Not Applicable --403.03
Requests for Production --403.02; 408.01; 409.01
Requests for Admission --403.02; 410.01; 411.01
Service of Discovery Requests --403.02
Service of Discovery Responses --403.03
Stipulation to Extend Discovery Period Should be Filed in Multiple Form --501.03
Stipulation to Extend Discovery Period Should Specify New Dates --501.03
Stipulation to Extend Time to Respond to Discovery Request Need Not be Filed --403.04; 501.02
Untimely Request --403.01
Types of --401
When Discovery Responses Made of Record by One Party, M ay be Referred to by Any Party --709; 710
Dismiss for Failure of Plaintiff to Offer Evidence, Motion to (see also Motions, Types of) --502.01; 535
Dismiss for Failure to State Claim, Motion to (see also Motions, Types of) --503
Dismiss Under FRCP 41(b) or 50(a), Motion Not Available --502.01; 535.04
Disqualification of Practitioner --115.03; 513.02
Division:
Of Application --516

OLD EDITION

Registration Cannot be Divided--516
Documents:
In Camera Inspection of--416.03
Requests for Production of (see also Discovery: Requests for Production of Documents) --408; 409;
711
Domestic Representative:
Authority of--114.07
Correspondence With--114.07
Designation of--114.07
Suggested Format for Designation--114.07
When Required--114.07
Due Dates, Where Last Day for Action Falls on Sat., Sun., Holiday --.112
Electronic Equivalent:
Of Official Document--707
Of Plain Copy of Registration--703.02(b)
Of Printed Publication--708
Envelopes for Proceeding Files:
Description of--120.01
Storage of--120.02
Establishment of Constructive Use by Prevailing Party, Judgment Entered Subject to --901.02(b)
Equivalent, Electronic (see Electronic Equivalent)
Evidence, Fed. Rules of, in TTAB Proceedings (see Fed. Rules of Evidence in TTAB Proceedings)
Evidence, for Summary Judgment Motion:
Affidavits and Attached Exhibits--528.05(b)
Discovery Responses--528.05(c)
In General--528.05(a)
Of Record Only for Motion--528.05(a)
Registrations--528.05(d)
Testimony From Another Case--528.05(e)
Evidence in Ex Parte Appeal:
Submission of During Appeal:
After Granting of Letter of Protest--1207.06
Examining Attorney May Submit Additional Evidence With Action on Request for Reconsideration of Final Action--1204; 1207.04
Evidence Submitted After Appeal Normally Untimely --1204; 1207.01
Evidentiary Record Should be Complete Prior to Appeal --1204; 1207.01
May be Considered Due to Actions of Nonoffering Party --1207.03
May be Submitted Upon Remand for New Refusal --1207.05
May be Submitted With Timely Request for Reconsideration of Final Action --1202.02; 1204; 1207.04
Request for Remand for--1207.02; 1207.06
Treatment of by TTAB, Fed. Cir--1208
Evidence, Introduction of in Inter Partes Proceeding:
Admissions Against Interest:
In Application or Registration File--703.01; 704
In Briefs on Case--706.02
In Pleadings--706.01
Admissions to Requests for Admission--710
Answers to Interrogatories--710

OLD EDITION

Applications:
Allegations, Specimens, etc., Not Evidence fo r Owner Unless Proved at Trial --703.01; 704
Evidentiary Value of --703.01; 703.03; 704
Not Subject of Proceeding --703.03
Statements and Things in File Not Evidence for Owner Unless Proved at Trial --703.01; 704
Subject of Proceeding --703.01
Brief on Case May Not be Used to Introduce Evidence --705.02; 706.02; 801.01
Commencement of Trial Period --701
Discovery Depositions:
Discovery Papers, When to be Filed --413; 709; 710
In General --404.02; 709
May be Used in Exam or Cross-exam of An y Witness at Trial --709
Of Party --530; 709
Of Self or Nonparty --530; 709
When Made of Record by One Party, May be Referred to by Any Party --709
Discovery Papers, When to be Filed --413; 709; 710
Discovery Responses:
Admissions to Requests for Admission --710
Answers to Interrogatories --710
Depositions --709
Discovery Papers, When to be Filed --413; 709; 710
Documents Provided as Interrogatory Answer --710; 711
Interrogatory Answers --710
May be Used in Exam or Cross-exam of Any W itness at Trial --709
Produced Documents --403.05(c); 711
Responses to Requests for Admission --710
Responses to Interrogatories --710
When Made of Record by One Party, May be Referred to by Any Party --709; 710
Documents, Discovery, Produced by Opponent --403.05(c); 711
Documents Provided as Interrogatory Answer --710; 711
Electronic Equivalent:
Of Official Document --707
Of Plain Copy of Registration --703.02(b)
Of Printed Publication --708
Evidence, Trial, Not Examined Prior to Final D ecision --502.01; 535.04; 718.02(c); 718.03(c)
Evidence Not in Compliance With Rules --717
Exhibits to Briefs On Case Not Evidence Unless Properly Introduced --705.02
Exhibits to Pleadings Not Evidence Unless Properly Introduced --313; 705.01
Extension of Time for (see also Extension of Time) --701
Filing Discovery Papers, When Appropriate --413; 709; 710
For Summary Judgment:
Affidavits and Attached Exhibits --528.05(b)
Discovery Responses --528.05(c)
In General --528.05(a)
Of Record Only for Motion --528.05(a)
Registrations --528.05(d)
Testimony From Another Case --528.05(e); 531; 715
Judicial Notice:

CJ EDITION

Kind of Fact Which May be Judicially Noticed --712.01
Right to be Heard on Propriety of Taking --712.04
Time of Taking--712.05
When Discretionary--712.02
When Mandatory--712.03
Interrogatory Responses--710
Materials Not Considered Unless Properly Introduced --702
Motion That Deposition Upon Written Questions be Taken Orally --532; 713.02; 714.01
Motion to Dismiss for Failure of Plaintiff to Offer Evidence (see also Motions, Types of)--535
Motion to Offer Discovery Deposition of Self or Nonparty --530
Motion to Reopen Testimony Period for Newly Discovered Evidence --509.01; 705.02
Motion to Strike Notice of Reliance --533
Motion to Strike Trial Testimony Deposition (see also Motions, Types of)--534
Motion to Use Testimony From Another Proceeding --531; 715
Newly Discovered, Motion to Reopen Testimony Period for Introduction of --509.01; 705.02
Noncomplying Evidence--717
Notice of Reliance:
Motion to Strike--533
Normally May Not be Used to Introduce Produced Documents --403.05(c); 711
Upon Admission to Request for Admission --710
Upon Answer to Interrogatory--710
Upon Discovery Deposition--509
Upon Official Records--707
Upon Printed Publications--708
Objections to Evidence (see Objections)
Official Records--707
Oral Hearing on Case May Not be Used to Introduce Evidence --717; 802.01; 802.07
Papers, Discovery, When to be Filed--413; 709; 710
Printed Publications--708
Produced Documents--403.05(c); 711
Registrations:
Allegations, Specimens, etc., Not Evidence for Owner Unless Proved at Trial --703.01; 704
Cancelled--703.02(a)
Electronic Equivalent of Copy of--703.02(b)
Evidentiary Value of--703.02(a); 703.02(b)
Expired--703.02(a)
File History of Registration Not Subject of Proceeding --703.02(a)
Foreign--703.02(a)
Party's--703.02(a)
Plaintiff's--313; 703.02(a)
Section 7(b) Presumptions, When Accorded --703.02(a); 703.02(b)
State--703.02(a)
Statements and Things in File Not Evidence for Owner Unless Proved at Trial --703.01; 704
Status and Title Copies, Requirements for --703.02(a); 703.02(b)
Subject of Proceeding--703.01
Third-Party--703.02(b)
Responses to Requests for Discovery (see Evidence, Introduction of: Discovery Responses)
Statements in Briefs on Case--706.02

OLD EDITION

Statements in Pleadings--706.01
Stipulated Evidence--716
Stipulated Testimony--713.02
Stipulations re Testimony--707-711; 713; 714; 716
Sufficiency of Evidence, Available Motions Relating to --502.01; 535
Testimony Depositions, Oral:
Attending by Telephone--713.08
Automatically of Record--404.02; 713.12
Before Whom Taken--713.07
Certification of--713.11
Compared to Discovery Depositions--404.02
Confidential Material in--713.16
Correction of Errors in Transcript--713.14
Described, Generally--404.02; 713.01
Errors in Transcript, Correction of--713.14
Examination of Witnesses--713.08
Exhibits to--713.08; 713.09
Extension of Time for (see also Extension of Time)--701
Failure to File--713.12
Failure to Serve Upon Opponent--713.13
Filing of--713.11; 713.12
Form of--713.08; 713.09
From Another Proceeding--531; 715
Motion That Deposition Upon Written Questions be Taken Orally --532; 713.02; 714.01
Motion to Quash Notice of Deposition--521
Motion to Strike (see also Motions, Types of)--534; 718.03(c)
Motion to Take Foreign Deposition Orally--520; 713.02; 714.01
Must be Filed--404.02; 713.12
Not Read Prior to Final Decision--502.01
Notice of Filing--713.11
Notice of Taking--713.05
Objections to Depositions (see Objections: To Testimony Deposition, Oral)
Offering of Exhibits--713.08
Place of--713.04
Protective Order for (see also Discovery: Protective Orders)--713.16
Refusal to Answer Questions--404.02; 713.08; 718.03(d)
Refusal to File Deposition--713.12
Securing Attendance of Witness:
Adverse--713.06
By Subpoena--713.06(a); 713.06(b)
In General--713.06(a)
Nonparty--713.06
Unwilling, in Foreign Country--713.06(c)
Unwilling, in United States--713.06(b)
Service of--713.13
Signature of--713.10
Stipulations re--707-711; 713; 714; 716
Taken Outside of TTAB's Presence--502.01; 702; 713.01
Taking by Telephone--713.08
Taking of Corresponds to Trial--701

OLD EDITION

Telephone, Taking or Attending by --713.08
Testimony Not Read Prior to Final Decision --502.01; 535.04; 718.02(c); 718.03(c)
Time for Taking --404.02; 701; 713.03; 713.04
Trade Secret Material in --713.16
Videotape Depositions Not Entertained --713.08
Whom Taken Before --713.07
Testimony Depositions, Upon Written Questions:
Advantages of --714.15
Attendance at by Adverse Party --714.05
Automatically of Record --404.02; 713.12
Availability of --520; 532; 713.02; 714.01
Before Whom Taken --713.07; 714.03
Certification of --713.11; 714.10
Compared to Discovery Depositions --404.02
Confidential Material in --713.16; 714.14
Correction of Errors in Transcript --713.14; 714.11
Described, Generally --404.02; 713.01; 714.07; 714.15
Disadvantages of --714.15
Errors in Transcript, Correction of --713.14; 714.11
Examination of Witnesses --714.07
Exhibits to --713.08; 713.09
Extension of Time for (see also Extension of Time) --701; 714.04; 714.07
Filing of --713.12; 714.11; 714.12
Form of --713.08; 713.09; 714.08
From Another Proceeding --531; 715
May be Attended by Adverse Party --714.05
Motion That Deposition Upon Written Qu estions be Taken Orally --532; 713.02; 714.01
Motion to Quash Notice of Deposition --521
Motion to Strike (see also Motions, Types of) --534; 718.03(c)
Motion to Take Foreign Deposition Orally --520; 713.02; 714.01
Must be Filed --404.02; 713.12; 714.11; 714.12
Not Read Prior to Final Decision --502.01
Notice of Filing --713.11
Notice of Taking --714.06
Objections to Depositions (see Objections: To Testimony Deposition, Upon Written Questions)
Offering of Exhibits --713.08
Place of --714.05
Protective Order for (see also Discovery: Protective Orders --713.16; 714.14
Questions, Service of --714.07
Refusal to Answer Questions --404.02; 713.08; 718.03(d)
Refusal to File Deposition --713.12
Securing Attendance of Witness:
Adverse --713.06; 714.03
By Subpoena --713.06(a); 713.06(b); 714.03
In General --713.06(a); 714.03
Nonparty --713.06; 714.03
Unwilling, in Foreign Country --404.03; 713.06(c); 714.03
Unwilling, in United States --404.03; 713.06(b); 714.03
Service of Questions --714.07

OLE EDITION

Service of Transcript--713.13; 714.11
Signature of--713.10; 714.09
Stipulations re--707-711; 713; 714; 716
Suspension For--510.03(a); 714.04; 714.07
Taken Outside of TTAB's Presence--502.01; 702; 713.01
Taking of Corresponds to Trial--701
Testimony Not Read Prior to Final Decision--502.01; 535.04; 718.02(c); 718.03(c)
Time for Taking--404.02; 701; 714.04
Trade Secret Material in--713.16; 714.14
Utility of--714.15
When Available--520; 532; 713.02; 714.01
Whom Taken Before--713.07; 714.02
Testimony From Another Proceeding--531; 715
Testimony in Affidavit or Stipulated Form--713.02
Testimony Not Read Prior to Final Decision--502.01; 535.04; 718.02(c); 718.03(c)
Testimony Periods--701
Time for--701
Trial Order--701
Trial Period, Commencement of--701
When Discovery Responses Made of Record by One Party, May be Referred to by Any Party--709;
710
Evidence, Newly Discovered, Motion to Reopen Testimony Period for Introduction of--509.01; 705.02
Evidence, Trial, Not Examined Prior to Final Decision--502.01; 535.04; 718.02(c); 718.03(c)
Evidentiary Matters Should Not be Pleaded--312.03; 318.02(b)
Exhibits:
Confidential (see Confidential Materials)
Storage of--120.02
To Brief on Case Not Evidence Unless Properly Introduced--705.02
To Deposition--713.08; 713.09
To Pleadings Not Evidence Unless Properly Introduced--313; 705.01
Ex Parte Appeal:
Abandonment of Application During--1211
Access to Subject Application File (see also Access to Files)--121
Alternative Positions May be Taken by Applicant--1215
Amendment of Application:
After Decision on Appeal--1205; 1217; 1218
Amendment to Allege Use Filed, or Associated With File, During Appeal--1206.01
During Appeal--1205
Amendment to Allege Use Filed, or Associated With File, During--1206.01
Appealable Matter--1201.05
Approval by Examining Attorney of Application, During Appeal, for Publication:
In General--1210
Upon Assignment to Applicant of Cited Registration--1212
Upon Cancellation of Cited Registration--1210
Upon Consideration of Amendment--1202.02; 1205
Upon Consideration of Amendment to Allege Use--1206.01
Upon Consideration of Applicant's Reply Brief--1203.02(c)
Upon Consideration of Applicant's Appeal Brief--1203.02(b)
Upon Consideration of Evidence Submitted With Request to Remand for Additional

OLD EDITION

Evidence--1207.02
Upon Consideration of Request for Reconsideration of Final Action --1202.02; 1204
Assignment of Cited Registration During--1212
Briefs for (see also Briefs: Ex Parte Appeal)--1203
Cancellation of Cited Registration During --1212
Consolidation of Applications on Appeal --1214
Copies of Subject File or Parts Thereof--122; 123
Decision, Final--1217
Evidence in:
Submission of During Appeal:
After Granting of Letter of Protest--1207.06
Examining Attorney May Submit Additional Evidence With Action on Request for
Reconsideration of Final Action--1204; 1207.04
Evidence Submitted After Appeal Normally Untimely--1204; 1207.01
Evidentiary Record Should be Complete Prior to Appeal --1204; 1207.01
May be Considered Due to Actions of Nonoffering Party --1207.03
May be Submitted Upon Remand for New Refusal --1207.05
May be Submitted With Timely Request for Reconsideration of Final Action --1202.02; 1204; 1207.04
Request for Remand for--1207.02; 1207.06
Treatment of by TTAB, Fed. Cir--1208
Examining Attorney May Not Raise New Ground for Refusal During Appeal Except Upon Remand for the Purpose--1201.02; 1203.02(b); 1217
Examining Attorney May Not Take Further Action in Case After Issuance of Final Decision of TTAB--1217
Federal Rules of Evidence in--101.02
Fee for--1202.04
File Not to be Removed From Offices of TTAB --121.01; 122
Filing of Appeal:
Certificate of "Express Mail," Mailing, and Transmission Procedures Available for --1202.02
How to Take Appeal--1202.01
Notice of Appeal May be Filed by Fax --107; 110.01; 110.07; 1202.02
Procedure Followed by TTAB When Appeal and Amendment to Application Both Filed --1205
Procedure Followed by TTAB When Appeal and Request for Reconsideration of Appealed Action Both Filed--1202.02; 1203.02(a); 1204
Final Decision--1217
From Final Decision of TTAB--902.08; 1218; 1219.02
Ground for Refusal, New, May Not be Raised During Appeal Except Upon Remand for the Purpose--1201.02; 1203.02(b); 1217
Jurisdiction to Take Further Action After TTAB Final Decision, Examining Attorney Does Not Have--1217
Notice of Appeal--1202.03
Oral Hearing on--1216
Petitionable Matter (see also Petition to the Commissioner)--1201.05
Procedure Followed by TTAB When Appeal and Amendment to Application Both Filed --1205
Procedure Followed by TTAB When Appeal and Request for Reconsideration of Appealed Action

OLD EDITION

Both Filed--1202.02; 1203.02(a); 1204
Propriety of Appeal:
Appealable Versus Petitionable Matter (see also Petition to the Commissioner) --1201.05
Premature Appeal--1201.03
Premature Final Action--1201.02
Readiness of Case for Appeal--1201.01; 1201.03
Readiness of Case for Final Action --1201.02
Requirements Not Subject of Appeal Must be Complied With Prior to Appeal --1201.02; 1201.04; 1202.01
Reconsideration of Final Decision of TTAB, Request for --1219.01
Remand of Application to Examining Attorney During:
After Appeal to Fed. Cir--1218
After Granting of Letter of Protest--1207.06; 1209.03
For Consideration of Amendment or Request for Reconsideration --1202.02; 1204; 1205
For Consideration of Amendment to Allege Use --1206.01
For New Refusal or Suspension:
At Request of Examining Attorney --1203.02(c); 1209.02; 1209.03
Sua Sponte by TTAB--1209.01
For Submission of Additional Evidence --1207.02; 1207.06
TTAB Cannot Remand in Final Decision --1217
Reopening of Application After Final Decision --1217; 1218
Request for Reconsideration of Examining Attorney's Final Action (see also Reconsideration)--1202.02; 1204
Requirements Not Subject of Appeal Must be Complied With Prior to Appeal --1201.02; 1201.04; 1202.01
Statement of Use Filed During is Untimely --1206.02
Storage of Subject Application File (see also Storage of Files and Exhibits)--120.02
Suspension of Proceedings During:
At Request of Applicant--1213
For Remand to Examining Attorney:
For New Refusal--1203.02(b); 1209
For Submission of More Evidence --1207.02; 1207.06
Pending Consideration by Examining Attorney of:
Amendment to Allege Use--1206.01
Amendment to Application--1202.02; 1205
Request for Reconsideration of Final Action --1202.02; 1203.02(a); 1204
Time for Filing:
Both Notice of Appeal and Appeal Fee Must be Timely Filed--1202.01; 1202.04
Certificate of "Express Mail," Mailing, and Transmission Procedures Available for --1202.02
Filing of Request for Reconsideration of Examining Attorney's Final Action Does Not Stay Time for Filing Appeal--1202.02; 1204
Late-Filed Appeal--1202.02
Must be Filed Within 6 Months From Date of Appealed Action --1202.02
Notice of Appeal May be Filed by Fax --107; 110.01; 110.07; 1202.02
Premature Appeal--1201.03
TTAB Cannot Remand in Final Decision --1217
When Assignee May Take Action In --125
Expenses, Not Awarded by TTAB --502.06; 529.01

OLD EDITION

Express Mail (see Certificate of Express Mail)
Extension of Time:
Motion to Extend or Reopen (see also Motions, Types of)--502.02; 509
Of Discovery Period--403.04; 501.03; 502.02; 509
Of Testimony Periods--501.03; 502.02; 509; 701
Stipulation to Extend or Reopen Normally Should be Filed in Multiple Form --501.03
Stipulation to Extend or Reopen Should Specify New Date(s) --501.03
Stipulation to Extend Time to Respond to Discovery Request Need Not be Filed --403.04; 501.02
To Appeal Decision of TTAB--509.02; 902.02; 903.04
To Oppose (see Extension of Time to Oppose; Extension of Time to Oppose, Request for)
To Respond to Discovery Request--403.04; 501.03
Unconsented Motion--502.02
Upon Decision on Other Motion--502.02; 502.05; 509.02
Extension of Time to Oppose (see also Extension of Time to Oppose, Request for):
Access to Application File During--121; 209.01
Amendment of Application During or After:
Action by TTAB After Consideration of Amendment --212.05
Action by TTAB Upon Receipt of Amendment --212.04
Amendment During Opposition--212.06
Amendment Should be Addressed to TTAB --212.03
Amendment to Allege Use--219
Approval of Amendment, Conditions for--212.02
Does Not Require Potential Opposer's Consent --212.03
Effect on Extension of Time to Oppose--212.04; 212.05
Form of Amendment--212.03
Notification of Action on Amendment--212.05
Who Has Jurisdiction to Consider Amendment --212.01
Amendment to Allege Use Filed, or Associated With File, During --219
Disposition of Application File After--209.01
Effect on Extension of:
Amendment to Allege Use Filed, or Associated With File, During Extension --219
Inadvertent Issuance of Registration--216
Letter of Protest--215
Petition to the Comm'r From Action on Request for Extension of Time to Oppose --211.02
Request for Reconsideration of Action on Extension Request --211.01
Republication of Mark--214
Restoration of Jurisdiction to Examining Attorney --213
Statement of Use Filed During Extension --219
Inadvertent Issuance of Registration, During --216
Letter of Protest, During--215
Relinquishment by Potential Opposer of Extension --217
Republication of Mark, During--214
Request for (see Extension of Time to Oppose, Request for)
Restoration of Jurisdiction to Examining Attorney, During --213
Statement of Use Filed During--219
Storage of Application File During--120.02; 209.01
Suspension of Running of Extension:
Pending Action on Amendment to Application --212.04
Pending Determination of Letter of Protest --215
Upon Restoration of Jurisdiction to Examining Attorney --213

OLD EDITION

Withdrawal of Applicant's Representative During --212.01
Extension of Time to Oppose, Request for (see also Extension of Time to Oppose):
Action by TTAB on Request:
Determination of Extension Expiration Date --209.03; 209.04
Examination of Request --209.02
Grant or Denial of Request, Considerations Governing --209.03; 209.04
Notification of Action on Request --209.02
Objections to Request, Consideration of --210
Obtaining Application File --209.01
Petition to Commissioner for Review of Action --211.02
Request for Reconsideration of Action --210; 211.01
Suspension, General Policy Governing --209.03
Caption of --203.02
Consent, Written, When Required --207.03
Correction of Defective Request --207.02; 207.03; 208
Defective, Correction of --207.02; 207.03; 208
Duplicate Requests Should be Avoided --203.05
Essential Element Omitted --207.02; 207.03; 208
Expiration Date of Extension, How Determined --209.03; 209.04
Extension Beyond First 30 Days --207.02
Extension Beyond 120 Days From Publication --207.03; 209.03
Extension Beyond 360 Days From Publication --209.03
Extension, With Consent, Beyond 180 Days From Publication --209.03
Extraordinary Circumstances Showing (see also Showing of Cause, Requirements for):
Required Showing Omitted --207.03
When Required --207.03
Fee Not Required --204
First 30-Day Extension --207.01
Form of Request, Generally --203
Further Request Normally Must be Filed in Same Name --206.02
Further Request Filed in Different Name:
By Privy --206.02
Due to Misidentification in Earlier Request of Potential Opposer --206.03
General Information Concerning --201
Good Cause Showing (see also Showing of Cause, Requirements for):
Nature of Required Showing --207.02
Not Required for First 30-Day Extension --207.01
Required Showing Omitted --207.02
When Required --207.02; 207.03
Handling by TTAB of Request (see Action by TTAB on Request)
Late-Mailed Official Gazette --202.03; 209.04
Misidentification of Potential Opposer --206.03
Must be Made in Writing --203.01
Must Identify Potential Opposer --206.01
Notification to Applicant of Filing of Request --210
Number of Copies Required --203.01
Objections to Request --210
Official Gazette Late-Mailed --202.03; 209.04
Petition to Commissioner for Review of Action on --211.02
Privy, Further Request Filed by --206.02

OLD EDITION

Proof of Service, When Required --203.04; 207.03
Request for Reconsideration of Action on --210; 211.01
Required Element Omitted --207.02; 207.03; 208
Service of, When Required --203.04; 207.03; 210
Showing of Cause, Requirements for:
Not Required for First 30-Day Extension --207.01
Extension Beyond First 30 Days --207.02
Extension Beyond 120 Days From Publication --207.03
Signature of --203.03
Supplemental Register Mark Not Subject to Opposition --205; 302
Time for Filing:
Definition of Date of Publication of Mark --202.02
Effect on Time of:
Inadvertent Issuance of Registration --216
Letter of Protest --215
Petition to the Comm'r From Action on Previous Extension Request --211.02
Republication of Mark --214
Request for Reconsideration of Action on Previous Request --211.01
Restoration of Jurisdiction --213
Further Extension Request Must be Filed Prior to Expiration of Previous Extension --202.01
Generally --202.01
Late-filed Request --202.05
Prematurely Filed Request --202.04
Timeliness Requirements Cannot be Waived --202.05
When Official Gazette is Late-mailed --202.03
Unsigned --203.03
Who May Request Extension --201
Written Consent, When Required --207.03
Fax Transmission of Papers to TTAB Generally Improper --107; 110.01; 110.07; 1202.02
Fed. Rules of Civ. Procedure:
General Applicability in TTAB Proceedings --101.02
Rule 11 Applicable --314; 529.01
Fed. Rules of Evidence in TTAB Proceedings:
Ex Parte Appeals --101.02
Generally --101.02
Federal Trade Commission, May File Petition to Cancel --303.04
Fee:
For Filing Counterclaim --118.01; 319.02
For Filing Opposition:
Amount of --118.01; 309.01
Generally --309.01
Insufficient --309.02
For Filing Petition to Cancel:
Amount of --118.01; 310.01
Generally --310.01
Insufficient --310.04
When Petition is Filed by Federal Trade Commission (No Fee) --310.03
When Petition is in Form of Counterclaim (Fee Required) --310.02
Fees:

OLD EDITION

Attorneys', Not Awarded by TTAB --502.06
Checks, for Payment of --118.03
Coupons, for Payment of Certain --118.05
Deposit Accounts, for Payment of --118.04
Filing, Acceptable Methods of --107
Filing Date of, How Accorded --109
Filing Receipts for --108
Lists of --118.01
Methods of Payment --118.03; 118.04; 118.05
Money Orders, for Payment of --118.03
Must be Paid in Advance --118.02
Not Required for Request for Extension of Time to Oppose --204
Refund of (see Refund of Fees)
File Jacket or Wrapper:
Description of --120.01
Placement of Papers in --120.01
Storage of --120.02
Files:
Access to (see also Access to Files) --121
Application (see Application Files)
Confidential Materials in (see Confidential Materials)
Copies of Files or Parts Thereof --122; 123
Not to Be Removed From Offices of TTAB --121.01; 122
Proceeding (see Proceeding Files)
Registration (see Registration Files)
Storage of (see also Storage of Files and Exhibits) --120.02; 120.03; 121.03
Filing Date of Papers and Fees, How Accorded --109
Filing Papers and Fees Intended for TTAB, Methods of --107
Filing Receipts --108
Final Decision:
Adverse Decision in Opposition or Cancellation, Effect of on Right to Seek Concurrent Registration --1111
Appeal From (see Appeal From Decision of TTAB)
Augmented Panel for --541; 803
By Whom Rendered --803
Described Generally --803
In Ex Parte Appeal --1217
Motion for Augmented Panel --541; 803
Motion for Reconsideration of --544; 804
Motion for Relief From Final Judgment --545
Preparation of --803
Motion to Include Rule 2.131 Remand in Inter Partes Case --515; 805
With Remand to Examining Attorney in Inter Partes Case [Rule 2.131] --515; 805
Final Judgment, Motion for Relief From --545
Five-day Addition After Certain Manners of Service (see Rule 2.119(c) 5-Day Addition)
Foreign Attorney or Agent, Representation by --114.05
Foreign Depositions:
Discovery --404.03(c); 520; 714.01
Motion for Leave to Take Orally --520
Testimony --520; 713; 714

OLD EDITION

Foreign Party, Correspondence With --117.06
Format for Various TTAB Papers, Suggested --106.03
Geographic Limitations Considered by TTAB Only in Concurrent Use Proceeding --311; 318.02(b); 319.01; 514.03; 1101.02
Goose-Gander Rule --402.02
Hague Convention Procedure --404.03(c)(2)
Heading of Papers Filed With TTAB, Proper --106.01
Hearing, Motion for Augmented Panel --541; 802.04
Hearing, Oral (see Oral Hearing)
Hypothetical Pleading --312.03
Identification of Papers Filed With TTAB, Proper --106.01
In Camera Inspection of Documents --416.03
Inadvertently Issued Registration --216; 307.10
Information, Obtaining Procedural --105
Inherent Power of TTAB to Schedule Proceedings --510.01
Inspection of Files at TTAB (see Access to Files)
Interference Proceeding:
Abandonment of Subject Application During (see also Abandonment of Application) --603
Access to Files During (see also Access to Files) --121
Addition of Party to --1006
Appeal From Decision of TTAB in (see Appeal From Decision of TTAB)
Briefing Schedule --801.02; 1007
Briefs on Case (see also Briefs: On Case) --801
Burden of Proof in, Who Has --1005
Commencement of --301; 403.02; 1003
Compared to Cancellation or Opposition --1007
Conduct of Proceeding Described, In General --1007
Decision, Final (see also Final Decision) --803; 806
Declared Only Upon Petition to Commissioner Showing Extraordinary Circumstances --1001; 1002
Defendant, Defined --1005
Described --102.02; 1001
Examination of Application With Petition to Commissioner to Declare Interference --1002; 1003
Fee Not Required Beyond Fee for Petition to Commissioner to Declare Interference --1003
Final Decision in (see also Final Decision) --803; 806
Has No Pleadings --1003; 1004
Institution of --1003
Issues in --1004
Junior Party, Defined --1005
Not Declared Between Application and Registration --1001; 1002
Notice of Interference --1003; 1007
Opposition to Application Published Subject to Interference, Procedure When Filed --1003
Oral Hearing (see also Oral Hearing: On the Case) --802; 1007
Petition to Commissioner From Action of TTAB During (see Petition to the Commissioner)
Petition to Commissioner to Declare (see also Petition to Commissioner) --1001; 1002
Plaintiff, Defined --1005
Pleadings Not Used in Interference --1003; 1004
Procedure When Application Published Subject to Interference is Opposed --1003
Senior Party, Defined --1005
Status of Application After Proceeding --807

OLD EDITION

Storage of Files During and After (see Storage of Files and Exhibits)
Termination of--121.03; 806
Trial Schedule for--701; 1007
Interrogatories (see also Discovery: Interrogatories)--406; 407
Introduction of Evidence (see Evidence, Introduction of in Inter Partes Proceeding)
Involuntary Dismissal Under FRCP 41(b), Motion for Not Available --502.01; 535.04
Joinder of Party--512
Joint Plaintiffs May File Opposition or Cancellation --304
Judgment:
Based Upon Settlement Agreement, Effect of --605.03(e)
Consent to Entry of Against Self--604
Default, for Failure to Answer, Motion for --508
Default, for Failure to Answer Notice of Institution in Concurrent Use Proceeding --1106
Default, Motion for Relief From --317.03; 545
Entered Subject to Prevailing Party's Establishment of Constructive Use --901.02(b)
Final, Motion for Relief From --545
For Failure of Plaintiff to File Main Brief on Case, Motion for [Rule 2.12 8(a)(3)]--537; 801.02(a)
For Failure of Plaintiff to Offer Evidence, Motion for (see also Motions, Types of)--502.01; 535
Motion for, due to Cancellation, Under Sec. 8 or 9 During Case, of Defendant's Regis. [Rule 2.134(b)]--536
On Pleadings, Motion for (see also Motion, Types of)--504
Summary, Motion for (see also Motions, Types of)--528
Judicial Notice (see also Evidence, Introduction of in Inter Partes Proceeding) --712
Junior Party, Defined--1005; 1107
Jurisdiction of TTAB, Generally--102.01
Jurisdiction Over Plaintiff's Pending Application, TTAB Does Not Have --605.03(c)
Jurisdiction, Restoration of to Examining Attorney (see Restoration of Jurisdiction to Examining Attorney)
Jurisdiction to Take Further Action After TTAB Final Decision in Ex Parte Appeal, Examining Attorney Does Not Have--1217
Juristic Person, Meaning of--303.02
Late-mailed Official Gazette, Effect on Time to Oppose--202.03; 209.04
Letter of Protest:
Described--215
Effect on Time to Oppose--215; 307.07
Time for Filing--215
Letter Rogatory Procedure--404.03(c)(2)
LEXIS Legal Data Base, TTAB Decisions in --101.03
Limit, Page, for Brief on Case--538; 801.03
Mailing Address of TTAB--103
Mailing Date of Official Gazette--202.03; 209.04
Misidentification:
Of Applicant or Registrant--512.04
Of Plaintiff--512.04
Of Potential Opposer--206.03; 303.05(c)
Money Orders, for Payment of Fees --118.03
More Definite Statement, Motion for (see also Motions, Types of)--505
Motions, Generally:
Action on--502.05
Authority of TTAB Members, Interlocutory Attorneys to Act (see Trademark Trial and Appeal

OLD EDITION

Board)
Briefs on (see also Briefs: On Motions) --502.03
Caption of --502.02
Certificate of "Express Mail" Available for --502.02
Certificate of Mailing by First-Class Mail Available for --502.02
Conferences on, Telephone or Pre-Trial --417; 502.07
Determination of --502.05
Form of --502.02
Identification of --502.02
Must be Made in Writing --502.02
Must be Served on Every Other Party --502.02
Oral Hearings on --502.04
Pre-Trial Conferences on --417; 502.07(b)
Reconsideration of Decision on --518
Rule 11 FRCP Applicable --314; 529.01
Signature of --502.02
Telephone Conferences on --417; 502.07(a)
Types Available Differ From District Court --502.01
Unsigned --502.02
Who May Act on --502.05
Motions, Types of:
Attacking Discovery Requests --Generally Inappropriate --407.02; 409.02; 411.02; 414; 526
Consented --502.02; 502.05
Contested --502.02; 502.05
For Additional Time for Argument at Oral Hearing --542.02; 802.05
For Attorneys' Fees (Not Awarded by TTAB) --502.06; 529.01
For Augmented Panel Hearing --541; 802.04
For Damages (Not Awarded by TTAB) --502.06; 529.01
For Default Judgment for Failure to Answer --508
For Directed Verdict, Not Available --502.01; 535.04
For Discovery Sanctions:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
Estoppel Sanction --527.05
For Failure to Comply With Order re Discovery --527.01
For Failure to Respond, or Respond Properly, to Admission Request --527.04
For Failure to Timely Respond --403.03; 527.03
If Party Says it Won't Respond to Discovery --527.02
For Discovery to Respond to Summary Judgment Motion --528.06
For Expenses (Not Awarded by TTAB) --502.06; 529.01
For Involuntary Dismissal Under FRCP 41(b), Not Available --502.01; 535.04
For Judgment due to Cancellation, Under Sec. 8 or 9 During Case, of Defendant's Registration [Rule 2.134(b)] --536; 602.02(b)
For Judgment for Failure of Plaintiff to File Main Brief on Case [Rule 2.128(a)(3)] --537; 801.02(a)
For Judgment for Failure of Plaintiff to Offer Evidence:
In General --502.01; 535.01
Motion Under FRCP 41(b) or FRCP 50(a) Not Available --502.01; 535.04
No Evidence at All [Rule 2.132(a)] --502.01; 535.02
No Evidence But PTO Records [Rule 2.132(b)] --502.01; 535.03
Other Motions Relating to Sufficiency of Evidence Not Available --502.01; 535.04
For Judgment on the Pleadings:

OLD EDITION

Determination of Motion--504.02
Nature of Motion--504.02
Submission of Matters Outside Pleadings --504.03; 528.04
Time for Filing--504.01
For Leave to Audiotape Oral Hearing --543; 802.06
For Leave to Exceed Page Limit for Brief on Case --538; 801.03
For Leave to File Amicus Brief--539
For Leave to Serve More Interrogatories --406.03(c); 519
For More Definite Statement:
Failure to Obey Order for Such Statement --505.03
May Not be Used to Obtain Discovery --505.01
Nature of Motion--505.01
Time for Filing--505.02
For Order re Manner or Place of Production of Documents --522
For Order to Show Cause due to Cancellation, Under Sec. 8 or 9 During Case, of Defendant's Registration [Rule 2.134(b)] --536; 602.02(b)

OLD EDITION

For Order to Show Cause re Plaintiff's Failure to File Main Brief on Case [Rule 2.128(a)(3)] --537; 801.02(a)
For Protective Order--416.01; 526
For Reconsideration of Final Decision --544; 804
For Reconsideration of Decision on Motion --518
For Relief From Default Judgment for Failure to Timely Answer Compl aint--317.03; 545
For Relief From Final Judgment --545
For Sanctions:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
For Failure to Comply With Protective Order --527.01
Non-Discovery--529.02
Relating to Discovery (see also Motions, Types of: For Discovery Sanctions) --527
Under Rule 11, FRCP--529.01
Where Party Cannot be Located --529.02
Where Party States it Will Not Proceed --529.02
For Summary Judgment:
Evidence on:
Affidavits and Attached Exhibits --528.05(b)
Discovery Responses --528.05(c)
In General--528.05(a)
Of Record Only for Motion --528.05(a)
Registrations--528.05(d)
Testimony From Another Case --528.05(e)
Judgment May be Entered for Nonmoving Party --528.08
Miscaptioned Motion --528.04
Motion for Discovery to Respond to --528.06
Nature of Motion--528.01
Should Specify Facts Said to be Disputed, or Undisputed --528.01
Standards for Determining --528.01
Suspension of Case Pending Determination of --528.03
Time for Filing--528.02
Unpleaded Issue Not Basis for --528.07(a)
Unpleaded Issue Not Defense Against --528.07(b)
Without Supporting Evidence --528.04
Relating to Sufficiency of Trial Evidence --502.01; 535
That Deposition Upon Written Questions be Taken Orally --532; 713.02; 714.01
To Amend Application or Registration:
Amendment With Consent --514.02
Amendment Without Consent --514.03
As Defense to Proceeding --318.02(b); 514.03
Geographic Limitations Considered Only in Concurrent Use Proceed ing--311; 318.02(b); 319.01; 514.03; 1101.02
In General--514.01
Requirements for--514.01
To Amend Name of Misidentified Party --512.04
To Amend Pleading:
In General--507.01
Should be Accompanied by Proposed Pleading --507.01
Under FRCP 15(a)--507.02
Under FRCP 15(b)--507.03

OLD EDITION

When Motion Necessary --507.02
To Change Oral Hearing Date --542.01; 802.03
To Change Title of Proceeding --512
To Compel Discovery:
Answer to Interrogatories --406.03(e); 415.01; 523
Failure to File Motion --523.04
In General --523.01
Production of Documents --415.01; 523
Re Deposition --404.02; 415.03; 523
Requirements for Motion --523.02
Time for Filing --523.03
TTAB Not Bound by Introduction or Preamble to Interrogatories --406.03(d)
When Interrogatories are Objected to as Excessive --406.03(e)
To Consolidate --511
To Correct Name of Misidentified Party --512.04
To Dismiss for Failure of Plaintiff to Offer Evidence:
In General --502.01; 535.01
Motion Under FRCP 41(b) or FRCP 50(a) Not Available --502.01; 535.04
No Evidence at All [Rule 2.132(a)] --502.01; 535.02
No Evidence But PTO Records [Rule 2.132(b)] --502.01; 535.03
Other Motions Relating to Sufficiency of Evidence Not Available --502.01; 535.04
To Dismiss for Failure to State Claim:
Amendment of Defective Pleading --503.03
Determination of --503.02
Nature of Motion --503.02
Submission of Matters Outside Pleading --503.04; 528.04
Time for Filing --503.01
To Dismiss Under FRCP 41(b) or 50(a), Not Availab le --502.01; 535.04
To Divide Application --516
To Extend:
Consented:
Determination of --509.02
Form of --509.02
Should be Filed in Multiple Form --502.02; 509.02
Should Specify New Date(s) --502.02; 509.02
Nature of Motion --509.01
Requirement for Good Cause Showing --509.01
Unconsented:
Determination of --509.02
May Not be Granted --509.02
Request That Reset Date(s) Run From Date of Decision on Motion --502.02; 509.02
Should be Filed in Single Form --502.02; 509.02
Upon Decision on Other Motion --502.02; 502.05; 509.02
To Hold Person in Contempt (TTAB Cannot) --502.06
To Join or Substitute:
Issuance of Registration in Name of Assignee or in Changed Name --512.03
Proceeding May be Continued in Original Name --512.01; 512.02
Upon Change of Name --512.02
Upon Misidentification by Mistake --512.04

OLD EDITION

Upon Transfer of Interest in Mark --512.01
To Offer Discovery Deposition of Self or Nonparty --530
To Quash Notice of Deposition --521
To Remand Application to Examining Attorney --515; 805
To Reopen:
Consented:
Determination of --509.02
Form of --509.02
Should be Filed in Multiple Form --502.02; 509.02
Should Specify New Date(s) --502.02; 509.02
For Introduction of Newly Discovered Evidence --509.01; 705.02
Nature of Motion --509.01
Requirement for Showing of Excusable Neglect or Newly Discovered Evidence --509.01
Unconsented:
Determination of --509.02
May Not be Granted --509.02
Request That Reset Date(s) Run From Date of Decisi on on Motion --502.02; 509.02
Should be Filed in Single Form --502.02; 509.02
Upon Decision on Other Motion --502.02; 502.05; 509.02
To Resume Proceedings:
After Conclusion of Bankruptcy Proceeding --510.03(b)
After Determination of Another Proceeding --510.02(b)
After Suspension for Settlement Negotiations --510.03(b)
To Strike Brief on Case, or Attached Exhibits --540; 801.05
To Strike Brief on Motion:
Brief in Support of, or in Opposition to, Motion --517.01
Reply Brief --517.02
To Strike Notice of Reliance --533
To Strike Part of Pleading:
Exhibits Attached to Pleadings --506.03
Motion Not Favored --506.01
Nature of Motion --506.01
Time for Filing --506.02
To Strike Trial Testimony Deposition:
For Inadequate Notice --521; 534.02
For Untimeliness --534.01
When Motion Should Not be Filed --534.03; 718.03(c)
To Substitute or Join:
Issuance of Registration in Name of Assignee or in Changed Name --512.03
Proceeding May be Continued in Original Name --512.01; 512.02
Upon Change of Name --512.02
Upon Misidentification by Mistake --512.04
Upon Transfer of Interest in Mark --512.01
To Suspend Proceedings:
Due to Withdrawal of Party's Attorney --510.03(a)
For Bankruptcy Proceeding --510.03(a)
For Good Cause --510.03(a)
For Settlement Negotiations --510.03(a)
Pending Deposition Upon Written Questions --510.03(a)

OLD EDITION

Pending Disposition of Potentially Dispositive Motion --510.03(a)
Pending Outcome of Another Proceeding --510.02(a)
Potentially Dispositive Motion Also Pending --510.02(a)
TTAB has Inherent Power to Suspend --510.01
To Take Foreign Deposition Orally --520; 713.02; 714.01
To Test Sufficiency of Response to Admission Request:
Failure to File Motion --524.04
In General--415.02; 524.01
Requirements for Motion --524.02
Time for Filing Motion --524.03
To Use Testimony From Another Proceeding --531; 715
To Withdraw as Representative:
Action by TTAB After Granting of Motion --116.05; 510.03(b); 513.01
Requirements for Motion --116.05; 513.01
To Withdraw or Amend Admission --411.04; 525
Types Available Differ From District Court --502.01
Unconsented, Uncontested --502.02; 502.05
Move by Party or Representative to New Address --117.07
Multiple Class Application or Registration, Opposition or Cancellation Against --305
Negotiation for Settlement:
Resumption of Proceedings After --510.03(b)
Suspension of Proceedings During --510.03(a); 605.02
Newly Discovered Evidence, Motion to Reopen Testimony Period for Introduction of --509.01; 705.02
Non-lawyer, Representation by --114.04; 114.06; 117.08
Notice, Judicial (see also Evidence, Introduction of in Inter Partes Proceeding) --712
Notice of Appeal From Decision of TTAB (see Appeal From Decision of TTAB)
Notice of Deposition, Requirements for:
Discovery Deposition --404.04
Testimony Deposition:
Oral--713.05
Upon Written Questions --714.06
Notice of Election to Have Review by Civil Action of TTAB Decision (see also Appeal From Decision of TTAB)--901.01; 902.03; 902.04; 903.06
Notice of Opposition (see also Complaint)--312
Notice of Reliance:
Introduction of Evidence by (see Evidence, Introduction of)
Motion to Strike --533
Notices in Official Gazette, Effect on TTAB Proceedings of --101.04
Notification of TTAB Proceeding:
Concurrent Use Proceeding-- 1105
Interference Proceeding-- 1003
Opposition or Cancellation Proceeding:
Defendent's Copy Returned as Undeliverable --315.02
Description of Notification Letter --315.01
General Procedure --315.01
To Whom Sent--315.01
Number of Copies Required for Various TTAB Papers --106.03; 203.01
Objections:
In General--718.01
To Discovery Deposition:

OLD EDITION

Conduct of Parties--405.03
Curable Error--405.03
Deposition Proceedings--405.03
Deposition Questions--404.02; 404.03(b)(2); 405.03
Motion to Quash Notice--521
Motion to Strike Deposition--534
Notice of Deposition--521; 405.01
Oath--405.03
Qualification of Officer--405.02
Substantive--405.03
Waiver of--405.03
To Interrogatories:
Excessive--406.03(e)
Stated in Lieu of Answer--407.02
To Notice of Reliance (and Accompanying Evidence):
Curability--533; 718.02(b)
Motion to Strike Notice--533
On Ground of Untimeliness--533; 718.02(a)
On Other Procedural Grounds--533; 718.02(b)
On Substantive Grounds--533; 718.02(c)
Waiver of--718.02; 718.04
To Requests for Admission--411.02
To Requests for Production of Documents --409.02
To Testimony Deposition, Oral:
Curability--718.03(a); 718.03(c)
Deposition Answers--534.03; 718.03(c)
Deposition Proceedings--713.08; 718.03(c)
Deposition Questions--404.02; 713.08; 718.03(d)
Form of Transcript--718.03(c)
Motion to Quash Notice--521
Motion to Strike Deposition--534; 718.03(c)
Notice of Deposition--521; 534.02; 713.05; 713.08; 718.03(b)
On Ground of Untimeliness--534.01; 718.03(a)
On Other Procedural Grounds--534.03; 718.03(c)
On Substantive Grounds--534.03; 718.03(c)
Qualification of Officer--713.08; 718.03(c)
Refusal to Answer--404.02; 713.08; 718.03(d)
Testimony Not Read Prior to Final Decision --502.01; 535.04; 718.02(c); 718.03(c)
Waiver of--718.03(c); 718.04
To Testimony Deposition, Upon Written Questions:
Curability--718.03(a); 718.03(c)
Deposition Answers--534.03; 714.13; 718.03(c)
Deposition Proceedings--713.08; 718.03(c)
Deposition Questions--404.02; 714.07; 714.13; 718.03(d)
Form of Transcript--718.03(c)
Motion to Quash Notice--521
Motion to Strike Deposition--521; 534; 718.03(c)
Notice of Deposition--521; 534.02; 714.06; 718.03(b)
On Ground of Untimeliness--534.01; 714.04; 718.03(a)
On Other Procedural Grounds--534.03; 718.03(c)

OLD EDITION

On Substantive Grounds--534.03; 718.03(c)
Qualification of Officer--713.08; 718.03(c)
Refusal to Answer--404.02; 713.08; 718.03(d)
Testimony Not Read Prior to Final Decision--502.01; 535.04; 718.02(c); 718.03(c)
Waiver of--718.03(c); 718.04
Waiver of--718.02; 718.03; 718.04
Obtaining Status Information for Applications and Registrations--124
Obtaining TTAB Verification Letter--123.03
Official Gazette:
Late-mailed, Effect on Time to Oppose of--202.03; 209.04
Mailing Date of--202.03
Notices, Effect on TTAB Proceedings of--101.04
Official Records, Introduction of--707
Opinions, Advisory, Not Issued by TTAB--605.03(f)
Opposition Proceeding:
Abandoned Application Not Subject to Opposition--307.11
Abandonment of Application by Applicant During--218; 307.11; 602.01
Abandonment of Proceeding, by Opposer (see also Withdrawal of Proceeding by Plaintiff)--601
Access to Files During (see also Access to Files)--121
Adverse Decision in, Effect of on Right to Seek Concurrent Registration--1111
Amendment of Application During--212.06
Amendment to Allege Use Filed, or Associated With File, During--219
Answer, Generally (see also Answer)--316; 318
Appeal From Decision of TTAB in (see Appeal From Decision of TTAB)
Briefing Schedule--801.02
Briefs on Case (see also Briefs: On Case)--801
Combined Complaint May be Filed--306
Commencement of--301; 403.02
Complaint (see also Complaint)--312
Consolidated Complaint May be Filed--306
"Conversion" to Concurrent Use Proceeding--514.03; 1112
Decision, Adverse, in Opposition, Effect of on Right to Seek Concurrent Registration--1111
Decision, Final (see also Final Decision)--803; 806
Described--102.02
Effect of Adverse Decision in Opposition on Right to Seek Concurrent Registration--1111
Extension of Time to File (see Extension of Time to Oppose)
Fee for Filing (see also Fee)--118.01; 309
Final Decision in (see also Final Decision)--803; 806
Geographic Limitations Not Considered in--311; 318.02(b); 319.01; 514.03; 1101.02
Identity of Defendant--315.01
Inadvertent Issuance of Registration During--216; 307.10
Joint Opposers May File--304
Late-filed--307.04
Letter of Protest During Opposition Period--215; 307.07
Misidentification of Party Granted Extension of Time to Oppose--303.05(c)
Multiple Class Application, Opposition Against--305
Notice of Opposition (see also Complaint)--312
Notification of Proceeding (see also Notification of TTAB Proceeding)--315
Oral Hearing (see also Oral Hearing: On the Case)--802
Partial Opposition--311

OLD EDITION

OLD EDITION

Petition to the Commissioner From Action on Request for Extension of Time to Oppose, Effect of --
307.08
Prematurely Filed--307.03
Privy of Party Granted Extension of Time to Oppose, Opposition Filed by --303.05(b)
Republication of Mark, Effect of on Time for Filing Opposition --214; 307.09
Restoration of Jurisdiction to Examining Attorney During Opposition Period --213; 307.06
Scope of--311
Statement of Use Filed During (Untimely) --219
Status of Application After Proceeding --807
Storage of Files During and After (see Storage of Files and Exhibits)
Supplemental Register Mark Not Subject to Opposition --205; 302
Suspension of Extension of Time to Oppose, Effect of --307.05
Termination of--121.03; 806
Time for Filing:
Definition of Date of Publication of Mark --202.02; 307.02
Effect on Time of:
Abandonment of Application --307.11
Inadvertent Issuance of Registration --216; 307.10
Letter of Protest--215; 307.07
Petition to the Comm'r From Action on Request for Extension of Time to Oppose--211.02; 307.08
Republication of Mark --214; 307.09
Request for Reconsideration of Action on Request for Extension of Time to Oppose-211.01
Restoration of Jurisdiction to Examining Attorney During Opposition Period--213; 307.06
Suspension of Extension of Time to Oppose --307.05
Extension of Time to File (see Extension of Time to Oppose; Extension of Time to Oppose, Request for)
General Information Concerning --307.01
Late-filed Opposition --307.04
Opposition Filed During Original Opposition Period Accepted as Timely Even if Mark Republished--214
Opposition Filed During Suspension of Extension of Time to Oppose for Consideration of Application Amendment Accepted as Timely--212.04
Premature Opposition --307.03
When Official Gazette is Late-mailed--202.03
To Application Published Subject to Concurrent Use Proceeding --1105
To Application Published Subject to Interference Proceeding --1003
Trial Schedule--701
Who is Defendant--315.01
Who May Oppose:
After Extension of Time to Oppose:
General Rule--303.05(a)
Misidentification of Party Granted Extension --303.05(c)
Party in Privity With Party Granted Extension --303.05(b)
Damage, Meaning of--303.03

OLD EDITION

Described, Generally--303.01
Joint Opposers--304
Person, Meaning of--303.02
Standing--303.03
Withdrawal of Application by Applicant During --218; 307.11; 602.01
Withdrawal of Proceeding, by Opposer (see also Withdrawal of Proceeding by Plaintiff) --601
Oral Hearing:
On a Motion--502.04
On Ex Parte Appeal--1216
On the Case (Inter Partes):
Audiotape Exhibit May be Used--802.07
Audiotaping May be Permitted--543; 802.06
Before Whom Held--541; 802.04
Corresponds to Oral Summation in Civil Action--802.01
Date of--542.01; 802.03
Described--802.05; 802.08
Length of--542.02; 802.05
Location of--802.03
May Not be Used to Introduce Evidence --717; 802.01; 802.07
Motion for Additional Time for Argument --542.02; 802.05
Motion for Augmented Panel Hearing --541; 802.04
Motion for Leave to Audiotape Hearing --543; 802.06
Motion to Change Oral Hearing Date --542.01; 802.03
Must be Requested--802.02
Nature of--802.05; 802.08
Not Mandatory--802.01; 802.03
Notice of--802.03
Party Which Appears at Will be Heard --802.03
Party Which Elects Not to Appear Should Notify TTAB Thereof --802.03
Purpose of--802.01
Request for--802.02
Time for, Length of--542.02; 802.05
Time of--542.01; 802.03
Videotape Exhibit May be Used--802.07
Videotaping Not Permitted--543; 802.06
Visual Aids, Including Audiotape and Videotape Exhibits, May be Used --802.07
When Advisable--802.01
Written Text of Oral Argument May Not be Submitted --802.07
Ordering Abstracts of Title to Applications and Registrations --122
Ordering Copies of Files or Parts Thereof--122; 123
Ordering Copies of Registrations--122
Order to Show Cause:
Why Default Judgment Should not be Entered Against Defendant for Failure to Answer --317; 508
Why Judgment Should not be Entered Against Defendant for Permitting its Registration to be Cancelled Under Sec. 8 or 9 During Case [Rule 2.134(b)] --536; 602.02(b)
Why Judgment Should not be Entered Against Plaintiff for Failur e to File Main Brief [Rule 2.128(a)(3)]--537; 801.02(a)
Other Authorized Representative of Party --114.04
Page Limit for Brief on Case--538; 801.03
Panel Hearing, Augmented, Motion for --541; 802.04

OLD EDITION

Paper, Preferred Size of--106.03
Papers:
According Filing Date to--109
Bound Form, When Appropriate--106.03; 120.01
Caption of Papers Filed With TTAB, Proper --106.01
Confidential (see Confidential Materials)
Copying Papers From PTO Files--122; 123
Discovery, When to be Filed--413
Either Original or Copy May be Filed--106.02; 106.03
Fax Transmission to TTAB Generally Improper --107; 110.01; 110.07; 1202.02
Filing, Acceptable Methods of--107
Filing Date of, How Accorded--109
Filing Receipts for--108
Generally--106
Not to be Removed From Offices of TTAB --121.01; 122
Number of Copies Required for Various TTAB --106.03; 203.01
Ordering Copies of--122; 123
Original Need Not be Filed--106.02; 106.03
Paper, Preferred Size of--106.03
Return of--119.02; 119.03
Service of (see Service of Papers)
Signature of--106.02
Suggested Format for Various TTAB --106.03
Unsigned--106.02
Partial Cancellation of Registration --311; 319.01
Partial Opposition to Application --311
Permissive Counterclaim (see also Counterclaim)--319.05; 319.06
Person, Meaning of--303.02
Petition to Cancel (see also Complaint)--312
Petition to Disqualify Practitioner --115.03; 513.02
Petition to the Commissioner:
Appealable Versus Petitionable Matter --901.02(a); 905; 1201.05
Form for--905
For Review of Action During Ex Parte Prosecution of Application --1201.05
For Review of Action of TTAB in TTAB Proceeding:
Filing of Petition Does Not Stay Proceeding --905
Time for Filing--905
What is Petitionable--901.02(a); 905; 1201.05
For Review of Action on Request for Extension of Time to Oppose --211.02; 307.08
In General--905
Oral Hearing on--905
Petitionable Matter--901.02(a); 905; 1201.05
Requirements for--905
To Declare an Interference:
Examination of Application Which is Subject of Petition--1002; 1003
Form for--905; 1002
Interference Declared Only Upon Petition to Commissioner --1001; 1002
Interference Not Declared Between Application and Registration --1001; 1002
Must Show Extraordinary Circumstances --1002
To Disqualify Practitioner--115.03; 513.02

OLD EDITION

To Reopen Application After Final Decision of TTAB in Ex Parte Appeal --1218
Pleadings:
Amendment of (see also Amendment of Pleadings; Motions, Types of) --322; 507
Answer, Generally (see also Answer)--316; 318
Complaint, Generally (see also Complaint)--312
Construed so as to do Substantial Justice --312.03
Counterclaim, Generally (see also Counterclaim)--319
Defenses, Generally (see also Defenses)--318.02(b)
Exhibits to Not Evidence Unless Properly Introduced --313; 705.01
Evidentiary Matters Should Not be Pleaded --312.03; 318.02(b)
Exhibits to, Not Evidence --313
Fair Notice of Basis Required --312.03; 318.02(b)
Motion to Amend (see also Motions, Types of) --507
Motion to Strike Part of (see also Motions, Types of) --506
Permissible Scope of Complaint --311
Purpose of--507.01
Remedies Available to Plaintiff --311
Rule 11 FRCP Applicable --314; 529.01
Statements in, Evidentiary Value of --706.01
Unpleaded Matters (see also Unpleaded Matters) --528.07; 321
Potential Opposition (see Extension of Time to Oppose)
Power of Attorney:
Elements of--114.03
Revocation of--116.01
Power of TTAB to Schedule Proceedings --510.01
Pre-Trial Conferences --417; 502.07(b)
Printed Publications, Introduction of --708
Privity, Defined--206.02
Privy, Further Request for Extension of Time to Oppose, or Opposition, Filed by --206.02; 303.05(b)
Proceeding Files:
Access to (see also Access to Files)--121
Description of--120.01
Docket Entries in--120.01
Envelope For--120.01
Not to be Removed From Offices of TTAB --121.01; 122
Placement of Papers in--120.01
Storage of (see also Storage of Files and Exhibits) --120.02; 120.03; 121.03
Proceedings Before TTAB:
Access to Files During (see also Access to Files)--121
Combined Complaint May be Filed --306
Commencement of Inter Partes --301
Consolidated Complaint May be Filed --306
General Description of Nature --102.03
Fee for Filing (see Fee; Fees)
Joint Plaintiffs May File Opposition or Cancellation --304
Multiple Class Application or Registration, Proceeding Against --305
Storage of Files During and After (see Storage of Files and Exhibits)
Types of:
Cancellation Described (see also Cancellation Proceeding) --102.02
Concurrent Use Described (see also Concurrent Use Proceeding) --102.02

OLD EDITION

Ex Parte Appeal Described (see also Ex Parte Appeal)--102.02
Interference Described (see also Interference Proceeding)--102.02
Opposition Described (see also Opposition Proceeding)--102.02
When Assignee May Take Action In--125
Who May Bring Opposition or Cancellation:
After Extension of Time to Oppose:
General Rule--303.05(a)
Misidentification of Party Granted Extension --303.05(c)
Party in Privity With Party Granted Extension --303.05(b)
Damage, Meaning of--303.03
Described, Generally--303.01
Federal Trade Commission May File Cancellation --303.04
Joint Plaintiffs--304
Person, Meaning of--303.02
Standing--303.03
Production of Documents (see also Discovery: Requests for Production of Documents) --408; 409; 522
Proof of Service, Requirement for--113.02
Protective Orders (see also Discovery: Protective Orders)--416; 526; 713.16
Protest, Letter of--215
Publication Date of Mark, Definition of--202.02
Publications, Printed, Introduction of--708
Quash Notice of Deposition, Motion to--521
Reconsideration:
Of Action on Request for Extension of Time to Oppose, Request for --210; 211.01
Of Decision on Motion, Motion for--518
Of Examining Attorney's Final Action in Application, Request for:
Action by Examining Attorney on--1202.02; 1204
Does Not Stay Time for Filing Appeal--1202.02; 1204
If Filed, Must be Filed Within 6 Months of Final Action --1202.02; 1204
May be Accompanied by Amendment and/or Additional Evidence --1202.02; 1204; 1207.04
Procedure Followed by TTAB When Appeal and Request for Reconsideration of Appealed Action Both Filed--1202.02; 1203.02(a); 1204
Should Not be Combined With Applicant's Appeal Brief --1204
Of Final Decision of TTAB:
In Ex Parte Appeal, Request for--1219.01
In Inter Partes Case, Motion for--544; 804
Records, Official, Introduction of--707
Refund of Fees:
General Rule--119.01
In Ex Parte Cases--119.02
In Inter Partes Cases--119.03
Refusal to Answer Deposition Question:
Discovery Deposition--404.02; 404.03(b)(2); 405.03; 415.03; 523
Testimony Deposition--404.02; 713.08; 718.03(d)
Registration Files:
Access to (see also Access to Files)--121
Copies of Files or Parts Thereof--122; 123
Not to be Removed From Offices of TTAB --121.01; 122
Storage of (see also Storage of Files and Exhibits)--120.02; 121.03

OLD EDITION

Registration:
Abandonment of During Inter Partes Proceeding --602.02
Abstract of Title to--122
Allegations, Specimens, etc., Not Evidence for O wner Unless Proved at Trial--703.01; 704
Amendment of (see Amendment of Registration)
Cancellation of (see Cancellation Proceeding; Counterclaim)
Cancelled--703.02(a)
Cannot be Divided--516
Concurrent Use (see also Application: Concurrent Use; Concurrent Use Proceeding):
Alteration of Restrictions on--1113
Bases for Issuance of--1101.03
Cannot be Obtained by Including Geographical Restriction in Identification of Goods --1102.01
How Obtained--1101; 1102
Registration Cannot be Geographically Restricted by Section 7(e) Amendment --1101.02; 1113
Defendant's Registration Cancelled Under Sec. 8 or 9 During Case, Motion for Order to Show Cause Due to [Rule 2.134(b)] --536; 602.02(b)
Electronic Equivalent of Copy of--703.02(b)
Evidentiary Value of--703.02(a)
Expired--703.02(a)
Foreign--703.02(a)
Geographic Restriction of, How Obtained, Altered, Removed --1101.02; 1113
Inadvertently Issued--216; 307.10
Introduction into Evidence (see also Evidence, Introduction of)--703
Obtaining Status Information Concerning --124
Ordering Copies of--122
Party's--703.02(a)
Principal Register--703.02(a)
Restriction of (see Restriction of Application or Registration)
Section 7(b) Presumptions Accorded to --703.02(a); 703.02(b)
State--703.02(a)
Statements and Things in File Not Evidence for Owner Unless Proved at Trial --703.01; 704
Supplemental Register--703.02(a)
Surrender of During Inter Partes Proceeding --602.02
Third-Party--703.02(b)
When Assignee May Take Action In--125
Withdrawal of During Inter Partes Proceeding --602.02
Voluntary Surrender of During Inter Partes Proceeding --602.02
Remand to Examining Attorney:
Of Application During Ex Parte Appeal to Fed. Cir --1218
Of Application During Ex Parte Appeal to TTAB:
After Granting of Letter of Protest --1207.06; 1209.03
For Consideration of Amendment or Request for Reconsideration --1202.02; 1204; 1205
For Consideration of Amendment to Allege Use --1206.01
For New Refusal or Suspension:
At Request of Examining Attorney --1203.02(c); 1209.02; 1209.03
Sua Sponte by TTAB--1209.01
For Submission of Additional Evidence --1207.02; 1207.06
TTAB Cannot Remand in Final Decision --1217

OLD EDITION

Of Application Which is Subject of Inter Partes Case --515; 805
Removal of Files From Offices of TTAB Not Permitted --120.01; 122
Reopen Time, Motion to (see also Motions, Types of)--502.02; 509
Reply to Answer Should Not be Filed --320
Representation of Party:
Adverse Parties Represented by Same P ractitioner--114.08
Attempted Representation by Ineligible Individual --114.06
By Attorney--114.03
By Foreign Attorney or Agent--114.05
By Non-lawyer--114.04; 114.06; 117.08
By "Other Authorized Representative" --114.04
By Party Itself--114.01
Change of Address--117.07
Correspondence With Representative (see Correspondence - With Whom Held)
Domestic Representative--114.07
Revocation of Authority--116.01
Selection of Attorney--114.02
Withdrawal From (see Withdrawal As Representative of Party)
Republication of Mark:
After Filing of Opposition, Effect of--214; 307.09
By Mistake--214
During Time to Oppose, Effect of--214; 307.09
Request for Extension of Time to Oppose (see Extension of Time to Oppose, Request for)
Request for Reconsideration (see Reconsideration)
Requests for Admission (see also Discovery: Requests for Admission)--410; 411
Requests for Production of Documents (see also Discovery: Requests for Production of Documents) --408; 409
Restoration of Jurisdiction to Examining Attorney:
During Time to Oppose--213; 307.06
During Opposition--213; 307.06
Restriction of Application or Registration:
At Request of Owner--318.02(b)
By Counterclaim for Partial Cancellation --319.01
By Opposition in Part--311
By Petition for Partial Cancellation --311
Defense Seeking Restriction of Plaintiff's Registration Requires Counterclaim --318.02(b)
Geographic Restrictions Considered by TTAB Only in Concurrent Use Proceeding --311
Resumption of Proceedings Following Suspension:
After Withdrawal of Party's Attorney --510.03(b)
For Bankruptcy Proceeding--510.03(b)
For Settlement Negotiations--510.03(b)
Motion to Resume (see also Motions, Types of) --510
Pending Determination of Potentially Dispositive Motion --510.03(b)
Pending Outcome of Another Proceeding --510.02(b)
Return of Papers Filed in PTO:
In Ex Parte Cases--119.02
In Inter Partes Cases--119.03
Review of Decision of TTAB (see Appeal From Decision of TTAB; Petition to the Commissioner)
Revocation of Authority to Represent Party --116.01
Rule 11, FRCP:

OLD EDITION

Applicable to Papers Filed in TTAB Proceedings --314; 529.01
Motion for Sanctions Under --529.01
Rule 2.119(c) 5-Day Addition:
Applicable After Certain Manners of Service --113.05
Not Applicable to Answer to Complaint --316.02
Rules Governing TTAB Proceedings:
Discovery--401
Generally--101.01
Obtaining Copies of--101.01
Sanctions:
Attorneys' Fees, Damages, Expenses Not Awarded by TTAB --502.06; 529.01
Discovery:
Estoppel Sanction--527.05
For Failure to Comply With Order re Discovery --527.01
For Failure to Respond, or Respond Properly, to Admission Request --527.04
For Failure to Timely Respond --403.03; 527.03
If Party Says it Won't Respond to Discovery --527.02
For Failure to Comply With Protective Order --527.01
Non-Discovery--529.02
Under Rule 11, FRCP --529.01
Where Party Cannot be Located --529.02
Where Party States it Will Not Proceed --529.02
Section 7(b) Presumptions:
Accorded to Owner of Principal Register Regist ration--703.02(a); 703.02(b)
Applicable Only When Principal Register Registration Made of Record by its Owner or Cited by Trademark Examining Attorney --703.02(b)
Not Accorded to Supplemental Register Registration --703.02(a)
Senior Party, Defined--1005; 1107
Service of Papers:
Additional Time After Certain Manners of --113.05
Elements of Certificate of Service --113.03
Generally--113
Manner of Service, Acceptable --113.04
Requirement for Proof of Service --113.02; 203.03
Requirement for Service--113.01; 203.03
Which Papers Must be Served --113.01
Settlement Agreement:
Breach of--605.03(d)
Consent Orders Not Issued by TTAB --605.03(f)
Effect of Judgment Based Upon --605.03(e)
Effect on Counterclaim When Main Claim Disposed of --606
In Concurrent Use Proceeding, Providing for Concurrent Registration --1109
Nature of--605.03(a)
Notification to TTAB of--605.03(a)
Stipulation to Dispose of Case --605.03(a)
TTAB Encourages Settlement --605.01
Will be Disregarded if Violates Act o r Rules--605.03(a)
With Amendment of Plaintiff's Pending Application --605.03(c)
With Amendment of Subject Application or Registration --605.03(b)
Settlement Negotiations:

OLD EDITION

Resumption of Proceedings After--510.03(b)
Suspension of Proceedings for--510.03(a); 605.02
Show Cause, Order to:
Why Default Judgment Should not be Entered Against Defendant for Failure to Answer --317; 508
Why Judgment Should not be Entered Against Defendant for Permitting its Registration to be Cancelled Under Sec. 8 or 9 During Case [Rule 2.134(b)] --536; 602.02(b)
Why Judgment Should not be Entered Against Plaintiff for Failure to File Main Brief [Rule 2.128(a)(3)] --537; 801.02(a)
Signature of Papers:
Certifies Propriety--106.02; 402.02; 412.01
Depositions--713.10; 714.09
Either Original or Copy May be Filed --106.02
In General--106.02
One Person May Not Sign for Another --106.02
Requirements for--106.02
Responses to Interrogatories --407.03
Responses to Requests for Admission --411.03
Unsigned Paper--106.02
Who Must Sign--106.02
Specimens in Application or Registration Not Evidence for Owner Unless Proved at Trial --703.01; 704
Standing----303.03
Statement of Use:
Filed During Ex Parte Appeal (Untimely) --1206.02
Filed During Extension of Time to Oppose (Untimely) --219
Filed During Opposition (Untimely) --219
Time for Filing--219
Statements and Things in Application or Registration File Not Evidence for Owner Unless Proved at Trial--703.01; 704
Statements in Briefs on Case, Evidentiary Value of --706.02
Statements in Pleadings, Evidentiary Value of --706.01
Status Line, Trademark--124
Status of Proceedings, Information Concerning --105
Statute Governing TTAB Proceedings, Generally --101.01
Stipulated Testimony--713.02
Stipulations:
Filing of--501.02
Form of--501.03
Generally--501.01
Matters Which May be Stipulated --501.01
Re Evidence--716
Re Testimony--707-711; 713; 714; 716
Signature of--501.03
To Dispose of Case--605.03(a)
To Extend:
Discovery Period--403.04
Form of--501.03
Should Normally be Filed in Multiple Form --501.03
Should Specify New Date(s) --501.03
Stipulation to Extend Time to Respond to Discovery Request Need Not be Filed --403.04; 501.02

OLD EDITION

Time to Respond to Discovery Request --403.04; 501.03
To Reopen:
Form of--501.03
Should be Filed in Multiple Form --501.03
Should Specify New Date(s) --501.03
Time to Respond to Discovery Request --403.04; 501.03
Whether Must be Filed --501.02
Storage of Files and Exhibits:
After Termination of TTAB Proceeding --121.03; 806
Confidential Materials --120.03; 416.07
During Ex Parte Appeal --120.02
During Extension of Time to Oppose --120.02
During Inter Partes Proceeding --120.02
Strike Brief on Case or Attached Exhibits, Motion to --540
Strike Brief On Motion, Motion to --517
Strike Notice of Reliance, Motion to --533
Strike Part of Pleading, Motion for (see also Motions, Types of) --506
Strike Trial Testimony Deposition, Motion to (see also Motions, Types of) --534
Subpoena:
Violation of--404.03(b)(2)
When Necessary --404.02; 404.03(b)(2); 415.03
Substitution of Party --512
Sufficient Evidence, Motion to Dismiss for Failure of Plaintiff to Offer (see also Motions, Types of) --535
Sufficiency of Evidence, Available Motions re -- 502.01; 535
Summary Judgment, Motion for (see also Motions, Types of) ----528
Supplemental Register Mark Not Subject to Opposition --205; 302
Surrender of Subject Registration During Inter Partes Proceeding --602.02
Suspension:
Of Ex Parte Appeal Proceeding:
At Request of Applicant --1213
For Remand to Examining Attorney:
For New Refusal--1203.02(b); 1209
For Submission of More Evidence --1207.02; 1207.06
Pending Consideration by Examining Attorney of:
Amendment to Allege Use --1206.01
Amendment to Application --1202.02; 1205
Request for Reconsideration of Final Action --1202.02; 1203.02(a); 1204
Of Inter Partes Proceeding:
Due to Withdrawal of Party's Attorney --510.03(a)
For Bankruptcy Proceeding --510.03(a)
For Good Cause--510.03(a)
For Settlement Negotiations --510.03(a)
Motion to Suspend (see also Motions, Types of) --510
Pending Deposition Upon Written Questions --510.03(a)
Pending Disposition of Potentially Dispositive Motion --510.03(a); 528.03
Pending Outcome of Another Proceeding --510.02(a)
Potentially Dispositive Motion Also Pending --510.02(a)
TTAB has Inherent Power to Suspend --510.01
Of Running of Extension of Time to Oppose:
Effect of--307.05

OLD EDITION

Pending Action on Amendment to Appli cation--214.04
Pending Determination of Letter of Protest --215
Upon Restoration of Jurisdiction to Examining Attorney --213
Taking Deposition by Telephone --404.05; 713.08
Telephone Conferences --417; 502.07(b)
Telephone, Taking or Attending Deposition by --404.05; 713.08
Termination of Proceeding --121.03; 806
Testimony Depositions (see also Evidence, Introduction of) --713; 714
Testimony From Another Proceeding --531; 715
Testimony Not Read Prior to Final Decision --502.01; 535.04; 718.02(c); 718.03(c)
Testimony Periods --701; 1007; 1108
Testimony, Stipulated --713.02
Testimony, Stipulations re --713.02; 713.04; 714.07
Time for Argument at Oral Hearing, Motion for Additional --542.02; 802.05
Time for Oral Hearing, Motion to Change --542.01; 802.03
Times for Taking Action --112
Trademark Act of 1946, Generally --101.01
Trademark Status Line --124
Trademark Trial and Appeal Board:
Address of--103
Authority of Members, Interlocutory Attorneys to Act --102.03; 502.05; 518
Composition of--102.03
Contact With TTAB Personnel --105
Description of--102.01; 702
Jurisdiction of, Generally --102.01
Power, Inherent, to Schedule Proceedings --510.01
Transfer of Interest in Mark in Inter Partes Case --512
Trial in TTAB Inter Partes Proceeding, In General (see also Evidence, Introduction of in Inter Partes Proceeding):
Commencement of--701
Described, Generally --702
Manner of--702
Testimony Periods --701
Time of--.701
Trial Order--701; 1007; 1108
Trial Order--701; 1007; 1108
Trial Period, Commencement of --701
Trial Schedule --701; 1007; 1108
U. S. Patents Quarterly (USPQ), TTAB Decisions in --101.03
Unpleaded Matters:
Cannot be Basis for Summary Judgment --528.07(a)
Cannot be Defense Against Summary Judgment --528.07(b)
Cannot be Relied Upon --321
Remand to Examining Attorney From Inter Partes Case for Consideration of --515; 805
Unpublished Decisions of the TTAB (see Decisions of the TTAB)
Unsigned Papers, Treatment of --106.02; 203.03
Verification Letter by TTAB:
Described--123.03
How to Obtain --123.03
When Required --123.01

OLD EDITION

Videotape Depositions Not Entertained --713.08
Voluntary Surrender of Subject Registration During Inter Partes Proceeding:
Express Surrender--602.02(a)
For Allowing Registration to be Cancelled Under Sec. 8 or 9 --536; 602.02(b)
Single Class in Multi-Class Registration --602.02(a); 605.03(b)
Withdrawal as Representative of Party:
By Applicant's Representative, During Extension of Time to Oppose --212.01
Generally--116.02
Mandatory--116.03
Motion for--116.05; 513.01
Permissive--116.04
Suspension (and Then Resumption) of Proceedings As a Result of --510.03(a); 510.03(b)
Withdrawal of Application (see Abandonment of Application)
Withdrawal of Proceeding by Plaintiff:
Effect of Judgment Entered for Withdrawal After Answer --601.01; 601.02
Effect on Counterclaim--606
Of Cancellation by Petitioner--601.02
Of Opposition by Opposer--601.01
When Motion for Judgment is Pending --601.03
Withdrawal of Subject Registration During Inter Partes Proceeding --602.02
Withdrawal or Amendment of Admission --411.04; 525
Witness Refuses to Answer Deposition Question:
Discovery Deposition--404.02; 404.03(b)(2); 405.03; 415.03; 523
Testimony Deposition--404.02; 713.08; 718.03(d)

OLD EDITION