

Appendix A

Examining Attorneys' Appeal Briefs

The following format should be used by examining attorneys when preparing an appeal brief in an appeal before the Trademark Trial and Appeal Board. The purpose of this format is to promote uniformity in the manner in which appeal briefs are presented and to suggest content guidelines. The substance of the appeal brief is a matter of individual effort within this format.

If, at the time an application file is sent to an examining attorney for preparation of the appeal brief, the examining attorney determines that jurisdiction should be restored to him or her for further examination (e.g., to make a new refusal, to correct informalities, or to suspend), this request should be submitted in lieu of the appeal brief. The request would usually be entitled "Request for Remand to Examining Attorney" and should be a brief statement of the reason for the request and an explanation of what action the examining attorney intends to take. A request for remand to submit additional evidence must include a showing of good cause (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. [TBMP §1207.02](#). The filing of such a request should be approved by the managing attorney.

If the examining attorney's request is granted, the Trademark Trial and Appeal Board will stay further proceedings in connection with the appeal. If the request is denied, the Trademark Trial and Appeal Board will reset the time for submission of the examining attorney's appeal brief.

The brief may not exceed twenty-five (25) double-spaced pages. [TMEP §1501.02](#). When referring to the record, the examining attorney should include a citation to the Trademark Status and Document Retrieval database (TSDR). The citation format should be by date, description of filing, and page number, for example: November 4, 2013 Office Action, TSDR p. 2. *See* [37 C.F.R §2.142\(b\)\(3\)TBMP §1203.01](#).

Because the record must be complete prior to appeal, the Board will normally not consider evidence submitted with the applicant's or examining attorney's brief. If the applicant does submit such evidence, the examining attorney should specifically object to such evidence if he or she does not want it to be considered. If the examining attorney does not object to the evidence, and discusses it in his or her brief or elsewhere in the record, the Board may treat it as of record.

EXAMINING ATTORNEY'S APPEAL BRIEF

The first paragraph should be an introduction, similar to the "Question Presented" section in a memo, e.g.:

The applicant has appealed the trademark examining attorney's refusal to register the trademark _____ on the ground that it is merely descriptive within the meaning of §2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1).

FACTS

TRADEMARK MANUAL OF EXAMINING PROCEDURE

This section should be a brief recital of the facts, such as what mark and goods were applied for, what refusal was made and the basis for it, summary of any evidence submitted by either party, etc. Since the examining attorney is an advocate at this stage of the proceeding, the appeal brief should be written in a style that will make his or her position convincing to the Board.

ARGUMENT

The argument presented in this section should be complete. The examining attorney should clearly and concisely present each substantive argument in support of his or her position and address all of the applicant's arguments and distinguish any significant cases cited. Reference should not be made to earlier correspondence such as the final refusal. If appropriate, arguments that were made in earlier Office actions may be repeated in whole or in part in this section of the appeal brief.

The following format for organizing arguments under sub-headings is recommended:

- (1) A sub-heading or sub-headings should be used. If there is only one issue with one point, one sub-heading should be used, e.g.:

THE MARK IS MERELY DESCRIPTIVE BECAUSE IT DESCRIBES A CHARACTERISTIC OF THE GOODS.

- (2) If there is one issue with several points, use additional sub-headings, e.g.:

_____ IS LIKELY TO CAUSE CONFUSION WITH _____.

(A) _____ is visually similar to
_____.(argument)

(B) _____ is phonetically similar to
_____.(argument)

(C) ETC.

- (3) If there is more than one issue, each issue should head a separate section, and be identified by Roman numerals, e.g.: ARGUMENTS

I. _____ IS LIKELY TO CAUSE CONFUSION

(See (2) for example)

II. _____ IS PRIMARILY MERELY A SURNAME.

(argument)

CONCLUSION

Reiterate the main reasons, if necessary. If not, end with a sentence such as the following:

For the foregoing reasons, the refusal to register on the basis of § _____ of the Trademark Act, 15 U.S.C. § _____, for the reason that _____, should be affirmed.

Respectfully submitted,

Trademark Examining Attorney (_____, Managing Attorney)

TRADEMARK MANUAL OF EXAMINING PROCEDURE

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