Introduction to the Trademark Trial and Appeal Board (TTAB)

Christopher C. Larkin
Administrative Trademark Judge
Trademark Trial and Appeal Board
General information about TTAB
Trademark Trial and Appeal Board

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

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

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

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

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

- **Draft and issue orders on non-dispositive motions**
  - Discovery motions
  - Contested scheduling motions
  - Complicated uncontested motions

- **Draft orders on dispositive motions for approval by judges**
  - Motions for summary judgment
  - Motions for sanctions
  - Motions to dismiss
Paralegals

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

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

• Hearing specialist

• Supervisor
The rest...

- Chief clerk
- Analytics and information technology
- Administrative staff
  - TTAB administrative officer
  - Human capital
  - Budget and contracts
  - Telework, communications and space
  - Visual information
TTAB workload, Fiscal Year 2022

- Appeals: 3,240
- Extensions of time to oppose: 16,814
- Oppositions: 6,989
- Cancellations: 2,285
- Concurrent Use: 27
Ex parte appeals

Fiscal year ending September 30, 2022

New appeals filed: 3,213
Appeals terminated without formal decision: 2,484
Final decisions issued: 392
Appeals pending: 1,854
Oppositions and cancellations

- Fiscal year ending September 30, 2022
- New proceedings filed: 8,999
  - Oppositions: 6,702
  - Cancellations: 2,290
- Proceedings terminated
  - Without Decisions: 9,154
  - Final Decisions issued: 169
- Proceedings pending: 7,340
Ex parte appeals
Procedure: Ex parte appeals

- Final refusal to register or second refusal on the same issue
- Must file an appeal within a set period from issuance of the final office action
  - Six months for an application
  - Three months for a registration
- No new evidence permitted during appeal
- Appellant and examining attorney submit briefs
- Appellant may request oral hearing
  - Participation by video optional
Grounds for refusal (1 of 3)

- Trademark Act Section 2
  - § 2(a) Deceptive
    - No longer immoral or scandalous
    - No longer disparaging
  - § 2(b) Official insignia
  - § 2(c) Name or likeness of living individual
  - § 2(d) Likely to cause confusion
Grounds for refusal (2 of 3)

- § 2(e)(1) - Merely descriptive or deceptively misdescriptive; generic
- § 2(e)(2) - Primarily geographically descriptive
- § 2(e)(3) - Primarily geographically deceptively misdescriptive
- § 2(e)(4) - Primarily merely a surname
- § 2(e)(5) - Comprises matter that is functional
Grounds for refusal (3 of 3)

- § 3 – Applies to service marks
- § 4 – Applies to collective and certification marks
- § 5 – Use by related companies
- § 6 – Disclaimers
- § 23 – Supplemental register
Inter partes (trial) proceedings
Publication for opposition

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

<table>
<thead>
<tr>
<th>Publication Period 30 days</th>
<th>1st 30-day Extension Upon Request No Fee</th>
<th>2d 60-day Extension Good Cause or Consent $200</th>
<th>Final 60-day Extension Consent or Extraordinary Circumstances $400</th>
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<tr>
<td>1st 90-day Extension Good Cause or Consent $200</td>
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Opposition: Filing

• Registration may be opposed by any party which believes it would be damaged by registration

• Opposer must file a notice of opposition within thirty days of publication or within a granted extension of time to oppose

• Must include the filing fee

• May be based on any ground for refusal of registration
Cancellation: Filing

Same as opposition but filed after registration

- **Within five years of registration** – cancellation may be based on any ground for refusal
- **After three years of registration** – expungement
- **After five years** – grounds for cancellation limited, including:
  - Genericness
  - Functionality
  - Abandonment
  - Obtained by fraud
  - Likelihood of confusion and descriptiveness are *not* available after five years
Grounds to oppose/cancel

• Grounds available in appeal and trial cases:
  – Trademark Act §§ 2(a)-(e)
  – § 6 (disclaimers) & § 23 (Supplemental register)

• Additional grounds available in inter partes:
  – Non-use (Trademark Act § 1(a))
  – Lack of bona fide intent to use (Trademark Act § 1(b))
  – Abandonment (Trademark Act § 14(3))
  – Dilution (Trademark Act § 43(c))
  – Fraud (Fed. R. Civ. P. 9)
Inter partes timeline: Pleadings

- Pleadings define the issues in the case
- Complaint: Either a notice of opposition or petition for cancellation
  - Consists of a “short and plain” statement of
    - Entitlement - reasons plaintiff believes it will be damaged by registration
    - Grounds – provide fair notice of the basis for each claim and be plausible
- Answer: Response to complaint
  - Affirmative defenses may be asserted
- Counterclaim: To cancel plaintiff’s pleaded registration(s)
  - Plaintiff allowed time to answer counterclaim
Inter partes timeline: Discovery

- Discovery conference
  - Topics: Discovery planning, Fed. R. Civ. P. 26(f)
  - Board participation
- Initial disclosures, Fed. R. Civ. P. 26(a)
  - Individuals likely to have discoverable information
  - Documents which may be used to support claims or defenses
- Discovery
  - Interrogatory requests for written answers
  - Requests for production of documents or things
  - Depositions: Live testimony under oath
  - Requests for admission: requests to admit facts
- Expert disclosures
Inter partes timeline: Trial

• Pre-trial disclosures

• Plaintiff’s trial period – 30 days
  — *Testimony* – by deposition or affidavit
  — *Notices of reliance* – documentary evidence
    • Discovery materials – Rule 2.120(j)(3)(i)
    • Registrations – Rule 2.122(d)(2)
    • Printed publications and official records – Rule 2.122(e)
  — *Trademark Rule 2.132 motions*

• Defendant’s trial period – 30 days

• Rebuttal period – 15 days
  — Must respond to defendant’s evidence
Inter partes timeline: Briefing

• Briefs: Written arguments on law and facts
  – No new evidence
  – Attachments discouraged (and usually ignored)
  – Page limits strictly enforced
  – Cite to evidence by referencing the TTABVUE record

• Plaintiff’s brief
  – 55 pages maximum
  – Due 60 days after close of rebuttal testimony

• Defendant’s brief
  – 55 pages maximum
  – Due 30 days after due date of plaintiff’s brief

• Rebuttal brief
  – 25 pages maximum
  – Due 15 days after due date of defendant’s brief
Inter partes timeline: Oral hearing

- Scheduled only at the request of either party
- Attendance of non-requesting party not required
- Participation by video optional; currently required
- Not a formal part of the record; no transcript or recording
- No new evidence or testimony at hearing
Inter partes timeline: Decision

- **Decision:** The explanation of the Board’s judgment
  - Panel of three administrative judges
  - Requires consideration of all relevant evidence and arguments
  - Findings of fact and conclusions of law
  - A judge who disagrees with the result may write a dissenting opinion
  - A judge who agrees with the result, but not the reasoning of the majority, may write a concurring opinion
Abbreviated proceedings

• Motion to dismiss for failure to state a claim
  – When the facts alleged do not constitute grounds for relief, the proceeding may be dismissed

• Motion for summary judgment
  – No genuine dispute of material fact
  – Movant is entitled to win as a matter of law

• Accelerated Case Resolution (ACR)
  – Similar to summary judgment, but the Board may determine disputed facts
Alternative Dispute Resolution

• Negotiation
  – Parties may generally settle on any mutually agreeable terms

• Third-party dispute resolution
  – Arbitration
  – Mediation

• Extension/Suspension: TTAB will suspend proceedings to allow settlement negotiation
Review of Board decisions

• Judicial review of Board’s decision
  – Must be taken within sixty-three days of final decision

• U.S. Court of Appeals for the Federal Circuit
  – Appeal on the administrative record
  – Briefs and oral argument

• United States District Court
  – Administrative record
  – New testimony or evidence allowed
  – De novo review by new trial
Useful resources

- **Trademark Statute and Rules**
  - [https://tfsr.uspto.gov/RDMS/TFSR/current](https://tfsr.uspto.gov/RDMS/TFSR/current)
  - Trademark Act of 1946 (as amended) — 15 USC § 1051, et seq.
  - Representation of Others Before the USPTO — 35 CFR Parts 10 & 11

- **TTAB precedential decisions** — United States Patent Quarterly

- **Trademark Manual of Examining Procedure (TMEP)**
  - [https://tmep.uspto.gov/RDMS/TMEP/current](https://tmep.uspto.gov/RDMS/TMEP/current)

- **Trademark Trial and Appeal Board Manual of Procedure (TBMP)**
  - [https://tbmp.uspto.gov/RDMS/TBMP/current](https://tbmp.uspto.gov/RDMS/TBMP/current)

- **TTABVUE (TTAB electronic dockets and case files)**

- **TTAB decision summaries at TTAB Reading Room**
  - [https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions](https://ttab-reading-room.uspto.gov/efoia/efoia-ui/#/search/decisions)

- **Official Gazette of the USPTO**
Other USPTO links

• USPTO home page
  – www.uspto.gov

• Trademark Examining Operations
  – www.uspto.gov/trademark
    • Search pending and registered trademarks (TESS)
    • File trademark applications and documents (TEAS)
    • Check status and view trademark files (TSDR)

• Trademark Trial and Appeal Board
  – www.uspto.gov/ttab
    • File TTAB documents (ESTTA)
    • View TTAB dockets and files (TTABVUE)
    • Statute and Rules
    • TTAB Manual (TBMP)