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301 Types of Board Proceedings

301.01 In General

The Board has jurisdiction over four types of inter partes proceedings, namely, oppositions, cancellations, interferences, and concurrent use proceedings. *See* TBMP § 102.

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, upon payment of the prescribed fee, file an opposition thereto, but the opposition may be filed only as a timely response to the publication of the mark, under Trademark Act § 12(a), 15 U.S.C. § 1062(a), in the Official Gazette of the USPTO. [Note 1.]

A cancellation proceeding is a proceeding in which the plaintiff seeks to cancel an existing registration of a trademark on the Principal or the Supplemental Register. "Any person who believes that he would be damaged by the registration of a mark" may, upon payment of the prescribed fee, file a petition to cancel thereto, but the petition to cancel may only be filed after the issuance of the registration. [Note 2.]

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. [Note 3.] The proceeding is declared by the Office only on petition to the Director showing extraordinary circumstances therefor, that is, that the party who filed the petition would be unduly prejudiced without an interference. [Note 4.] *See* TBMP § 1002.

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, ordinarily as to the geographic scope of the applicant's mark or the goods and/or services on or in connection with which the mark is used. [Note 5.] *See* TBMP § 1101.01.

NOTES:

1. *See* Trademark Act § 13, 15 U.S.C. § 1063. *See also* Trademark Act § 68(a)(2), 15 U.S.C. § 1141h(a)(2) (an application filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is subject to opposition under Trademark Act § 13, 15 U.S.C. § 1063).

2. *See* Trademark Act § 14 and Trademark Act § 24, 15 U.S.C. § 1064 and 15 U.S.C. § 1092.

3. *See* Trademark Act § 16, 15 U.S.C. § 1066; Trademark Act § 18, 15 U.S.C. § 1068.

4. *See* Trademark Act § 16, 15 U.S.C. § 1066; 37 CFR § 2.91.

5. *See* Trademark Act § 2(d),15 U.S.C. § 1052(d); Trademark Act § 17,15 U.S.C. § 1067; Trademark Act § 18, 15 U.S.C. § 1068; 37 CFR § 2.42, 37 CFR § 2.73, 37 CFR § 2.99; *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 n.9 (TTAB 1995).

301.02 Mark on Supplemental Register Not Subject to Opposition

15 U.S.C. § 1092 ***[Trademark Act § 24]*** *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.*

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. [Note 1.] *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. ESTTA, does not permit a party to file a notice of opposition against an application for registration on the Supplemental Register. In the rare circumstance that an opposition against such an application is filed in paper form, the opposition papers will not be returned to the person who filed them but any opposition fee submitted will be refunded. The fee for the required petition to the Director to file on paper will not be refunded. The remedy of the would-be opposer lies in the electronic filing of a petition to cancel the registration of the mark, once the registration has issued. [Note 2.]

NOTES:

1. *See* Trademark Act § 12(a), Trademark Act § 13(a), and Trademark Act § 24, 15 U.S.C. § 1062(a), 15 U.S.C. § 1063(a), and 15 U.S.C. § 1092.

2. *See* Trademark Act § 24, 15 U.S.C. § 1092.

301.03 Mark Filed Under the Madrid Protocol is Subject to Opposition

A request for extension of protection of an international registration to the United States, filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a) ("the Madrid Protocol"), is examined as an application for registration on the Principal Register. Thus, an application whose filing basis is Trademark Act § 66(a), 15 U.S.C. § 1141f(a), is subject to opposition under Trademark Act § 13, 15 U.S.C. § 1063. [Note 1.]

NOTES:

1. *See* Trademark Act § 68(a)(2),15 U.S.C. § 1141h(a)(2).

302 Commencement of Proceeding

37 CFR § 2.101(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.*

37 CFR § 2.111(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.*

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 notice of 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, together with the required fee, in the USPTO. [Note 1.]

Similarly, a cancellation proceeding is commenced by the timely filing of a petition for cancellation, together with the required fee, in the USPTO. [Note 2.]

The notice of opposition, or the petition for cancellation, and the answer thereto correspond to the complaint and answer in a court proceeding. [Note 3.] 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. [Note 4.]

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. For further information concerning interference proceedings, *see* TBMP Chapter 1000.

A concurrent use proceeding commences when the Board mails a notice of the proceeding to each of the parties thereto, as described in 37 CFR § 2.99(c) and 37 CFR § 2.99(d)(1). For further information concerning concurrent use proceedings, *see* TBMP Chapter 1100.

Electronic filing via ESTTA is required for the filing of a notice of opposition or a petition for cancellation. [Note 5.]

NOTES:

1. 37 CFR § 2.101(a). *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988) ("An opposition proceeding is initiated by a simple statement, comparable to the filing of a complaint"); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (untimely opposition dismissed as a nullity). *Cf.* Fed. R. Civ. P. 3.

2. 37 CFR § 2.111(a).

3. 37 CFR § 2.116(c).

4. 37 CFR § 2.116(b). *See Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1004 (Fed. Cir. 1988).

5. 37 CFR § 2.101(b)(1); 37 CFR § 2.101(b)(3); 37 CFR § 2.111(c)(1).

302.01 Mandatory Electronic Filing

37 CFR § 2.101(b) ***Filing an opposition.***

(1) *An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.*

(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(3) *An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

37 CFR § 2.106 ***Answer.***

(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).*

37 CFR § 2.111 ***Filing petition for cancellation.***

(c)(1) *A petition to cancel a registration must be filed through ESTTA.*

(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form. A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (c). Timeliness of the paper submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198.*

37 CFR § 2.114 ***Answer.***

(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).*

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.* * * * *

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered.* * * * *

As required by 37 CFR § 2.101(b)(3), an opposition to an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), must be filed electronically through ESTTA and may not under any circumstances be filed in paper form. [Note 1.] As required by 37 CFR § 2.101(b)(1), an opposition to an application based on Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, must be filed electronically through ESTTA. [Note 2.] As required by 37 CFR § 2.111(c)(1), a petition for cancellation must be filed electronically through ESTTA. [Note 3.] For information regarding the electronic filing requirements for extensions of time to oppose, see TBMP § 203.01.

While an opposition against a § 66(a) application must always be filed electronically in ESTTA, and may not under any circumstances be filed in paper form, in the rare instance that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against a § 1 or § 44 application or a petition for cancellation against a § 1, § 44 or § 66(a) registration (or registered extension of protection) may be filed on paper, accompanied by a Petition to the Director and the required fee. [Note 4.] For more information on filing oppositions and cancellations, see TBMP § 306 and TBMP § 307.

An answer to a notice of opposition or petition for cancellation must be filed through ESTTA. [Note 5.] In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form accompanied by a Petition to the Director and the requisite fee. [Note 6.] For more information on filing and serving an answer see TBMP § 311.01.

A paper-filed notice of opposition, a petition to cancel, or answers thereto, which are not accompanied by a Petition to the Director and the required fee, will not be considered. [Note 7.] Whether a paper filing of a notice of opposition, petition to cancel or answers thereto (accompanied by the required petition and fee) is permitted depends on whether a sufficient showing in the petition has been made based on the facts provided. [Note 8.] Petitions to the Director to file on paper are subject to 37 CFR § 2.146, including the requirement for verified facts under 37 CFR § 2.146(g). [Note 9.] A supported petition would include an affidavit or declaration and any other available evidence to support the assertion of technical problems with ESTTA (e.g., screen print showing an ESTTA error message, a reference number from a telephone call to the TTAB regarding ESTTA unavailability), or to support the assertion of extraordinary circumstances. When submitting a Petition to the Director with the paper-filed notice of opposition, petition to cancel, or answer, the filer should send these papers in the same envelope. If a Petition to the Director has been filed through TEAS, the paper filing should include a prominent statement regarding the TEAS filing of the Petition to the Director. With regard to a paper-filed notice of opposition or petition to cancel and payment of fees, separate checks for the Petition to the Director and the opposition or cancellation filing fee should be provided in the same envelope; written directions to deduct the fees from a deposit account should provide instructions separately for payment of fees for the Petition to the Director, and for the appropriate filing fees for the notice of opposition or petition to cancel.

In addition, general submissions to the Board must be made via ESTTA. [Note 10.] Eastern Time continues to control the timeliness of filing dates. [Note 11.] In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. [Note 12.] No fee is required. All submissions in paper form must include a written explanation of the technical problems or extraordinary circumstances encountered by the filer. [Note 13.] Such explanations must include the specific facts underlying the inability to file by ESTTA, rather than a mere conclusory statement that technical problems or extraordinary circumstances prevented the use of ESTTA. [Note 14.] The precise impact of ESTTA technical problems varies depending on specific facts. [Note 15.] The exception for extraordinary circumstances may apply to situations where no USPTO technical problems exist, but the filer experiences an extraordinary situation making ESTTA unavailable to the filer, which might, in appropriate situations, include certain types of technical problems at the filer's location or with the filer's systems. [Note 16.] Whether such circumstances are extraordinary will be determined on a case by case basis. In either case, the Board will review the explanation accompanying the paper filing in its consideration of the filing, and explanations that do not meet the technical problems or extraordinary circumstances showing will not be considered. [Note 17.]

Please Note: In the case of general submissions filed on paper, accompanied by the required explanation, parties should consider any such paper filing accepted unless the Board indicates otherwise. Thus, for any filing to which the opposing party would respond, for purposes of the response deadline, the opposing party

should proceed as if the paper submission were accepted at the time of its filing and respond accordingly. [Note 18.]

For additional information on filing via ESTTA see TBMP § 110.

NOTES:

1. 37 CFR § 2.101(b)(3). *Cf. In re Börlind Gesellschaft für Kosmetische Erzeugnisse GmbH*, 73 USPQ2d 2019, 2020 (TTAB 2005) (former 37 CFR § 2.102(a)(2) (now 37 CFR § 2.102(a)(1)) requires ESTTA filing of extensions of time to oppose Trademark Act § 66(a) applications).

2. 37 CFR § 2.101(b)(1).

3. 37 CFR § 2.111(c)(1).

4. 37 CFR § 2.101(b)(3); 37 CFR § 2.101(b)(2); and 37 CFR § 2.111(c)(2).

5. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1).

6. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966-67 (October 7, 2016).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

10. *See* 37 CFR § 2.126(a).

11. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19296 (Notice of Proposed Rulemaking April 4, 2016) (describing ongoing practice of using Eastern Time to determine the timeliness of ESTTA filing dates).

12. *See* 37 CFR § 2.126(b).

13. *See* 37 CFR § 2.126(b).

14. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

15. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966-67 (October 7, 2016).

16. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966-67 (October 7, 2016).

17. 37 CFR § 2.126(b); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

18. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

303 Who May Oppose or Petition to Cancel

303.01 In General

15 U.S.C. § 1063(a) ***[Trademark Act § 13(a)]*** *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, 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 1062 of this title of the mark sought to be registered.*

* * * *

15 U.S.C. § 1064 ***[Trademark Act § 14]*** *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, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, by the registration of a mark on the principal register established by this chapter, or under the Act of March 3, 1881, or the Act of February 20, 1905.*

* * * *

15 U.S.C. § 1092 *[Trademark Act § 24] 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 such person is or will be damaged by the registration of a mark on the supplemental register--*

(1) *for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title; or*

(2) *on grounds other than dilution by blurring or dilution by tarnishment, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.*

15 U.S.C. § 1127 ***[Trademark Act § 45]*** *In the construction of this chapter, 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.*

The term "person" also includes the United States, any agency or instrumentality thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States. The United States, any agency or instrumentality thereof, and any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States, shall be subject to the provisions of this chapter in the same manner and to the same extent as any non-governmental entity.

The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this Act in the same manner and to the same extent as any non-governmental entity.

* * * *

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

37 CFR § 2.101(b) *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board.* …

37 CFR § 2.111(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. ...*

303.02 Meaning of the Term " Person "

The term "person," as used in the Trademark Act, includes both natural and juristic persons. [Note 1.] A juristic person is a "firm, corporation, union, association, or other organization capable of suing and being sued in a court of law." [Note 2.]

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. [Note 3.] *See* TMEP § 1201.02(d) ("An operating division's use is considered to be use by the applicant…."). 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, where the issue is presented in connection with a discovery conference or a motion, the Board may inquire as to whether the division is incorporated or is otherwise a legal entity that 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. [Note 4.] *See* TMEP § 1201.02(d).

The term "person" as used in the Trademark Act also includes the United States, any agency and instrumentality thereof, or any individual, firm or corporation which acts for the United States and with the authorization and consent of the United States, as well as any state, any instrumentality of a state, and any officer or employee of a state or instrumentality of a state acting in his or her official capacity. [Note 5.]

NOTES:

1. Trademark Act § 45, 15 U.S.C. § 1127. *Cf.* 37 CFR § 2.2(b).

2. Trademark Act § 45, 15 U.S.C. § 1127. *See Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1475 (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, 720-21 (CCPA 1969) (a corporation is a "person" within the meaning of Trademark Act § 45, 15 U.S.C. § 1127and can base an opposition on Trademark Act § 2(a), 15 U.S.C. § 1052(a)); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685, 1686 n.2 (TTAB 1987) (Commonwealth of Aruba is a "person" within the meaning of Trademark Act §§ 13 and 45, 15 U.S.C. §§ 1063 and 1127); *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254, 1257 (TTAB 1987) (U.S. Navy is a juristic person within the meaning of Trademark Act § 45, 15 U.S.C. § 1127); *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410 n.6 (TTAB 1986) (Alabama Board of Trustees, a corporate body, may be considered either a "person" or an "institution" within the meaning of Trademark Act § 2(a), 15 U.S.C. § 1052(a)); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 n.2 (TTAB 1985) (corporations as well as individuals are "persons" for purposes of Trademark Act § 2(a),15 U.S.C. § 1052(a)); *In re Mohawk Air Services Inc.*, 196 USPQ 851, 855 (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).

3. *See In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986).

4. *Cf. In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1660 n.1 (TTAB 1986) (because applicant was merely a division, Board noted that should it ultimately prevail, "this defect may be corrected by an amendment supported by a verification or declaration by the real applicant").

5. Trademark Act § 45, 15 U.S.C. § 1127.

303.03 Meaning of the Term "Damage"

The term "damage," as used in Trademark Act § 13 and Trademark Act § 14, 15 U.S.C. § 1063 and 15 U.S.C. § 1064, concerns specifically a party's standing to file an opposition or a petition to cancel, respectively. [Note 1.] 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 legitimate personal interest in the outcome of the proceeding and a reasonable basis for its belief in damage. [Note 2.] *See* TBMP § 309.03(b).To plead a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. [Note 3.] There is no requirement that a plaintiff show a personal interest in the proceeding different from or "beyond that of the general public" in order to establish standing. [Note 4.] There is also no requirement that actual damage be pleaded or proved in order to establish standing or to prevail in an opposition or cancellation proceeding. [Note 5.] However, the allegations in support of plaintiff's belief of damage must have a "reasonable basis in fact." [Note 6.]

For a discussion of standing, *see* TBMP § 309.03(b).

NOTES:

1. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 n.2 (Fed. Cir. 1999) (construing standing requirements of Trademark Act § 13, 15 U.S.C. § 1063 regarding oppositions and Trademark Act § 14,15 U.S.C. § 1064 regarding cancellations consistently).

2. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025-26 (Fed. Cir. 1999).

3. *Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1026 (Fed. Cir. 1999).

4. *Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092; 50 USPQ2d 1023, 1027 (Fed. Cir. 1999) ("The crux of the matter is not how many others share one's belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue"). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982).

5. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (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 and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); *Rosso & Mastracco, Inc. v. Giant Food Inc.*, 720 F.2d 1263, 219 USPQ 1050, 1052 (Fed. Cir. 1983); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976); *Universal Oil Products Co. v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972).

See also Montecash LLC v. Anzar Enterprises Inc., 95 USPQ2d 1060, 1062 (TTAB 2010); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1543 n.10 (TTAB2009) (plaintiff does not have to prove claims or actual damage to establish standing); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 (TTAB 1991); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990); *Ipco Corp. v. Blessings Corp.*, 5 USPQ2d 1974, 1976 (TTAB 1988); *Aruba v. Excelsior Inc.*, 5 USPQ2d 1685, 1686 (TTAB 1987); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1077 (TTAB 1987); *BRT Holdings Inc. v. Homeway, Inc.*, 4 USPQ2d 1952, 1956 (TTAB 1987); *American Speech-Language-Hearing Association v. National Hearing Aid Society*, 224 USPQ 798, 801 (TTAB 1984); *Davco Inc. v. Chicago Rawhide Manufacturing Co.*, 224 USPQ 245, 246 (TTAB 1984).

6. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999) citing *Universal Oil Products v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972) and stating that the belief of damage alleged by plaintiff must be more than a subjective belief); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1215 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. July 11, 2007), *cert. denied*, 552 U.S. 1109 (2008).

303.04 Federal Trade Commission

15 U.S.C. § 1064 ***[Trademark Act § 14]*** *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 chapter, and the prescribed fee shall not be required.*

The proviso at the end of Trademark Act § 14, 15 U.S.C. § 1064, provides statutory standing for the Federal Trade Commission to cancel a registration on the Principal Register on the grounds specified in paragraphs (3) and (5) of the section. [Note 1.]

For information concerning the grounds for cancellation specified in paragraphs (3) and (5) of Trademark Act § 14, 15 U.S.C. § 1064, *see* TBMP § 307.01.

NOTES:

1. *See Formica Corp. v. Lefkowitz*, 590 F.2d 915, 200 USPQ 641, 647 (CCPA 1979); *Federal Trade Commission v. Formica Corp.*, 200 USPQ 182, 191 (TTAB 1978).

303.05 Opposition Filed During Extension of Time to Oppose

37 CFR § 2.102(a) *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file a request with the Trademark Trial and Appeal Board to extend the time for filing an opposition.*

* * * *

37 CFR § 2.102(b) *A 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 must be in the name of the person to whom the extension was granted, except that 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 insures only to the benefit of the party to which it was granted and those in privity with that party. [Note 1.] 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. [Note 2.] Cf. TBMP § 206.02. An opposition filed in a different name will be accepted only if the opposition is filed by a person in privity with the person granted the extension of time or if the person that requested the extension was misidentified through mistake. [Note 3.]

NOTES:

1. *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (a party cannot claim the benefit of an extension granted to another, unrelated party).

2. *See* 37 CFR § 2.102(b); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (fact that two entities share same objection is not a basis for finding privity).

3. *See Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (privity and misidentification by mistake "are two disjunctive conditions under which an opposer may claim the benefit of an extension granted to another named entity").

303.05(b) Opposition Filed by Privy

A party in privity with a potential opposer may step into the potential opposer's shoes and file a notice of opposition or may join with the potential opposer as a joint opposer. [Note 1.] Thus, an opposition filed during an extension of time to oppose may be filed by a party other than the party to which the extension was granted, if it is shown to the satisfaction of the Board that the differing party is in privity with the party granted the extension. [Note 2.] *Cf.* TBMP § 206.02.

The "showing" of privity should be in the form of a recitation of the facts on 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 that fails to make a satisfactory showing of privity.

Once a timely notice of opposition has been filed, and the time for opposing has expired, the right to pursue the filed case is a right individual to the timely filer. While this right may be transferred to another party, as by an assignment of the mark with the associated goodwill, it may not be shared. [Note 3.]

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

NOTES:

1. *See* 37 CFR § 2.102(b); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee, as party in privity with opposer, could have joined opposer in filing opposition during extension of time to oppose; however, having failed to join opposer in filing opposition during extension of time to oppose, licensee may not be joined after opposition is filed); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980).

2. *See* 37 CFR § 2.102(b); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1669-70 (TTAB 2015) (individual employee that filed extension request not in privity with employer who filed notice of opposition); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee considered to be in privity with licensor; however, having failed to join opposer in filing opposition during extension of time to oppose, licensee may not be joined after opposition is filed);. *Cf. In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (fact that two entities are using marks similar to that for which application has been made and that both have been named defendants in civil actions brought by the owner of the mark in question is not a basis for finding privity); *In re Spang Industries*, 225 USPQ 888, 888 (Comm'r Pats. 1985) (attorney/client relationship does not invest the attorney with same right or interest as his client).

3. *See SDT, Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (opposer's licensee, having failed to join opposer in filing opposition during extension of time to oppose, cannot be joined after opposition is filed); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980) (extension of time granted to opposer does not inure to the benefit of unrelated third party, despite its sharing of a common interest with opposer vis-à-vis applicant's mark). *Cf. Leading Jewelers Guild, Inc. v. LJOW Holdings LLC*, 82 USPQ2d 1901, 1901 n.1(TTAB 2007) (substitution allowed following assignment); *Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media,Inc.*, 6 USPQ2d 1028, 1032 (TTAB 1988) (president/sole shareholder is in privity with opposer corporation and may be substituted as "real party in interest" during opposition); *Raker Paint Factory v. United Lacquer Manufacturing Corp.*, 141 USPQ 407, 409 (TTAB 1964) (motion to amend complaint to substitute sole owner of company as real party in interest for opposer company granted); *Pyco, Inc. v. Pico Corp.*, 165 USPQ 221, 222 (TTAB 1969) (substitution of opposer allowed where notice of opposition named non-existing entity that had transferred rights to opposer prior to filing of opposition). *Cf. also, Chien Ming Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988) (trademark application was fatally defective because applicant was not the owner of the mark, having transferred it from himself to a corporation between the time that he executed the application and the date it was received in the Office).

303.05(c) Misidentification of Opposer

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." [Note 1.]

The phrase "misidentified through 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. [Note 2.] *See* TBMP § 512.04.

The "showing" submitted in support of a claim of misidentification through mistake should be in the form of a recitation of the facts on which the claim of misidentification through 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.

For information concerning motions for substitution of party plaintiff on grounds of misidentification, *see* TBMP § 512.04.

NOTES:

1. 37 CFR § 2.102(b). *See Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993).

2. *See Custom Computer Services, Inc. v. Paychex Properties, Inc.*, 337 F.3d 1334, 67 USPQ2d 1638, 1640 (Fed. Cir. 2003) (entity named in extensions was not a "different existing legal entity" from entity that filed opposition); *Warren Distribution, Inc. v. Royal Purple, LLC*, 115 USPQ2d 1667, 1670-71 (TTAB 2015) (individual employee who filed extension request a different legal entity than employer who filed notice of opposition and, thus, cannot be considered identified through mistake); *Cass Logistics Inc. v. McKesson Corp.*, 27 USPQ2d 1075, 1077 (TTAB 1993) (word processing error resulting in identification of different legal entity was not a "mistake" within the meaning of the rule). *Cf. William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1870, 1872 (TTAB 1994) (motion to substitute party that acquired mark from opposer prior to commencement of proceeding granted where opposition had been mistakenly filed in name of original owner); *Missouri Silver Pages Directory Publishing Corp. Inc. v. Southwestern Bell Media,Inc.*, 6 USPQ2d 1028, 1032 (TTAB 1988) (president/sole shareholder is in privity with opposer corporation and may be substituted as "real party in interest" during opposition). *Cf. also* TMEP § 803.03 and TMEP § 1201.02(c); *Chien Ming Huang v. Tzu Wei Chen Food Co.*, 849 F.2d 1458, 7 USPQ2d 1335, 1336 (Fed. Cir. 1988) (trademark application was fatally defective because applicant was not the owner of the mark, having transferred it from himself to a corporation between the time that he executed the application and the date it was received in the Office); *In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1640 (TTAB 1991) (correction not permitted where joint venture owned the mark but the application was filed by a corporation which was one member of the joint venture); *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) (foreign manufacturer, not exclusive United States distributor, owns mark in absence of agreement between them providing otherwise); *Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (substitution allowed where, after opposition instituted, court determined that attempted incorporation of applicant was legally defective; three individuals who owned mark as tenants in common substituted for corporation initially named as owner of mark).

303.05(d) Misidentification of Applicant or Respondent

If a notice of opposition is filed against a mark where the applicant has been inadvertently misidentified in the application, the opposition will nevertheless be instituted and the real party in interest may be substituted for the named defendant during the opposition proceeding. [Note 1.] Likewise, where a petition to cancel is filed against a registrant that has been inadvertently misidentified in the registration, the real party in interest may be substituted for the named defendant.

NOTES:

1. *See* Fed. R. Civ. P. 17(a); 37 CFR § 2.116. *See also Argo & Co. v. Springer*, 189 USPQ 581, 582 (TTAB 1976) (three individuals who owned mark as tenants in common substituted for corporation initially named as owner of mark where, after opposition instituted, court in related civil proceeding determined that attempted incorporation of applicant was legally defective). *Cf. In re Tong Yang Cement Corp.*, 19 USPQ2d 1689, 1690 (TTAB 1991) (application filed by corporation which was not the owner of the mark void ab initio); *Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1210 (TTAB 1988) (foreign manufacturer, not exclusive United States distributor, owns mark in absence of agreement between them providing otherwise).

303.06 Joint Opposers or Petitioners

Two or more parties may file a notice of opposition or a petition for cancellation 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. *See* TBMP § 308. [Note 1.] For information concerning the filing of an opposition by two or more parties jointly where the notice of opposition is filed during an extension of time obtained by only one of the parties, *see* TBMP § 303.05.

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. *See* TBMP § 309.03(b) and TBMP § 309.03(c) for a discussion of standing and grounds for oppositions and cancellations. 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, even though a ground for opposition or cancellation has been proved. [Note 2.]

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. [Note 3.]

NOTES:

1. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994) (licensee was not permitted to join as co-opposer after notice of opposition was filed, but even if permitted, would have had to submit fee).

2. *See Chemical New York Corp. v. Conmar Form Systems, Inc.*, 1 USPQ2d 1139, 1142 (TTAB 1986) (of three joint opposers, owner of registration and its licensee as user of marks had real interest in proceeding, but opposer who only held software copyright had no standing and was given no further consideration). *See*

also Boswell v. Mavety Media Group Ltd., 52 USPQ2d 1600, 1605 (TTAB 1999) (Board found that one of the two opposers did not prove standing).

3. *See Avia Group International Inc. v. Faraut*, 25 USPQ2d 1625, 1627 (TTAB 1992) (respondent's motion to dismiss and its alternative motion to join petitioner's parent as owner of pleaded registrations and real party in interest denied since issue concerned what rights petitioner has in pleaded marks vis-à-vis respondent, not anyone else). *See also Sun Valley Company Inc. v. Sun Valley Manufacturing Co.*, 167 USPQ 304, 310 (TTAB 1970) ("It is illogical to require that all parties that could possibly be injured by a registration be joined as parties to a cancellation or opposition proceeding before any one party can seek relief from the registration of a mark. This position is contrary to the specific provisions of Sections 13 and 14 of the Statute which provide that 'any person' who believes that he is or would be damaged by the registration of a mark is a proper party to file an opposition or a petition to cancel.").

304 Proceeding Against Multiple Class Application or Registration

When a notice of opposition is filed with respect to an application which contains goods and/or services in multiple classes [Note 1] 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. [Note 2.] *See* TBMP § 308.04. If there are insufficient fees accompanying the complaint to pay in full for each named opposer or petitioner for each class opposed or for which cancellation is sought, the proceeding will not be instituted in ESTTA and the transaction will not be completed. If filed on paper, the proceeding may not be instituted. [Note 3.] The institution notice will identify the parties and classes for which the required fees were submitted. *See* TBMP § 308 for information on filing fees. For information about dividing a multi-class application where not all classes are opposed, or dividing an application where not all goods in the opposed class(es) are opposed, *see* TBMP § 516. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.86.

2. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

3. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

4. *See also* TMEP § 1110 *et. seq. Cf.* TMEP § 1403.03.

305 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) *When appropriate, petitions for cancellation of different registrations owned by the same party may be joined in a consolidated petition for cancellation. The required fee must be included for each party joined as a petitioner for each class sought to be cancelled in each registration against which the petition for cancellation has been filed.*

305.01 Consolidated Complaint

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. [Note 1.] *See* TBMP § 308.05 regarding fees for filing consolidated complaints. When such a pleading is filed, the Board will set up a single opposition file, identified by a single opposition proceeding number, but bearing the number of each application opposed in the consolidated notice of opposition.

Similarly, when appropriate, a party may seek to cancel, in a single (i.e., "consolidated") petition for cancellation, different registrations owned by the same defendant. 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. [Note 2.] *See* TBMP § 308.05. When such a pleading is filed, the Board will set up a single cancellation file, identified by a single cancellation proceeding number, but bearing the number of each registration sought to be cancelled in the consolidated petition to cancel.

A consolidated notice of opposition, or consolidated 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. [Note 3.]

For information concerning motions to consolidate proceedings, *see* TBMP § 511.

NOTES:

1. *See* 37 CFR § 2.104(b).

2. *See* 37 CFR § 2.112(b).

3. *See* Fed. R. Civ. P. 42(a); *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (oppositions involving similar marks and similar issues consolidated); *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441 (TTAB 1973) (applicant's motion to consolidate denied in view of extent of differences in the involved issues); *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (joint motion to consolidate granted in view of identity of parties and issues), *Federated Department Stores, Inc. v. Gold Circle Insurance Co.*, 226 USPQ 262, 263 (TTAB 1985) (consolidation permitted; issues of fact and law substantially similar).

305.02 No Combined Complaint

A party may not file a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations owned by the same defendant. [Note 1.]

Filing by ESTTA is required, and no ESTTA form exists for such a combined complaint. [Note 2.] However, to achieve a comparable result a filer may separately electronically file a notice of opposition and a petition for cancellation and simultaneously request consolidation. [Note 3.] To facilitate proper handling, the motion for consolidation in this situation should be included in the same filing with the petition for cancellation, for which the institution order is reviewed by Board personnel rather than automatically instituted and sent, as with most oppositions. The attached pleading should include a prominent reference to the motion to consolidate. This procedure will help bring the requested consolidation to the Board's attention more promptly

when the notice of institution for the petition to cancel is reviewed. Alternatively, the filer may move for consolidation in a separate, subsequent filing. For information concerning motions to consolidate proceedings, *see* TBMP § 511. Once consolidated, the opposition is treated as the "parent" case, and both proceeding numbers are placed on all documents relating to the combined proceedings. *Cf.* TBMP § 511.

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

2. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016). ("… no exception to the requirement to file by ESTTA will be made for a combined filing, and prior case law allowing for this type of combined notice of opposition and petition for cancellation is superseded by the mandatory online filing requirement.").

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

306 Time for Filing Opposition

306.01 In General

15 U.S.C. § 1062(a) ***[Section 12(a) of the Trademark Act]*** *Upon the filing of an application for registration and payment of the prescribed fee, the Director 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 1051(d) of this title, the Director shall cause the mark to be published in the Official Gazette of the Patent and Trademark Office....*

15 U.S.C. § 1063(a) ***[Section 13(a) of the Trademark Act]*** *Any person who believes that he would be damaged by the registration of a mark upon the principal register, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, 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 1062 of this title 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 Director for good cause when requested prior to the expiration of an extension. The Director shall notify the applicant of each extension of the time for filing opposition...*
.

37 CFR § 2.101 ***Filing an opposition.***

(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.* * * * *

(b)(1) *An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.*

(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be*

filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.

(3) *An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.*

(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.* * * *

(e) *The filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition, and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

An opposition to the registration of a mark on 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. [Note 1.] *See* TBMP § 303.

An opposition to an application based on Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126 must be filed electronically via ESTTA. [Note 2.] In the rare circumstance that an opposition is filed on paper, accompanied by the Petition to the Director and the required fee, the certificate of mailing by first-class mail procedure described in 37 CFR § 2.197 and the Priority Mail Express® procedure described in 37 CFR § 2.198 are both available. **Please note:** The institution of a timely paper-filed opposition will occur only if the Petition to the Director is granted and the opposition does not have any other defects. *See* TBMP § 309.04. The certificate of facsimile transmission procedure, described in 37 CFR § 2.197, is not available. [Note 3.] *See* TBMP § 111.02.

An opposition to an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a) must be filed electronically via ESTTA and may not be filed on paper under any circumstances. [Note 4.] *See* TBMP § 203.01.

The filing date of an opposition is the date of electronic receipt in the Office of the opposition and the required fee. [Note 5.] In the rare instance that a paper filing is permitted, the filing date will be determined in accordance with 37 CFR § 2.195, 37 CFR § 2.196, and 37 CFR § 2.197 unless the notice is filed in accordance with 37 CFR § 2.198 (Filing of correspondence by Priority Mail Express®). [Note 6.] If the notice is filed in accordance with 37 CFR § 2.198, the filing date of an opposition will be the date of deposit with the United States Postal Service ("USPS"), i.e., the date shown by the "date in" date on the Priority Mail Express® label or other official USPS notation, unless the "date in" date cannot be determined, in which case the date the notice is received in the Office is considered the filing date of the opposition. [Note 7.]

After the close of the time period for filing an opposition, including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed or to add a joint opposer. [Note 8.] Nor may an opposition, once instituted, be amended to correct a misidentified serial number associated with the application sought to be opposed. [Note 9.] The Board may, however, be able to correct serial number misidentification errors that are brought to its attention by the opposer, in the rare instances that the opposition has not yet been instituted and time remains in the opposition period. In such a circumstance, a would-be opposer's remedy is to seek to cancel the mark once the application has matured to registration by filing a petition to cancel in ESTTA, or (if time remains in the opposition period) to file a new opposition through ESTTA, including payment of the filing fee therefor, which correctly identifies the application sought to be opposed. If an opposition is instituted against an incorrect serial number, and the mistake cannot be corrected, the Board will not refund the opposition fee.

Parties using the ESTTA filing system will not face late opposition and other timing errors. The ESTTA system will not permit a would-be opposer to file an opposition against an application that has not yet been published or that has been abandoned, or where the statutory time period for filing an opposition has passed. The ESTTA system also prompts the would-be opposer, once the user identifies the serial number of the application sought to be opposed, to verify that it has correctly identified the serial number associated with the application. *See* TBMP § 306.04. In addition, as long as the ESTTA filing process is completed, a potential opposer is assured that its filing will be accorded a valid filing date. [Note 10.]

For information on opposition filing fees, *see* TBMP § 308. For information on how to file an opposition, *see* TBMP § 309. For information on service of the notice of opposition, *see* TBMP § 309.02(c).

For information concerning the effect of such matters as restoration of jurisdiction, republication, amendment, letter of protest, petition to the Director, abandonment, or the inadvertent issuance of a registration, on the filing of an opposition or a request to extend time to oppose, *see generally*, TBMP Chapter 200.

NOTES:

1. Trademark Act § 13(a), 15 U.S.C. § 1063(a), and 37 CFR § 2.102(b) and 37 CFR § 2.102(c); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994).

2. *See* 37 CFR § 2.101(b)(1).

3. *See* 37 CFR § 2.195(d)(3), 37 CFR § 2.197(a) and 37 CFR § 2.198(a). *See also Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (opposition filed by facsimile not entitled to a filing date or improperly filed).

4. 37 CFR § 2.101(b)(3). *Cf. In re Börlind Gesellschaft für Kosmetische Erzeugnisse GmbH*, 73 USPQ2d 2019, 2020 (TTAB 2005) (former 37 CFR § 2.102(a)(2) (now 37 CFR § 2.102(a)(1)) requires ESTTA filing of extensions of time to oppose Trademark Act § 66(a) applications).

5. *See* 37 CFR § 2.101(e).

6. 37 CFR § 2.101(e). *See Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (untimely opposition dismissed as a nullity).

7. *See* 37 CFR § 2.198(a)(2).

8. *See* 37 CFR § 2.107(a); *Drive Trademark Holdings LP v. Inofin and Mark Walsh*, 83 USPQ2d 1433, 1436 (TTAB 2007).

9. *See Yahoo! Inc. v. Loufrani*, 70 USPQ2d 1735, 1736 (TTAB 2004) (opposition listing the incorrect serial number of the application dismissed as a nullity). *Cf. Quality S. Manufacturing Inc. v. Tork Lift Central Welding of Kent Inc.*, 60 USPQ2d 1703, 1704 (Comm'r 2000) (Board directed to terminate opposition that misidentified serial number associated with application; registration will not be cancelled); and *In re Merck & Co. Inc.*, 24 USPQ2d 1317, 1318 (Comm'r 1992) (application misidentified in request for extension of time).

10. 37 CFR § 2.101(e); *Chocoladefabriken Lindt & Sprungli AG v. Flores*, 91 USPQ2d 1698, 1699 n.3 (TTAB 2009) ("Of course, a potential opposer must complete the ESTTA filing process to be accorded a

valid filing date"), citing *Vibe Records, Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282 (TTAB 2008) (the official filing date of an ESTTA filing is the date time-stamped when the ESTTA filing and required fee are received on the USPTO server).

306.02 Date of Publication of Mark

The date of publication of a mark is the issue date of the issue of the Official Gazette in which the mark appears, pursuant to Trademark Act § 12(a), 15 U.S.C. § 1062(a), for purposes of opposition. The Official Gazette is available in electronic form at **http://www.uspto.gov/**.

306.03 Premature Opposition

Trademark Act § 13(a), 15 U.S.C. § 1063(a), requires that an opposition to the registration of a mark on 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 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, and any submitted opposition fee will be refunded. *Cf.* TBMP § 119.03 and TBMP § 202.03.

306.04 Late Opposition

Because the timeliness requirements of Trademark Act § 13(a), 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 Board or by the Director on petition. [Note 1.]

Parties using the ESTTA filing system will not face late opposition and other timing errors. The ESTTA system will not permit a would-be opposer to file an opposition against an application that has not yet been published or that has been abandoned, or where the statutory time period for filing the opposition has passed. Accordingly, ESTTA will reject an attempt to electronically file an opposition after the expiration of the would-be opposer's time for opposing. In the rare instance that a party files an opposition on paper and it has been permitted by the Director, on petition, an opposition that has been filed after the expiration of the would-be opposer's time for opposing must be denied by the Board as late. The opposition will not be instituted, and any submitted opposition fee will be refunded. The fee for the petition to the Directore will not be refunded. In either circumstance, the would-be opposer's remedy lies in the filing of a petition for cancellation, pursuant to Trademark Act § 14, 15 U.S.C. § 1064 when and if a registration is issued. [Note 2.]

For information concerning the effect of fee and signature requirements on the timing of an opposition, *see* TBMP § 308.02(b) and TBMP § 309.02(b), respectively.

NOTES:

1. *See The Equine Touch Foundation, Inc. v. Equinology, Inc.*, 91 USPQ2d 1943,1945 n.6 (TTAB 2009) ("The time for filing a notice of opposition is statutory and cannot be waived by the Board"); *In re Sasson Licensing Corp.*, 35 USPQ2d 1510, 1512 (Comm'r 1995) (waiver of now amended United States Patent and Trademark Office Rule 1.8regarding certificates of mailing would effectively waive Trademark Act § 13, 15 U.S.C. § 1063 and, in any event, fact that potential opposer did not retain executed hard copies of documents filed with Office and cannot prove document was timely is not an extraordinary circumstance

justifying a waiver of Rule 1.8); *In re Kabushiki Kaisha Hitachi Seisakusho*, 33 USPQ2d 1477, 1478 (Comm'r 1994); *In re Cooper*, 209 USPQ 670, 671 (Comm'r 1980). **Please Note:** In 2003, Trademark Rule 1.8 was replaced by 37 CFR § 2.197, which is now the applicable rule regarding certificates of mailing.

2. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 n.10 (TTAB 2007).

307 Time for Filing Petition to Cancel

15 U.S.C. § 1064 ***[Trademark Act § 14]*** *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, including as a result of a likelihood of confusion of dilution by blurring or dilution by tarnishment under section 43(c), 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 is functional or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 or 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 certification mark for purposes other than to certify, or (D) 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 such person is or will be damaged by the registration of a mark on the supplemental register--*

(1) *for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 43(c); or*

(2) *on grounds other than dilution by blurring or dilution by tarnishment, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the*

Director to cancel such registration. The Director 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 Director. 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 ***Filing petition for cancellation.***

(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.*

(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part. The petition for cancellation need not be verified, but must be signed by the petitioner or the petitioner's attorney, as specified in § 11.1 of this chapter, or other authorized representative, as specified in § 11.14(b) of this chapter. Electronic signatures pursuant to § 2.193(c) are required for petitions submitted electronically via ESTTA. The petition for cancellation 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(3) or (5) of the Act. In all other cases, the petition for cancellation 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.*

* * * *

(e) The filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date of a petition for cancellation will be determined in accordance with §§ 2.195 through 2.198.

307.01 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. A petition to cancel may also be filed at any time in the case of a registration issued under the Act of 1881 or the Act of 1905 which has not been published under Trademark Act § 12(c), 15 U.S.C. § 1062(c). [Note 1.]

In addition, a petition to cancel any registration may be filed at any time on any ground specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5). [Note 2.]

As permitted by Trademark Act § 14(3), 15 U.S.C. § 1064(3), a petition to cancel may be filed at any time on grounds that, for example, the mark has been abandoned; the registration was obtained by fraud; the mark is generic; the mark is geographically deceptive, [Note 3],or disparaging, or falsely suggests a connection with a person's name or identity, [Note 4], the mark comprises matter that, as a whole, is functional [Note 5], or the mark comprises the flag of the United States [Note 6], or the name of a living individual without the individual's consent. [Note 7.]

The filing date of the petition is the date of electronic receipt in the Office of the petition, with the required fee. [Note 8.] In the rare instance that a paper filing is permitted by the Director, on petition, the filing date of the petition will be determined in accordance with 37 CFR § 2.195, 37 CFR § 2.196, and 37 CFR § 2.197 unless the petition is filed by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service ("USPS") in accordance with 37 CFR § 2.198. [Note 9.] If the petition is filed in accordance with 37 CFR §2.198, the filing date of a petition will be the date of deposit with the USPS, i.e.,

the date shown by the "date in" date on the "Priority Mail Express®" label or other official USPS notation, unless the "date in" date cannot be determined, in which case the date of receipt in the Office is considered the filing date of the petition. [Note 10.]

For additional information on selected grounds for opposition and cancellation, *see* TBMP § 309.03(c).

For information on filing fees, *see* TBMP § 308. For information on service of the petition for cancellation, *see* TBMP § 309.02(c).

NOTES:

1. *See* Trademark Act § 14 and Trademark Act § 24, 15 U.S.C. § 1064 and 15 U.S.C. § 1092; 37 CFR § 2.111(b).

2. *See* Trademark Act § 14 and Trademark Act § 24, 15 U.S.C. § 1064 and 15 U.S.C. § 1092; 37 CFR § 2.111(b).

3. *See* Trademark Act § 2(a), 15 U.S.C. § 1052(a). *Cf. Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1524-25 (TTAB 2013) (registration over five years old may not be challenged on a ground that is available only when the registration is less than five years old); *Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990) (registration over five years old may not be challenged on ground that mark is geographically descriptive under Trademark Act §2(e)(2), 15 U.S.C. § 1052(e)(2)).

4. *See* Trademark Act § 2(a), 15 U.S.C. § 1052(a).

5. *See* Trademark Act § 2(e)(5), 15 U.S.C. § 1052(e)(5).

6. *See* Trademark Act § 2(b), 15 U.S.C. § 1052(b).

7. *See* Trademark Act § 2(c), 15 U.S.C. § 1052(c).

8. *See* 37 CFR § 2.111(e).

9. *See* 37 CFR § 2.111(e).

10. *See* 37 CFR § 2.198(a)(2).

307.02 Petition That Must Be Filed Within Five Years from the Date of Registration

307.02(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 Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), must be filed within 5 years from the date of the registration of the mark. [Note 1.] 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 Trademark Act § 12(c), 15 U.S.C. § 1062(c) on a ground not specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) must be filed within 5 years from the date of publication under Trademark Act § 12(c), 15 U.S.C. § 1062(c). [Note 2.]

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 Trademark Act § 14(3) or 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), a petition to cancel filed prior to the expiration of the five-year period may be based on any ground which could have prevented registration initially. [Note 3.] The grounds for cancellation which are thus available in the case of a petition filed within the five-year period, but not thereafter, include: all of the grounds specified in Trademark Act § 14(3) and Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) as well as likelihood of confusion under Trademark Act § 2(d), 15 U.S.C. § 1052(d); [Note 4], certain grounds specified in Trademark Act § 2(e), 15 U.S.C. § 1052(e) (including a claim that respondent's mark is merely descriptive or deceptively misdescriptive, that respondent's mark is geographically descriptive or geographically deceptively misdescriptive, or that respondent's mark is primarily merely a surname) [Note 5]; the ground that respondent is not the owner of the registered mark; and the ground that there was no bona fide use of respondent's mark in commerce to support the original registration.

For additional information on selected grounds for opposition and cancellation, *see* TBMP § 309.03(c). For a discussion of standing to file a petition to cancel or a notice of opposition, *see* TBMP § 309.03(b).

As stated above, a petitioner may not seek to cancel a Principal Register registration over 5 years old on the ground of likelihood of confusion. [Note 6.] However, under Trademark Act § 18, 15 U.S.C. § 1068, a petitioner may seek to partially cancel a registration over 5 years old by restricting the goods or services therein in order to avoid a likelihood of confusion. For a discussion of a petition to partially cancel a registration under Trademark Act § 18, 15 U.S.C. § 1068, *see* TBMP § 309.03(d).

Note that a petitioner may not seek to cancel a Principal Register registration over 5 years old on the ground that it is generic, where the genericness claim is made only as to a portion of the mark and not the entire mark. However, the alleged generic nature of the portion of the mark may have a bearing on the likelihood of confusion analysis. [Note 7.]

The five-year period specified in Trademark Act § 14(1), 15 U.S.C. § 1064(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. [Note 8.] *Cf.* TMEP § 1604.04 and TMEP § 1606.03. Similarly, the five-year period specified in Trademark Act § 14(2), 15 U.S.C. § 1064(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 Trademark Act § 12(c), 15 U.S.C. § 1062(c). [Note 9.]

The filing date of the petition is the date of electronic receipt in the Office of the petition, with the required fee. [Note 10.] In the rare instance that a paper filing is permitted by the Director, on petition, the Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Priority Mail Express®" procedure described in 37 CFR § 2.198 are available. [Note 11.] If the paper filing of the petition to cancel has been permitted by way of Petition to the Director, the filing date of the petition will be determined in accordance with 37 CFR § 2.195, 37 CFR § 2.196, and 37 CFR § 2.197 unless the petition is filed by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service ("USPS") in accordance with 37 CFR § 2.198. [Note 12.] If the petition is filed by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service ("USPS") in accordance with 37 CFR §2.198, then the filing date of the petition is the date the petition was deposited with the USPS i.e., the date shown by the "date in" date on the "Priority Mail Express®" label or other official USPS notation, unless the "date in" date cannot be determined, in which case the date the notice is received in the Office is considered the filing date of the petition. [Note 13.]

For information on filing fees, *see* TBMP § 308.

NOTES:

1. *See Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (claim under Trademark Act § 2(d), 15 U.S.C. § 1052(d) is time-barred under Trademark Act § 14(3), 15 U.S.C. § 1064(3); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1913 (TTAB 2007) (same); *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (the filing date of the petition is the operative date in determining whether the cancellation is time barred, not the date that the notice of the proceeding is mailed to the parties). *Cf. British-American Tobacco Co. Limited v. Philip Morris Inc.*, 55 USPQ2d 1585, 1590 (TTAB 2000) (Trademark Act § 14, 15 U.S.C. § 1064 does not limit Board's authority to entertain an action under Article 8 of the Pan American Convention against a registration over five years old).

2. *See* Trademark Act § 14(1) and Trademark Act § 14(2), 15 U.S.C. § 1064(1) and 15 U.S.C. § 1064(2); 37 CFR § 2.111(b).

3. *See Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142, 142 (Fed. Cir. 1986); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); and *Kellogg Co. v. Pack'Em Enterprises Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991).

4. *See Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862-63 (TTAB 2007) (Trademark Act§ 2(d), 15 U.S.C. § 1052(d) not a legitimate basis for petition to cancel a registered mark where the registration is more than five years old). *Cf. Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (claim of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

5. *See The Equine Touch Foundation Inc. v. Equinology, Inc.*, 91 USPQ2d 1943, 1945(TTAB 2009) (petition to cancel a registration on the Principal Register on a claim that the mark is descriptive may be filed at any time within five years of the date of registration). *Cf. Montecash LLC v. Anzar Enterprises Inc.*, 95 USPQ2d 1060, 1061(TTAB 2010) (registration more than five years old may not be cancelled based on claim that a portion of the mark is generic term); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (same; motion to strike claim granted).

6. *See Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862-63 (TTAB 2007).

7. *See Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (decision to strike counterclaim as time-barred does not affect respondent's ability to argue that a portion of the mark is generic and should be accorded less weight in a likelihood of confusion analysis).

8. *See Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990) (fifth-year anniversary falling on a weekend or holiday).

9. *Cf. Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1310 (TTAB 1990);TMEP § 1604.04 and TMEP § 1606.03.

10. *See* 37 CFR § 2.111(e).

11. *See* 37 CFR § 2.111(e), 37 CFR § 2.197(a) and 37 CFR § 2.198(a).

12. *See* 37 CFR § 2.111(e).

13. *See* 37 CFR § 2.198.

307.02(b) Trademark Act § 14, 15 U.S.C. § 1064, Limitation is Independent of Trademark Act § 15, 15 U.S.C. § 1065, Affidavit

The five-year time limit specified in Trademark Act § 14, 15 U.S.C. § 1064, barring certain attacks on a Principal Register *registration*, "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)." [Note 1.]

NOTES:

1. *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390, 1392 n.5 (Fed. Cir. 1990) (emphasis in original). *See also Western Worldwide Enterprises Group Inc. v. Qinqdao Brewery*, 17 USPQ2d 1137, 1139 (TTAB 1990); *Strang Corp. v. Stouffer Corp.*, 16 USPQ2d 1309, 1311 (TTAB 1990) (concept of incontestability of a registration is irrelevant to a cancellation proceeding under Trademark Act § 14, 15 U.S.C. § 1064).

307.02(c) Factors Affecting the Five-Year Period

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

If an opposer relies on 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 to cancel such pleaded registration, filed in response to the notice of opposition. 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 on which a counterclaim may be based. [Note 1.]

Similarly, the limitation would not apply to a counterclaim to cancel such a Principal Register registration relied on 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.

NOTES:

1. *See, e.g., Williamson-Dickie Manufacturing Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 862 n.3 (TTAB 1980) (grounds not limited where petition to cancel registration pleaded in opposition was not filed until after fifth anniversary date of registration, because opposition wherein opposer relied on registration was filed before anniversary date); *Humble Oil & Refining Co. v. Sekisui Chemical Co. Ltd. of Japan*, 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although counterclaim to cancel pleaded registration was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). *See also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:67 (2017). *Cf.* regarding concurrent use proceedings, *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (five-year period tolled where applicant, prior to expiration of five-year period, files a proper concurrent application or an amendment

converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

307.02(c)(2) Amendment of Registration

When a Principal Register registration has been amended, the registration is subject to attack under Trademark Act § 14, 15 U.S.C. § 1064, 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 Trademark Act § 14, 15 U.S.C. § 1064 five-year period following issuance of the registration, or publication under Trademark Act § 12(c), 15 U.S.C. § 1062(c), may have expired, if a petition to cancel the registration is filed within the 5 years following the amendment of the registration, the petition is not limited to Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the 5 years after the amendment, "the modified registration, not having been in existence for 5 years, may be challenged in a cancellation proceeding as long as petitioner states grounds [not limited to Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) grounds] for the cancellation indicating how he believes he is or will be damaged by the modified registration." [Note 1.]

NOTES:

1. *Stanspec Co. v. American Chain & Cable Co.*, 531 F.2d 563, 189 USPQ 420, 423 (CCPA 1976). *See Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 824-25 (TTAB 1984) (counterclaim would be proper where defendant pleads that the amendment to the mark in the subject registration resulted in a mark materially different from originally registered mark, representing enlargement of rights conferred by original certificate of registration; that defendant used its mark prior to opposer's first use of amended mark; and that confusion with amended mark is likely).

307.02(c)(3) Amendment of Petition for Cancellation

If a petitioner files a cancellation against a registration and the five-year period has not yet expired when the cancellation is filed, the five-year time limit specified in Trademark Act § 14, 15 U.S.C. § 1064, does not bar any claims that may be raised by an amended pleading, subject to the provisions of Fed. R. Civ. P 15(a). This is so even if the five-year period has expired by the time an amended petition for cancellation is filed. In such cases, the filing of the cancellation tolls, during the pendency of the proceeding, the running of the five-year period for purposes of determining the grounds on which a cancellation may be based. [Note 1.] See TBMP § 507 regarding motions to amend the pleadings.

NOTES:

1. *See Ashland Licensing & Intellectual Property LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125, 1128-30 (TTAB 2016) (the commencement of a cancellation proceeding prior to the fifth-year anniversary of the registration tolls Trademark Act Section 14 for the purpose of petitioner adding claims against the registration during the pendency of the Board proceeding).

307.03 Premature Petition to Cancel

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

Thus, a petition to cancel a pending application prior to the issuance of the registration is premature, and cannot be filed through ESTTA. In the rare instance of a petition to cancel filed on paper that reflects a filing date prior to the issuance of registration, the petition will be rejected by the Board, even if the registration has issued by the time of the Board's action. The petition to cancel filed on paper will not be instituted, and any submitted fee for the petition to cancel will be refunded. In either circumstance, petitioner's remedy lies in the electronic filing of a new petition to cancel after the registration has issued.

307.04 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 Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), must be filed (with the required fee) 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 Trademark Act § 12(c) (of the Trademark Act § of 1946), 15 U.S.C. § 1062(c), on a ground not specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) must be filed within five years from the date of publication under Trademark Act § 12(c),15 U.S.C. § 1062(c).

If a party attempts to electronically file a petition to cancel one of these Principal Register registrations after the expiration of the five-year period and does not select in ESTTA one or more of the grounds specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5), the petition is late, and ESTTA will not institute the cancellation. In the rare instance that a petition to cancel has been filed on paper and after the expiration of the five-year period and does not plead one or more of the grounds specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) the petition is late, and will be rejected by the Board. The petition to cancel will not be instituted, and any submitted fee for the petition to cancel only will be refunded. However, the rejection of the petition is without prejudice to petitioner's right to electronically file, at any time thereafter, a new petition to cancel the registration, and to plead therein one or more of the grounds specified in Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5).

For information concerning the effect of fee and signature requirements on the timing of a petition to cancel, *see* TBMP § 308.02(b) and TBMP § 309.02(b).

308 Filing Fees

308.01 Fee for Filing Opposition

308.01(a) 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, including the registration of any mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office....*

37 CFR § 2.101

(a) *An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee.*

* * * *

(c) . . . . *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).*

(d) *An otherwise timely opposition cannot be filed via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay in full for each named party opposer to oppose the registration of a mark in each class specified in the opposition. A paper opposition that is not accompanied by the required fee sufficient to pay in full for each named party opposer for each class in the application for which registration is opposed may not be instituted. If time remains in the opposition period as originally set or as extended by the Board, the potential opposer may resubmit the opposition with the required fee.* * * * *

The rules governing opposition fees are specified in 37 CFR § 2.101(c)-37 CFR § 2.101(d). The amount of the required filing fee is specified in 37 CFR § 2.6(a)(17). The required fee must be submitted with the opposition; the filing date of an opposition (and, hence, the date of commencement of the opposition proceeding) is the date of electronic receipt in the Office of both the opposition with the required fee. [Note 1.] In the rare instance of a permitted filing of a paper notice of opposition (granted by a Petition to the Director), the filing date will be determined in accordance with 37 CFR § 2.195, 37 CFR § 2.196, 37 CFR § 2.197 and 37 CFR § 2.198. [Note 2.] *See* TBMP § 309.

The required fee must be submitted for each party joined as opposer for each class opposed, [Note 3] and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified. *See* TBMP § 304. [Note 4.]

For information on how to pay fees, *see* 37 CFR § 2.206-37 CFR § 2.208, and TBMP § 118. For information on fee refunds, *see* 37 CFR § 2.209, and TBMP § 119.

NOTES:

1. *See* 37 CFR § 2.101(e). *See also Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282-83 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity).

2. *See* 37 CFR § 2.101(e).

3. *See* 37 CFR § 2.101(c) and 37 CFR § 2.101(d); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (second named opposer not party to proceeding where notice of opposition named two opposers, but fee payment sufficient for only one opposer and only one opposer identified in ESTTA cover sheet); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) ("With opposers, regardless of the basis of the opposition application, the opposers identified in the ESTTA cover sheet determine the fees paid through ESTTA. Any additional opposers named only in the accompanying statement, for whom no fees have been paid, will not be part of the proceeding, regardless of the filing basis of the opposed application.").

4. *See* 37 CFR § 2.101(d).

308.01(b) Insufficient Fee

An otherwise timely opposition will not be accepted via ESTTA unless the opposition is accompanied by a fee that is sufficient to pay, in full, for each named party opposer to oppose the registration of a mark in each class specified in the opposition. [Note 1.]

A notice of opposition against an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), must be filed electronically through ESTTA and may not under any circumstances be filed in paper form. [Note 2.] *See* TBMP § 309.

A notice of opposition against an application based on Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, must be filed electronically through ESTTA. [Note 3.] In rare circumstances, an opposition may be filed on paper, accompanied by a Petition to the Director and the required fee. [Note 4.] *See* TBMP § 309. Absent the required fee, the opposition may not be instituted. [Note 5.]

The institution notice will identify the parties and classes for which the required fees were submitted. *See* TBMP § 310.

The responsibility for filing proper fees rests with the party filing the fees.

NOTES:

1. *See* 37 CFR § 2.101(d); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (second named opposer not party to proceeding where notice of opposition named two opposers, but fee payment sufficient for only one opposer and only one opposer identified in ESTTA cover sheet); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity).

2. *See* 37 CFR § 2.101(b)(3).

3. *See* 37 CFR § 2.101(b)(1).

4. *See* 37 CFR § 2.101(b)(2)

5. *See* 37 CFR § 2.101(d).

308.02 Fee for Filing Petition to Cancel

308.02(a) In General

15 U.S.C. § 1064 ***[Trademark Act § 14]*** *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, including as a result of a likelihood of dilution by blurring or dilution by tarnishment under section 1125(c) of this title, 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 ***[Trademark Act § 24]*** *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 the supplemental register--*

(1) *for which the effective filing date is after the date on which such person's mark became famous and which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title; or*

(2) *on grounds other than dilution by blurring or dilution by tarnishment, such person may at any time, upon payment of the prescribed fee and the filing of a petition stating the ground therefor, apply to the Director to cancel such registration.* * * *

37 CFR § 2.111(d) *The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration(s) for which cancellation is sought (see § 2.6). A petition cannot be filed via ESTTA unless the petition is accompanied by a fee that is sufficient to pay in full for each named petitioner to seek cancellation of the registration(s) in each class specified in the petition. A petition filed in paper form that is not accompanied by a fee sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought may not be instituted.*

(e) *The filing date of a petition for cancellation is the date of electronic receipt in the Office of the petition and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date of a petition for cancellation will be determined in accordance with §§ 2.195 through 2.198.*

The rules governing cancellation fees are specified in 37 CFR § 2.111(d). 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 electronic receipt in the Office of both the petition to cancel and the required fee. [Note 1.] *See* TBMP § 308.02(b). In the rare instance when an otherwise timely paper filing of a petition to cancel accompanied by the required fees, has been permitted on Petition to the Director, the filing date will be determined in accordance with 37 CFR § 2.195, 37 CFR § 2.196, 37 CFR § 2.197 and 37 CFR § 2.198. [Note 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. [Note 3.] *See* TBMP § 304.

For information on how to pay fees, *see* 37 CFR § 2.206-37 CFR § 2.208, and TBMP § 118. For information on fee refunds, *see* 37 CFR § 2.209, and TBMP § 119.

NOTES:

1. *See* 37 CFR § 2.111(a), 37 CFR § 2.111(d), and 37 CFR § 2.111(e); *Williamson-Dickie Manufacturing Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966). *Cf. Fred Beverages, Inc. v. Fred's Capital Management Co.*, 605 F.3d 968, 94 USPQ2d 1958, 1960 (Fed. Cir. 2010) (Board's decision denying petitioner's motion for leave to amend cancellation petition, for failure to submit fee for amendment at time of filing the motion,reversed; case remanded to Board for further consideration of motion to amend).

2. *See* 37 CFR § 2.111(e).

3. *See* 37 CFR § 2.111(d).

308.02(b) Insufficient Fee

A petition for cancellation must be filed electronically through ESTTA. [Note 1.] *See* TBMP § 309.

An otherwise timely petition for cancellation will not be accepted via ESTTA unless the petition to cancel is accompanied by a fee that is sufficient to pay in full for each named party petitioner to petition for cancellation of the registration of a mark in each class specified in the petition for cancellation. [Note 2.]

In those rare instances where an otherwise timely petition to cancel has been filed on paper, and such filing is not accompanied by any fee, or a sufficient fee to pay to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought, the petition to cancel will be rejected and the Board will not institute a proceeding. [Note 3.]

Except to the extent that the five-year period of Trademark Act § 14, 15 U.S.C. § 1064, is applicable in a particular case, there is no time limit for the filing of a petition to cancel an issued registration. Thus, if the petition is rejected for failure to submit a fee, or a fee that is sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought, the rejection of the petition is without prejudice to petitioner's right to electronically file, at any time thereafter, a new petition to cancel 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. [Note 5.]

The responsibility for filing proper fees rests with the party filing the fees. [Note 6.]

NOTES:

1. *See* 37 CFR § 2.111(c)(1). Board practice does not permit the filing of a petition for cancellation on CD-ROM. *See* 37 CFR § 2.126; MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 72 Fed. Reg. 42242, 42247 (August 1, 2007).

2. *See* 37 CFR § 2.111(d). *Cf. Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (second named opposer not party to proceeding where notice of opposition named two opposers, but fee payment sufficient for only one opposer and only one opposer identified in ESTTA cover sheet); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282-83 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity).

3. *See* 37 CFR § 2.111(d).

4. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (defective renewal application must be corrected and refiled within statutory time period);and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

5. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding defective renewal application); *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

308.02(c) 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. [Note 1.] *Cf.* TBMP § 303.04.

NOTES:

1. *See* Trademark Act § 14, 15 U.S.C. § 1064.

308.02(d) Fee for Counterclaim

For information concerning fees for counterclaims, *see* TBMP § 313.02.

308.03 Fees for Joint Opposers or Petitioners

Two or more parties may file an opposition, or a petition for cancellation, 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. [Note 1.] *See* TBMP § 308.01 and TBMP § 308.02. *See also* TBMP § 303. Oppositions and petitions filed through ESTTA must be accompanied by the proper fees for each party in the position of plaintiff, for each class in each application opposed or registration sought to be cancelled. [Note 2.] *See* TBMP § 308.01(b) and TBMP § 308.02(b). If all party plaintiffs are identified during the ESTTA filing process, the electronic filing system calculates the proper fees and will not institute the proceeding until the appropriate fees have been paid. [Note 3.] In rare circumstances where an opposition or petition to cancel is filed on paper, the opposition or cancellation may not be instituted if insufficient fees have been provided to pay in full for each named party plaintiff for each class in the application sought to be opposed, or for each party plaintiff for each class in the registration sought to be cancelled. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d); *SDT Inc. v. Patterson Dental Co.*, 30 USPQ2d 1707, 1709 (TTAB 1994).

2. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

3. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d). *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (where only one opposer was identified during the filing process, only one was charged; second named opposer not considered party to proceeding); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1021 n.1 (TTAB 2009) (second petitioner not added as party plaintiff due to failure to pay additional fee). *Cf. Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1282-83 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity).

4. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

308.04 Fees for Proceeding Against Multiple Class Application or Registration

The required opposition or cancellation fee must be submitted for each party joined as plaintiff for each class sought to be opposed or cancelled. [Note 1.] *See* TBMP § 308.01 and TBMP § 308.02. *See also* TBMP § 304. Oppositions and petitions filed through ESTTA must be accompanied by the proper fees for each party in the position of plaintiff, for each class in each application opposed or registration sought to be cancelled. [Note 2.] *See* TBMP § 308.01(b) and TBMP § 308.02(b). In the rare circumstances where an opposition or petition to cancel is filed on paper, the opposition or cancellation may not be instituted if insufficient fees have been provided to pay in full for each named party plaintiff for each class in the

application sought to be opposed, or for each party plaintiff for each class in the registration sought to be cancelled. [Note 3.]

NOTES:

1. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

2. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d).

3. *See* 37 CFR § 2.101(d) and 37 CFR § 2.111(d)

308.05 Fees for Consolidated and Combined Complaints

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. [Note 1.] *See* TBMP § 305 and TBMP § 308.01.

Similarly, when appropriate, a party may seek to cancel, in a single (i.e., "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. [Note 2.] *See* TBMP § 305 and TBMP § 308.02.

A party may not file a single pleading combining a notice of opposition to one or more applications, and a petition to cancel one or more registrations, even when each subject application and registration is owned by the same defendant. [Note 3.] *See* TBMP § 305.02. Filing by ESTTA is required, and no ESTTA form exists for such a combined complaint. [Note 4.] However, to achieve a comparable result a filer may separately electronically file a notice of opposition and a petition for cancellation and simultaneously request consolidation. [Note 5.] It is recommended to file the request for consolidation in a separate submission in ESTTA.

See TBMP § 305 for more information on consolidated and combined complaints and filing in ESTTA. For information concerning motions to consolidate proceedings, see TBMP § 511.

NOTES:

1. *See* 37 CFR § 2.104(b).

2. *See* 37 CFR § 2.112(b).

3. *See, e.g., Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 n.2 (TTAB 1993) (combined opposition and cancellation).

4. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016). ("… no exception to the requirement to file by ESTTA will be made for a combined filing, and prior case law allowing for this type of combined notice of opposition and petition for cancellation is superseded by the mandatory online filing requirement.").

5. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

309 Form and Content of Oppositions and Petitions to Cancel

309.01 In General

37 CFR § 2.101(b) *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may file an opposition addressed to the Trademark Trial and Appeal Board.*
...

(1) *An opposition to an application must be filed by the due date set forth in paragraph (c) of this section through ESTTA.*

(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an opposition against an application based on Section 1 or 44 of the Act may be filed in paper form. A paper opposition to an application based on Section 1 or 44 of the Act must be filed by the due date set forth in paragraph (c) of this section and be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph. Timeliness of the paper submission will be determined in accordance with §§ 2.195 through 2.198.*

(3) An opposition to an application based on Section 66(a) of the Act must be filed through ESTTA and may not under any circumstances be filed in paper form.

* * * *

37 CFR § 2.111(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part.*

* * * *

37 CFR § 2.111(c)(1) *A petition to cancel a registration must be filed through ESTTA.*

37 CFR § 2111(c)(2) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a petition to cancel may be filed in paper form. A paper petition to cancel a registration must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (c). Timeliness of the paper submission, if relevant to a ground asserted in the petition to cancel, will be determined in accordance with §§ 2.195 through 2.198.*

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 submission 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 submission will not be refused consideration if a signed copy is submitted to the Office within the time limit set in the notification of this defect by the Office.*

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form. All submissions in paper form, except the extensions of time to file a notice of opposition, the notice of opposition, the petition to cancel, or answers thereto (see §§ 2.101(b)(2), 2.102(a)(2), 2.106(b)(1), 2.111(c)(2), and 2.114(b)(1)), must include a written explanation of such technical problems or extraordinary circumstances. Paper submissions that do not meet the showing required under this paragraph (b) will not be considered. A paper submission, including exhibits and depositions, must meet the following requirements:*

(1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

(3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

(4) *A paper submission must not be stapled or bound;*

(5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in § 2.123(g)(2);*

(6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

(c) *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the "Confidential" selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.*

* * * *

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Submissions, including oppositions and petitions to cancel, must be made to the Board electronically via ESTTA. [Note 1.] An opposition to an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), may not under any circumstances be filed in paper form [Note 2], but if ESTTA is unavailable due to technical problems, or due to extraordinary circumstances, an opposition to an application based on Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, may be filed on paper, accompanied by a Petition to the Director and the required fee. [Note 3.] Similarly, if ESTTA is unavailable due to technical problems, or due to extraordinary circumstances, a petition to cancel against a § 1 or § 44 registration or a § 66(a) registered extension of protection may be filed on paper, accompanied by a Petition to the Director and the required fee. [Note 4.]

The notice of opposition, or petition to cancel, corresponds to the complaint in a court proceeding. [Note 5.] For purposes of simplicity, the term "complaint" is often used hereafter in this section to refer to a notice of opposition or a petition to cancel.

NOTES:

1. *See* 37 CFR § 2.126(a); 37 CFR §2.101(b)(1); 37 CFR §2.101(b)(3); 37 CFR § 2.111(c)(1).

2. *See* 37 CFR § 2.101(b)(3). *See also CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011) (any opposition to a Section 66(a) application must be filed through ESTTA); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011) (same).

3. *See* 37 CFR § 2.101(b)(2).

4. 37 CFR § 2.111(c)(2).

5. *See* 37 CFR § 2.116(c).

309.02 Form of Complaint

The form of a complaint must meet the general requirements for submissions to the Board as set forth in 37 CFR § 2.126. *See* TBMP § 106.03. When the complaint is filed electronically through ESTTA, the text in the electronic submission must be in at least 11-point type and double-spaced, and any exhibits pertaining to the electronic submission must be made electronically as an attachment to the complaint and be clear and legible. [Note 1.]

An opposition against a Trademark Act § 1, Trademark Act § 44, and Trademark Act § 66(a), 15 U.S.C. § 1051 or 15 U.S.C. § 1126, or 15 U.S.C. § 1141f(a) application must be filed electronically through ESTTA. [Note 2.] Similarly, a petition for cancellation, must be filed electronically through ESTTA. [Note 3.] In the rare instances when a complaint is filed on paper, the submission, including any exhibits, must be in at least 11-point type and double-spaced, may not be stapled or bound or have any extruding tabs or other such devices, and must otherwise comply with the requirements of 37 CFR § 2.126(b).

NOTES:

1. *See* 37 CFR § 2.126(a)(1) and 37 CFR § 2.126(a)(2).

2. *See* 37 CFR § 2.101(b)(1); 37 CFR § 2.101(b)(3).

3. 37 CFR § 2.111(c)(1).

309.02(a) Format for Complaint

Parties are required to use ESTTA to commence the proceeding and for general filing purposes. [Note 1.] Using ESTTA, a person can complete and submit a notice of opposition or petition for cancellation over the Internet, making an official filing online. ESTTA gives step-by-step instructions for properly completing a filing. In the rare circumstances that a filing through ESTTA cannot be accomplished, *see* 37 CFR § 2.101(b)(2) and 37 CFR § 2.111(c)(2), the ESTTA form (docket) "cover sheet" created using ESTTA may be completed and then be printed out for mailing to the Board along with the notice of opposition or petition to cancel, accompanied by the requirements for such a paper filing. [Note 2.] If filed on paper, the certificate of mailing by first-class mail procedure described in 37 CFR § 2.197 and the Priority Mail Express® procedure described in 37 CFR § 2.198 are both available. **Please Note:** Oppositions against § 66(a) applications cannot be filed on paper under any circumstances.

The Board views the ESTTA filing form and the attached pleading as comprising a single document or paper being filed with the Board. [Note 3.] Upon filing via ESTTA, the filer will receive an email acknowledgement of receipt from ESTTA with the ESTTA tracking number and the filing information. After the proceeding

is instituted, whenever a party submits a filing via ESTTA, the ESTTA cover sheet is automatically "pre-populated" with the party's name as that party is listed in TTABVUE (the Board's database of electronic proceeding files). The electronic files of the Board are accessible on the Internet via TTABVUE, although confidential filings will not be made available for public viewing. *See* TBMP § 108, TBMP § 120.02 and TBMP § 121.

An opposition against an application based on Trademark Act § 66(a), 15 U.S.C. § 1141f(a), must be filed electronically through ESTTA. [Note 4.] ESTTA requires the opposer of a § 66(a) application to provide information essential to the opposition in order to allow the USPTO to meet promptly its notification obligation to the World Intellectual Property Organization ("WIPO").Such essential information includes: 1) the specific goods and/or services in the application which are being opposed; 2) the ground(s) for the opposition; and 3) the application or registration number(s) for any mark owned by opposer and cited as a basis for the opposition. [Note 5.] Only the information provided on the ESTTA form is sent to WIPO. [Note 6.]

With oppositions to applications that have other filing bases and with petitions to cancel, in the rare circumstances that they are filed on paper, (accompanied by a Petition to the Director and the required fee), they need not follow a particular format, but must meet the requirements of 37 CFR § 2.126(b) for paper submissions and include the necessary information.

The complaint (which in ESTTA is the attachment) should include the following information:

Heading: The complaint should bear at its top the heading "IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD."

Identification of subject application or registration: The heading should be followed by information identifying the application or registration that is the subject of the complaint with the wording "Serial No._____" for an opposition or "Registration No._____" for a petition to cancel.

Name of proceeding: The application or registration number should be followed by the name of the proceeding (i.e., "ABC Corporation v. XYZ Company") and the wording "Opposition No. _____" or "Cancellation No. _____."

Title of Paper: The title should describe the nature of the paper (i.e., "Notice of Opposition" or "Petition to Cancel").

Plaintiff information: 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.

Registrant information in petition to cancel:A petition to cancel should indicate the name and correspondence address and the current email address(es) of the current owner of record of the registration. [Note 7.] To determine the correspondence address of the owner of the registration, the petitioner may consult the Office's Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. [Note 8.] The TSDR display of information includes a tab for "status," a tab for "documents" and a link to "View Assignments." The petitioner may consult the assignments database to determine whether the registration has been assigned. If the registration has been assigned, and the assignment has been recorded, the assignee is considered the owner of record and the complaint should name the assignee as defendant in the proceeding. *See* TBMP § 309.02(c)(2). Plaintiffs are encouraged to provide information about a new

owner, which may not be in the Office's TSDR database, even if there is a domestic representative. [Note 9.] Also, plaintiffs are encouraged to provide current contact information for attorneys, or in the case of registrations under § 66(a) of the Act, current contact information for the designated representative for the international registration, which may not be in the Office's TSDR database. [Note 10.] Providing such information facilitates the Board's location and service of the proper parties in order to avoid defaults that may subsequently be set aside and thus prolong the process. [Note 11.]

Substance of complaint: The complaint must also include a pleading of the substance (i.e., standing and grounds) of the complaint. *See* TBMP § 309.03.

Signature: The complaint must be signed and include a description of the capacity in which the signing individual signs, e.g., attorney for plaintiff, plaintiff (if plaintiff is an individual), partner of plaintiff (if plaintiff is a partnership), officer of plaintiff identified by title (if plaintiff is a corporation), etc. *See* TBMP § 309.02(b).

NOTES:

1. 37 CFR § 2.101(b)(1); 37 CFR § 2.111(c)(1); 37 CFR § 2.126(a).

2. 37 CFR § 2.101(b)(2) and 37 CFR § 2.111(c)(2).

3. *See PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) ("Since ESTTA's inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board"). *See also CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1961-62 (TTAB 2011); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) ("[T]he ESTTA generated filing form … is considered part of the plaintiff's initial pleading"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) (The ESTTA cover sheet is considered part of the complete opposition pleading).

4. 37 CFR § 2.101(b)(3).

5. *See Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011).

6. *See CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1960 (TTAB 2011).

7. *See* 37 CFR § 2.112(a). *See also Informix Software Inc. v. Oracle Corp.*, 40 USPQ2d 1153, 1155 (N.D. Cal. 1996) (the proper defendant in suit for cancellation of a registration is the owner of that registration, not an exclusive licensee).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

10. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

11. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

309.02(b) Signature of Complaint

The complaint need not be verified, but it must be signed by the plaintiff or by the plaintiff's attorney, as specified in 37 CFR § 11.1, or other authorized representative, as specified in 37 CFR § 11.14(b). [Note 1.] *See* TBMP § 106.02 and TBMP § 114.06. Electronic signatures pursuant to 37 CFR § 2.193(c) are required for complaints submitted electronically via ESTTA. [Note 2.] The Board views the electronic signature on the ESTTA filing form as pertaining to all attachments thereto. [Note 3.] Thus, a plaintiff's electronic signature on the ESTTA filing form serves as its signature for the entire complaint being filed, including in the absence of a signature on any attachment to the filing form. [Note 4.]

If an attorney signs the complaint, it need not be accompanied by a written power of attorney, but if a written power of attorney is filed, the plaintiff must sign it. 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 or improperly signed complaint will not be refused consideration for that reason if a signed copy is submitted to the Board within the time limit set in the notification of this defect by the Board. [Note 5.] *See* TBMP § 106.02.

However, Trademark Act § 14, 15 U.S.C. § 1064, limits, after a specified five-year period, the grounds on which certain Principal Register registrations may be cancelled. [Note 6.] *See* TBMP § 307.02(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. [Note 7.] *Cf.* TBMP § 308.02(b). Although whenever it comes to the Board's attention, 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. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.101(b) and 37 CFR § 2.111(b). *See also Media Online Inc. v. El Clasificado, Inc.*, 88 USPQ2d 1285, 1286 n.3 (TTAB 2008). *Cf. Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905 (TTAB 2014) (signatory not authorized under Trademark Rules, Board applies opportunity to cure provision in § 2.119(e) to improperly signed papers).

2. *See* 37 CFR § 2.101(b) and 37 CFR § 2.111(b).

3. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1927 (TTAB 2005) ("Since ESTTA's inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single

document or paper being filed with the Board"). *See also CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1961-62 (TTAB 2011); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) ("[T]he ESTTA generated filing form … is considered part of the plaintiff's initial pleading"); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) (The ESTTA cover sheet is considered part of the complete opposition pleading).

4. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005).

5. *See* 37 CFR § 2.119(e); *Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905 (TTAB 2014) (signatory not authorized under Trademark Rules, Board applies opportunity to cure provision in § 2.119(e) to improperly signed papers).

6. *See* Trademark Act § 14, 15 U.S.C. § 1064; 37 CFR § 2.111(b).

7. *Cf. e.g.*, cases involving former requirement for verification, *Williamson-Dickie Manufacturing Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (the filing date of a petition to cancel is the date of receipt in the USPTO of the verified petition and filing fee); *Texas Instruments Inc. v. Conklin Instrument Corp.*, 161 USPQ 740, 741 (TTAB 1969) (unverified petition timely filed but ineffective; verified substitute petition untimely). *Cf. also In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (timely payment of filing fee for statement of use is statutory and cannot be waived).

8. *Cf. In re Holland American Wafer Co.*, 737 F.2d 1015, 222 USPQ 273, 275 (Fed. Cir. 1984) (regarding rejection of renewal application); *In re L.R. Sport Inc.*, 25 USPQ2d 1533, 1534 (Comm'r 1992) (regarding rejection of statement of use); and *In re Application Papers Filed November 12, 1965*, 152 USPQ 194, 195 (Comm'r 1966) (regarding insufficient filing fee for patent application).

309.02(c) Service of Complaint

A Board proceeding commences when an opposer or petitioner files its complaint with the Board, together with the required fee. [Note 1.]

Service of the complaint is provided by the Board in conjunction with the notice of institution. [Note 2.]

For information on service of the opposition on applicant, *see* TBMP § 309.02(c)(1). For information on service of the petition to cancel on respondent, *see* TBMP § 309.02(c)(2). For information on service of copies of an application for concurrent use registration, *see* TBMP § 1106.04.

NOTES:

1. *See* 37 CFR § 2.101(a) and 37 CFR § 2.111(a).

2. *See* 37 CFR § 2.105(a) and 37 CFR § 2.113(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) ("[T]he notice of institution constitutes service and will include a web link or web address to access the electronic proceeding Record.").

309.02(c)(1) Service of Opposition on Applicant

37 CFR § 2.105 ***Notification to parties of opposition proceeding(s).***

(a) *When an opposition in proper form (see §§ 2.101 and 2.104) has been filed with the correct fee(s), and the opposition has been determined to be timely and complete, the Trademark Trial and Appeal Board shall prepare a notice of institution, which shall identify the proceeding as an opposition, number of the proceeding, and the application(s) involved; and the notice shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service of the notice of opposition to the applicant.*

37 CFR § 2.101(e) *The filing date of an opposition is the date of electronic receipt in the Office of the notice of opposition, and required fee. In the rare instances that filing by paper is permitted under these rules, the filing date will be determined in accordance with §§ 2.195 through 2.198.*

37 CFR § 2.119 ***Service and signing.***

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, … must be served upon the other party or parties.*

An opposition proceeding is commenced by filing in the Office a timely notice of opposition with the required fee. [Note 1.]

When an opposer files its notice of opposition with the Board, the opposition, including any exhibits, need not be served by the opposer on the defendant. Rather, the Board effects service of the complaint on the defendant. The Board provides notice to the defendant of the opposition proceeding by providing, in the notice of institution, a web link or web address to access the electronic proceeding record, and this constitutes service of the notice of opposition. [Note 2.] Applicants will receive notification of the Board proceeding by email if Applicant authorized email communication with the Office. [Note 3.]

As a reminder, 37 CFR § 2.18(b)(1) requires applicants and parties to proceedings to promptly notify the Office of any change in physical address or email address. In addition, parties are reminded of the importance of maintaining correct and current email address information with the Office and taking steps to ensure that Office emails are not blocked by servers or spam filters, or diverted to junk mail folders.

The filing date of the notice of opposition is the date of electronic receipt in the Office of the notice and the required fee. [Note 4.] However, in the rare circumstance that a notice of opposition is filed on paper, and the paper filing is permitted by the Director, on petition, if the notice of opposition is filed by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service (USPS) in accordance with 37 CFR § 2.198, then the filing date is the date the notice of opposition was deposited with the USPS [Note 5], unless the "date in" date cannot be determined, in which case the date the notice is received in the Office is considered the filing date of the opposition. [Note 6.] The Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Priority Mail Express® procedure described in 37 CFR § 2.198 are available for the filing of a notice of opposition on paper. [Note 7.] Facsimile transmission of the notice of opposition is not permitted, and if submitted, will not be accorded a date of receipt. [Note 8.]

For information on filing fees *see* TBMP § 308. For information on the service of other filings submitted to the Board, *see* TBMP § 110.03 and TBMP § 113.01.

NOTES:

1. 37 CFR § 2.101(a).

2. 37 CFR § 2.105(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) ("[T]he notice of institution constitutes service and will include a web link or web address to access the electronic proceeding Record.").

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

4. *See* 37 CFR § 2.101(e).

5. *See* 37 CFR § 2.198(a)(1).

6. *See* 37 CFR § 2.198(a)(2).

7. *See* 37 CFR § 2.197(a) and 37 CFR § 2.198(a).

8. 37 CFR § 2.195(d)(3); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (untimely opposition dismissed as a nullity).

309.02(c)(2) Service of Petition on Respondent

37 CFR § 2.111 ***Filing petition for cancellation.***

(a) *A cancellation proceeding is commenced by filing in the Office a timely petition for cancellation with the required fee.*

37 CFR § 2.113 ***Notification of cancellation proceeding.***

(a) *When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.*

37 CFR § 2.119 ***Service and signing.***

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, … must be served upon the other party or parties.*

* * * *

A cancellation proceeding is commenced by filing in the Office a timely petition to cancel with the required fee. [Note 1.]

When petitioner files its petition to cancel with the Board, the petitioner need not serve a copy of the petition on the owner of record for the registration at the owner's address of record in the Office. Rather, the Board effects service of the complaint on defendant in a cancellation proceeding. The Board provides notice to the

defendant of the cancellation proceeding by providing, in the notice of institution, a web address to access the electronic proceeding record, and this constitutes service of the petition to cancel. [Note 2.] Presently, in cancellation proceedings, the Board will serve defendants by U.S. mail, pending system enhancements to facilitate email service at a later date. [Note 3.]

Please Note: With respect to a registered extension of protection under Trademark Act § 66(a), 15 U.S.C. § 1141f, while the Board will effect service on the owner of the registration, *see* 37 CFR. § 2.113(b), the Board will endeavor to forward a courtesy copy of the notice to the international registration holder's designated representative which will include a web link or web address to access the electronic proceeding record. [Note 4.]

As a reminder, 37 CFR § 2.18(b)(1) requires registrants and parties to proceedings to promptly notify the Office of any change in physical address or email address. In addition, parties are reminded of the importance of maintaining correct and current email address information with the Office and taking steps to ensure that Office emails are not blocked by servers or spam filters, or diverted to junk mail folders.

The filing date of the petition is the date of electronic receipt in the Office of the petition and the required fee. [Note 5.] However, in the rare circumstance that a petition to cancel is filed on paper and the paper filing is permitted by the Director on petition, if the petition is filed by the "Priority Mail Express® Post Office to Addressee" service of the United States Postal Service ("USPS") in accordance with 37 CFR § 2.198, then the filing date is the date the petition to cancel was deposited with the USPS, [Note 6], unless the "date in" date cannot be determined, in which case the date the petition is received in the Office is considered the filing date of the petition to cancel. [Note 7.] The Certificate of Mailing procedure described in 37 CFR § 2.197 and the "Priority Mail Express®" procedure described in 37 CFR § 2.198 are available for the filing of a petition to cancel. [Note 8.]

For information on filing fees, see TBMP § 308. For information on the service of other filings submitted to the Board, see TBMP § 110.03 and TBMP § 113.01.

NOTES:

1. *See* 37 CFR § 2.111(a).

2. *See* 37 CFR § 2.113(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) ("[T]he notice of institution constitutes service and will include a web link or web address to access the electronic proceeding record.").

3. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016).

4. *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

5. 37 CFR § 2.111 (e).

6. *See* 37 CFR § 2.198(a)(1).

7. *See* 37 CFR § 2.198(a)(2).

8. *See* 37 CFR § 2.197(a) and 37 CFR § 2.198(a).

309.03 Substance of Complaint

15 U.S.C. § 1068 ***[Trademark Act § 18]*** *In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part. ...*

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 § 2.101(b) *Any person who believes that he, she or it would be damaged by the registration of a mark on the Principal Register may filed an opposition addressed to the Trademark Trial and Appeal Board.*

* * * *

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

* * * *

37 CFR § 2.111(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of the registration in whole or in part.*

* * * *

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

* * * *

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.*

309.03(a) In General

309.03(a)(1) Scope of Opposition and Petition to Cancel

In an opposition, the registration sought by an applicant may be opposed in whole, or in part. Similarly, a petitioner may seek to cancel a registration in whole, or in part. [Note 1.] *See* TBMP § 309.03(d). However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. [Note 2.] *See* TBMP Chapter 1100.

An opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a), application must be filed through ESTTA. Because ESTTA requires the opposer of a § 66(a) application to provide information essential to the opposition in order to allow the USPTO to meet promptly its notification obligation to the World

Intellectual Property Organization ("WIPO"), the scope of the goods and services being opposed are limited to those identified in the ESTTA-generated cover sheet. [Note 3.] For the same reason, and because only the information on the ESTTA-generated cover sheet is forwarded to WIPO automatically without review, the grounds for a notice of opposition are limited to those selected and reflected on the ESTTA-generated cover sheet regardless of what any accompanying notice of opposition asserts. [Note 4.]

The Board is an administrative tribunal that 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.

NOTES:

1. *See* Trademark Act § 18, 15 U.S.C. § 1068.

2. *See* 37 CFR § 2.99(h) and 37 CFR § 2.133(c).

3. 37 CFR § 2.104(c). *See Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011) ("… with respect to Section 66(a) applications, all oppositions must be confined to the opposed goods identified … on the ESTTA-generated opposition forms."); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016).

4. 37 CFR § 2.104(c); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011). *See also Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014) (ESTTA form controls scope of permissible amendments to claims against § 66(a) application, because opposer did not limit grounds to any particular class on ESTTA form, opposer may seek leave to amend the attached pleading to assert those grounds against all three classes even though original attached pleading did not); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016).

309.03(a)(2) Elements of Complaint – In General

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 TBMP § 309.03(b)), and (2) a short and plain statement of one or more grounds for opposition. [Note 1.]

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 TBMP § 309.03(b)) and (2) a short and plain statement of the ground(s) for cancellation. [Note 2.]

A pleading should include enough detail to give the defendant fair notice of the basis for each claim. [Note 3.] The elements of each claim should be stated simply, concisely, and directly, and taken together "state a claim to relief that is plausible on its face." [Note 4.] *See* TBMP § 503.02.

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. [Note 5.] 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. [Note 6.] 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. [Note 7.]

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 alternatively or hypothetically, either in one count or in separate counts. [Note 8.]

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. [Note 9.]

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. [Note 10.]

Factual allegations made in the pleadings are not evidence of the matters alleged except insofar as they might be deemed to be admissions against interest. [Note 11.]

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 justice. [Note 12.]

For a discussion of the grounds for opposition and cancellation, *see* TBMP § 309.03(c) and 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:13 et. seq. and §§ 20:52 et. seq. (2017), for oppositions and cancellations, respectively. For a discussion of the grounds upon which a Principal Register registration over five years old may be cancelled, *see* TBMP § 307.01 and TBMP § 307.02 and 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 20:55 et. seq. (2017).

NOTES:

1. *See* 37 CFR § 2.104(a); *Young v. AGB Corp.* 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) (standing and grounds are distinct inquiries; allegation of "economic damage" while relevant to standing does not constitute a ground); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 753 (TTAB 1985); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 156 (TTAB 1985) (allegation of priority without direct or hypothetical pleading of likelihood of confusion is insufficient pleading of Trademark Act § 2(d), 15 U.S.C. § 1052(d)). *Cf.* Fed. R. Civ. P. 8(a).

2. *See* 37 CFR § 2.112(a); *Person's Co. v. Christman*, 900 F.2d 1565, 14 USPQ2d 1477, 1479 (Fed. Cir. 1990); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1019 (Fed. Cir. 1984); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982); *Kelly Services Inc. v. Greene's Temporaries Inc.*, 25 USPQ2d 1460, 1464 (TTAB 1992); *American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992). *Cf.* Fed. R. Civ. P. 8(a).

3. *See Johnson v. City of Shelby*, 574 U.S. ___, 135 S. Ct. 346, 347 (2014) (per curiam) (plaintiff's "[h]aving informed the city of the factual basis for their complaint, they were required to do no more to stave off threshold dismissal for want of an adequate statement of their claim"); *Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007). *See also Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1562 (TTAB 2011) (opposer's assertion of use on "their related components" in connection

with "lighting control panels and electrical light dimmers" provided fair notice to applicant of the scope of opposer's asserted goods at common law); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should be stated concisely and directly, and include enough detail to give the defendant fair notice); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1471 (TTAB 1993), *recon. denied*, 36 USPQ2d 1328, 1330 (TTAB 1994) (although pleading need not allege particular "magic words," pleading of mere descriptiveness in this case could not be logically interpreted as asserting that applicant is not the owner of the mark); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 48 (TTAB 1985) (petitioner's Trademark Act § 2(a), 15 U.S.C. § 1052(a) allegations were merely conclusory and unsupported by factual averments).

4. *Johnson v. City of Shelby*, 574 U.S. ___, 135 S. Ct. 346, 347 (2014) (per curiam) (plaintiff's "[h]aving informed the city of the factual basis for their complaint, they were required to do no more to stave off threshold dismissal for want of an adequate statement of their claim"); *Ashcroft v. Iqbal*, 556 U.S. 662 (2009), *quoting Bell Atlantic Corp. v. Twombly*, 550 U.S. 554, 570 (2007); Fed. R. Civ. P. 8(a). *See also* 5 C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 1219 (4th ed. 2017) ("The federal rules effectively abolish the restrictive theory of the pleadings doctrine, making it clear that it is unnecessary to set out a legal theory for the plaintiff's claim for relief.").

5. *See* Fed. R. Civ. P. 10(b); *Isle of Aloe, Inc. v. Aloe Creme Laboratories, Inc.*, 180 USPQ 794, 794 (TTAB 1974) (while paragraphs were numbered, none of the paragraphs were limited to a statement of a single set of circumstances).

6. *See* Fed. R. Civ. P. 10(b); *Wise F&I, LLC v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1107 n.9 (2016) (where opposer set forth a single set of broad allegations regarding pleaded marks and registrations, Board directed opposer, if amended notices of opposition were filed, to set forth each pleaded mark and registration in a separate paragraph so that Applicant could separately admit or deny the allegations with respect to each mark and registration); *O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) ("claims must be separately stated . . . . We will not parse an asserted ground to see if any of the elements that go to pleading that ground would independently state a separate ground;" motion to amend application filed under Madrid Protocol denied).

7. *See* Fed. R. Civ. P. 10(b) and (c).

8. *See* Fed. R. Civ. P. 8(d)(2) and (3); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the examining attorney). *See also Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before examining attorney that its / mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as basis for standing).

9. *See* Fed. R. Civ. P. 8(d)(2).

10. *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1571 (TTAB 1988) (if evidentiary facts are pleaded, and they aid in giving a full understanding of the complaint as a whole, they need not be stricken).

11. *See Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1755 (TTAB 2009) (allegations in defendant's application are not facts and must be proven at trial); *Baseball America Inc. v. Powerplay Sports, Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004) (factual allegations made in the pleadings are not evidence of the matters alleged, except insofar as they might be deemed to be admissions against interest). *Cf. Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (opposer's attempt to make registrations of record by attaching to its notice of opposition printouts from the Office's electronic database records showing the current status and title of its registrations would have been sufficient under current version of 37 CFR § 2.122(d)(1)).

12. *See* 37 CFR § 2.116(a); Fed. R. Civ. P. 8(e); *The Scotch Whiskey Association v. United States Distilled Products Co.*, 952 F.2d 1317, 21 USPQ2d 1145, 1147 (Fed. Cir. 1991); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1874 (TTAB 2011).

309.03(b) Standing

Any person who believes it is or will be damaged by registration of a mark has standing to file a complaint. [Note 1.] *See* TBMP § 303. At the pleading stage, all that is required is that a plaintiff allege facts sufficient to show a "real interest" in the proceeding, and a "reasonable basis" for its belief that it would suffer some kind of damage if the mark is registered. [Note 2.] *See also* TBMP § 303.06 regarding pleading of standing by joint plaintiffs. To plead a "real interest," plaintiff must allege a "direct and personal stake" in the outcome of the proceeding. [Note 3.]The allegations in support of plaintiff's belief of damage must have a reasonable basis "in fact." [Note 4.]

Allegations in support of standing which may be sufficient for pleading purposes must later be affirmatively proved by the plaintiff at trial (or on summary judgment). [Note 5.] However, there is no requirement that actual damage be pleaded or proved, or that plaintiff show a personal interest in the proceeding different or "beyond that of the general public" [Note 6], in order to establish standing or to prevail in an opposition or cancellation proceeding. *See* TBMP § 303.03.

A real interest in the proceeding and a reasonable belief of damage may be found, for example, where plaintiff pleads (and later proves):

A claim of likelihood of confusion that is not wholly without merit [Note 7], including claims based upon current ownership of a valid and subsisting registration [Note 8] or prior use of a confusingly similar mark. [Note 9.] A registration on the Supplemental Register may be sufficient to establish standing [Note 10];

Plaintiff has been refused registration of its mark because of defendant's registration, or has been advised that it will be refused registration when defendant's application matures into a registration, or has a reasonable belief that registration of its application will be refused because of defendant's registration [Note 11];

Plaintiff has a bona fide intent to use the same mark for related goods, and is about to file an intent-to-use application to register the mark, and believes registration of the mark will be refused in view of defendant's registration [Note 12];

Plaintiff belongs to class of potential purchasers it alleges are disparaged or brought into contempt or disrepute by defendant's mark [Note 13];

Defendant has relied on its ownership of its application or registration in another proceeding between the parties, or defendant has asserted a likelihood of confusion in another proceeding between the parties involving the same marks. [Note 14.]

A counterclaimant's standing to cancel a pleaded registration is inherent in its position as defendant in the original proceeding. [Note 15.] *See also* TBMP § 313.03.

A plaintiff need not assert proprietary rights in a term in order to have standing. [Note 16.] For example, when descriptiveness or genericness of the mark is in issue, plaintiff may plead (and later prove) its standing by alleging that it is engaged in the sale of the same or related products or services (or that the product or service in question is within the normal expansion of plaintiff's business) and that the plaintiff has an interest in using the term descriptively in its business. (That is, plaintiff may plead that it is a competitor.) [Note 17.]

If a plaintiff can show standing on one ground, it has the right to assert any other grounds in an opposition or cancellation proceeding. [Note 18.]

NOTES:

1. *See* Trademark Act § 13 and Trademark Act § 14, 15 U.S.C. § 1063 and 15 U.S.C. § 1064.

2. *Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982). *See also Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1377 (Fed. Cir. 2002); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987) *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) (trade association has standing to maintain opposition); *International Order of Job's Daughters v. Lindeburg and Co.*, 727 F.2d 1087, 220 USPQ 1017, 1020 (Fed. Cir. 1984); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1876 (TTAB 2011) (allegations that term is an appellation of origin for Cuban cigars owned by plaintiff and that plaintiff will be damaged by continued registration of designation is sufficient to allege plaintiff's real interest in the case for standing); *Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1548 (TTAB 2011) (in view of arguable similarities in the marks and relatedness of the goods, opposer has shown a reasonable belief of damage and that it has a real interest in the case); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1543 n.10 (TTAB2009) (plaintiff does not have to prove claims or actual damage to establish standing); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 n.8 (TTAB 2009) (licensees have standing to oppose); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (standing based on parties' agreement); *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (standing based on showing of commercial interest in the mark); *Association pour la Defense et la Promotion de L'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1841 (TTAB 2007) (standing established where (1) individual named in the mark died in 1985, (2) representative is the granddaughter of the named individual and one of the heirs, (3) representative is a member of the petitioner committee and the purpose of the committee is to defend the rights and the work of the named individual, and (4) petitioners claim that the mark at issue falsely suggests a connection with the named individual).

Cf. NSM Resources Corp. v. Microsoft Corp., 113 USPQ2d 1029, 1033 (TTAB 2013) ("The fact that the word 'Huck' may be used in respondent's written materials that happen also to bear respondent's registered mark [XBOX 360], a mark not remotely similar to the word 'Huck,' does not establish a basis upon which to allege standing to cancel the registration of the subject mark."); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1782-83 (TTAB 2010) (even assuming petitioner has a "real interest" and "personal stake" in taking photographs of goats on a roof, there is no allegation that respondent's mark prevents petitioner from doing so or how his interest in taking such photographs relates to respondent's services).

3. *Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014); *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d1023, 1026 (Fed. Cir. 1999). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875-76 (TTAB 2011) (Cuban entity has sufficiently alleged standing where claims do not require assertion of a property interest, a specific license to cancel the registration was issued by the U.S. State Department to plaintiff, and standing may be rooted in enforceable rights despite the existence of an embargo); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1790 (TTAB 2008) (Cuban entity has standing although it does not and cannot engage in any business in the United States due to the embargo on Cuban goods).

4. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d1023, 1027 (Fed. Cir. 1999) (stating that the belief of damage alleged by plaintiff must be more than a subjective belief) (citing *Universal Oil Products v. Rexall Drug & Chemical Co.*, 463 F.2d 1122, 174 USPQ 458, 459-60 (CCPA 1972)). *See also Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1783 (TTAB 2010) (petitioner's alleged belief that he would be damaged by respondent's registrations is not reasonable).

5. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d1023, 1029 (Fed. Cir. 1999) citing *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982)). *See also, e.g., Stephen Slesinger Inc. v. Disney Enterprises Inc.*, 98 USPQ2d 1890, 1895 n.15 (TTAB 2011) (no standing in Board proceeding where district court decided plaintiff lacked an ownership interest in the marks), *aff'd*, 702 F.3d 640, 105 USPQ2d 1472 (Fed. Cir. 2012), *cert den.* 134 S. Ct. 125 (2013); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 (TTAB 2007) (opposer established valid ground for grant of summary judgment in its favor; opposer allowed time to prove its standing); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (failure to prove standing); and *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600, 1605 (TTAB 1999) (at final decision, inquiry is not whether pleading of standing is sufficient but whether allegations have been proven).

6. *See Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1027(Fed. Cir. 1999) ("The crux of the matter is not how many others share one's belief that one will be damaged by the registration, but whether that belief is reasonable and reflects a real interest in the issue"). *See also Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); and *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Blackhorse v. Pro-Football, Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011) (no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in the proceeding); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007) (plaintiff has shown that it is not a mere intermeddler).

7. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 217 USPQ 641, 648 (Fed. Cir. 1983); *Lipton Industries Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *Otto Roth & Co. v. Universal Foods Corp.*, 640 F.2d 1317, 209 USPQ 40, 44 (CCPA 1981) (plaintiff may show standing based on common law rights in mark that is distinctive, inherently or otherwise); *Bausch & Lomb Incorporated v. Karl Storz*

GmbH & Co KG, 87 USPQ2d 1526, 1530 (TTAB 2008) (standing established by introduction of parties' agreement); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (standing established by properly making pleaded registrations of record); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1576 (TTAB 2008) (standing based on ownership of prior registration not voided by allegation, even if true, that mark is generic); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1502 (TTAB 2008) (standing established by testimony as to prior use); *Schering-Plough HealthCare Products Inc. v. Ing-Jing Huang*, 84 USPQ2d 1323, 1324 (TTAB 2007) (standing based on ownership of pleaded registrations); *Chicago Bears Football Club Inc. v. 12TH Man/Tennessee LLC*, 83 USPQ2d 1073, 1075 (TTAB 2007) (exclusive licensee has standing); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (standing based on common law use of mark); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1285 (TTAB 2007) (standing established by properly making pleaded registration of record and asserting non-frivolous likelihood of confusion claim); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1964 (TTAB 2007) (cancellation petitioner's standing based on prior common law use of elements contained in defendant's registered marks); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1848 (TTAB 2004); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); *Metromedia Steakhouses, Inc. v. Pondco II Inc.*, 28 USPQ2d 1205, 1209 (TTAB 1993); *The Nestle Co. Inc. v. Nash-Finch Co.*, 4 USPQ2d 1085, 1087 (TTAB 1987); *Liberty Trouser Co. v. Liberty & Co.*, 222 USPQ 357, 358 (TTAB 1983) (allegation of likelihood of confusion accepted as proper allegation of petitioner's standing with respect to pleaded grounds of fraud and abandonment).

8. *See Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842, 1844 (Fed. Cir. 2000); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974) (prior registration but not priority in use); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (pleaded registrations of record); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1712 (TTAB 2011) (standing established because pleaded registrations are of record on a motion for involuntary dismissal); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (pleaded registrations of record); *SmithKline Beecham Corp. v. Omnisource DDS LLS*, 97 USPQ2d 1300, 1301 (TTAB 2010) (pleaded registrations made of record); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1754 (TTAB 2009) (pleaded registration made of record); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1849 (TTAB 2008) (pleaded registrations properly made of record); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (pleaded registration made of record); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008) (standing established by making of record copies of its pleaded registrations showing the current status of the registrations and their ownership in opposer); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1721 (TTAB 2008) (opposer alleged ownership of application that issued during proceeding and introduced a certified copy of subsequent registration at trial showing current status and title in opposer's name); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393, 1396 (TTAB 2007) (pleaded registrations made of record); *Sinclair Oil Corp. v. Kendrick*, 85 USPQ2d 1032, 1037 n.10 (TTAB 2007) (opposer's allegations of ownership of pleaded registrations insufficient to prove standing); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (pleaded registrations made of record; cancelled registration has no probative value); *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1565 (TTAB 2007) (pleaded registrations made of record); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (pleaded registrations made of record); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1505 (TTAB 2007) (pleaded registrations made of record); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1337 (TTAB 2006) (parties stipulated to status and title of opposer's pleaded registrations and applications); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006) (pleaded registration of record by virtue of the counterclaim brought by applicant); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005); *Knight*

Textile Corp. v. Jones Investment Co., 75 USPQ2d 1313, 1315 (TTAB 2005) (status and title copies of pleaded registrations made of record).

9. *See First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc.*, 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (intrastate use by foreign opposer); *Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1395 (TTAB 2016) (opposer's trade name use; admissions by applicant that opposer is direct competitor); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1565 (TTAB 2011) (prior use established by testimony and conceded by applicant); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1118 n.8 (TTAB 2009) (use of mark established by testimony sufficient to show reasonable belief of damage even though use "purportedly based on a license which has not been clearly established in evidence"); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1022 (TTAB 2009) (standing established by showing of common law rights); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008) (prior use); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (past use and present licensing); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007) (prior use).

10. *See Otter Products LLC v. BaseOneLabs LLC*, 105 USPQ2d 1252, 1254 (TTAB 2012) (opposer's Supplemental Registration sufficient to establish opposer's real interest in proceeding).

11. *See Empresa Cubana del Tabaco v. General Cigar Co.*, 111 USPQ2d 1058, 1062 (Fed. Cir. 2014) (plaintiff's application refused based on defendant's registrations); *Saddlesprings Inc. v Mad Croc Brands Inc.*, 104 USPQ2d 1948, 1950 (TTAB 2012) (standing adequately alleged by allegation that petitioner's intent-to-use application has been refused based on respondent's registrations); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036, 1041 (TTAB 2012) (evidence of record showing petitioner's pending application refused registration based on respondent's registration); *Kallamni v. Khan*, 101 USPQ2d 1864, 1865 (TTAB 2012) (evidence of record showing petitioner's pending application refused registration based on respondent's registration); *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142 (TTAB 2011) (Office action refusing registration to plaintiff based on defendant's registration made of record); *Weatherford/Lamb Inc. v. C&J Energy Services Inc.*, 96 USPQ2d 1834, 1837 (TTAB 2010) (Office action suspending plaintiff's pending application pending possible refusal based on alleged likelihood of confusion with defendant's registration made of record); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1400 (TTAB 2009); *Hiraga v. Arena*, 90 USPQ2d 1102, 1106-7 (TTAB 2009); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Corporacion Habanos S.A. v. Guantanamera Cigars, Co.*, 86 USPQ2d 1473, 1475 (TTAB 2008) (opposer received permission from the U.S. Dept. of Treasury to file an application and such application is suspended); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1237 (TTAB 2007); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1914 (TTAB 2007); *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons, Inc.*, 55 USPQ2d 1298, 1300 (TTAB 2000); *Hartwell Co. v. Shane*, 17 USPQ2d 1569, 1570 (TTAB 1990). *Cf. Giersch v. Scripps Networks*, 90 USPQ2d 1020, 1022 (TTAB 2009) (pending application must be properly introduced, and the fact that it was refused pending outcome of proceeding must be documented, before Board will rely upon application in determining plaintiff's standing).

12. *See American Vitamin Products Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992).

13. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1024 (Fed. Cir. 1999); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. denied*,552 U.S. 1109 (2008).

14. *See Tonka Corp. v. Tonka Tools, Inc.*, 229 USPQ 857, 859 (TTAB 1986) (petitioner has standing to cancel registration that has been asserted, even defensively, in a civil action); and *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984).

15. *See Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1428 (TTAB 2014) ("Applicant has standing based on opposers' assertion of their marks and registrations against applicant in their notice of opposition."); *Delaware Quarries, Inc. v. PlayCore IP Sub, Inc.*, 108 USPQ2d 1331, 1332 (TTAB 2013) (standing assessed at time the counterclaim is filed and Board's dismissal of the main claim does not render counterclaim moot); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1881 (TTAB 1990); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987); *General Mills, Inc. v. Nature's Way Products*, 202 USPQ 840, 841 (TTAB 1979) (counterclaimant's position as defendant in the opposition gives him a personal stake in the controversy). *Cf. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1236 n.3 (TTAB 2007) (respondent in a cancellation proceeding has standing by virtue of its ownership of involved registration).

16. *See International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1496 (Fed. Cir. 2000); *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 USPQ2d 1301, 1302 (Fed. Cir. 1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988) ("This is true irrespective of the grounds upon which the opposer relies in asserting the nonregistrability of applicant's mark").

17. *See Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*,823 F.2d 490, 2 USPQ2d 2021, 2024 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *Otto Roth & Co. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); *Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1951-52 (TTAB 2014) (opposer established it is a manufacturer of the same or related goods as applicant and applicant did not contest opposer's standing), *vacated on other grounds and remanded*, 786 F.3d 960, 114 USPQ2d 1827 (Fed. Cir. 2015); *Alcatraz Media Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1760-61 (TTAB 2013) (petitioner established and respondent admitted that petitioner is a competitor using the term at issue as part of its domain name), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014), (mem.); *Miller v. Miller*, 105 USPQ2d 1615, 1618-19 (TTAB 2013) (opposer established it has a commercial interest in using MILLER LAW GROUP); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1876 (TTAB 2011) (promoter or manufacturer of goods labeled with the same indication of geographic origin where plaintiff does not have a pending application, is not using the term in the United States, and is not required to being using the term at all); *Kistner Concrete Products Inc. v. Contech Arch Technologies, Inc.*, 97 USPQ2d 1912, 1918 (TTAB 2011) (competitor in industry has a real interest in cancelling registration for product configuration); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, 1553 (TTAB 2009) (competitors and retailer of the goods in the applications have demonstrated a real interest in preventing registration of the proposed marks); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1787 (TTAB 2008) (primarily geographically deceptively misdescriptive and deceptive claims); *Saint-Gobain Corp. v. 3M Co.*, 90 USPQ2d 1425, 1428 (TTAB 2007) (standing to oppose registration of mark for single color for coated abrasives established by opposer's evidence of use of various colors on coated abrasives); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1679 (TTAB 2007) (standing based on opposer's privity relationship with company that has competitive right to use mark descriptively); *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1767 (TTAB 2007) (commercial interest in allegedly descriptive term); *Plyboo America Inc. v. Smith & Fong Co.*, 51 USPQ2d 1633, 1634 (TTAB

1999) (standing where opposer a competitor in the industry, a direct competitor of applicant, and one who used the mark at issue on or in connection with its product); *Binney & Smith Inc. v. Magic Marker Industries, Inc.*, 222 USPQ 1003, 1010 (TTAB 1984). *Cf. Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1244 n.10 (TTAB 2007) (defense of unclean hands, even if established, does not deprive petitioner of standing).

18. *See Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1877 (TTAB 2011) (because petitioners alleged standing as to at least one ground, primarily geographically deceptively misdescriptive, they may assert any other legally sufficient claims including those under Section 2(a), the Pan American Convention and fraud); *Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009), *citing Liberty Trouser Co. v. Liberty & Co., Ltd.*, 222 USPQ 357, 358 (TTAB 1983).

309.03(c) Grounds

In addition to standing, a plaintiff must also plead (and later prove) a statutory ground or grounds for opposition or cancellation. [Note 1.] *See* TBMP § 303.06 regarding pleading of grounds by joint plaintiffs. A plaintiff may raise any available statutory ground for opposition or cancellation that negates the defendant's right to registration. [Note 2.] *See* TBMP § 102.01 and cases cited therein. Grounds for petitions to cancel a Principal Register registration that is more than 5 years old are more limited and are specified in Trademark Act § 14(3) and Trademark Act § 14(5), 15 U.S.C. § 1064(3) and 15 U.S.C. § 1064(5). *See* TBMP § 307.01.

In pleading the grounds for opposition or cancellation, citation to a section of the statute, although encouraged and often helpful in clarifying the nature of a set of allegations in a pleading, may not be sufficient to plead a claim under that section or place a defendant on proper notice of the extent of the claim. For example, although the Trademark Act provides that dilution under Trademark Act § 43(c), 15 U.S.C. § 1125 may be asserted as a claim in a Board proceeding, mere reference to that section of the Trademark Act is insufficient to plead a dilution claim, as proper pleading of the claim also requires an allegation that the plaintiff's mark was famous prior to the earliest date on which the defendant can rely for purposes of priority. [Note 3.]

A plaintiff cannot rely upon an unpleaded claim unless the plaintiff's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter. [Note 4.] *See also* TBMP § 314. In cases brought under Trademark Act § 2(d), 15 U.S.C. § 1052(d) the plaintiff must specifically plead any registrations on which it is relying and may not rely at trial on unpleaded registrations. [Note 5.] For information regarding express or implied consent to the trial of an unpleaded issue, *see* TBMP § 507.03(b).

Electronic filing through ESTTA requires an opposer or petitioner to select relevant grounds for opposition or cancellation, with the required accompanying statement supporting and explaining the grounds. *See* 37 CFR § 2.104(a) and 37 CFR § 2.112(a).

Examples of available grounds for opposition and for cancellation are listed below. **Please Note:** The grounds identified in examples (2) (as to *de jure* functional marks), (3), (12) through (14), (17), and (21) are available for cancellation of a Principal Register registration over five years old. This list is exemplary, not exhaustive.

(1) Trademark Act § 2(d), 15 U.S.C. § 1052(d): That defendant's mark so resembles a mark registered in the 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 or services of the defendant, to cause confusion, or to cause mistake, or to deceive. [Note 6.]

(2) Trademark Act § 2(e), 15 U.S.C. § 1052(e): For example, that defendant's mark, when used on or in connection with the goods or services of the defendant, is merely descriptive or deceptively misdescriptive of them, [Note 7] or that defendant's mark is primarily geographically descriptive [Note 8] or primarily geographically deceptively misdescriptive of them [Note 9]; or that defendant's mark is primarily merely

a surname [Note 10]; or that defendant's mark comprises any matter that, as a whole, is functional. [Note 11.]

(3) Trademark Act § 2(a),15 U.S.C. § 1052(a): For example, that defendant's mark is geographically deceptive, [Note 12] that defendant's mark disparages members of a particular group, [Note 13] that defendant's mark consists of or comprises immoral, deceptive, or scandalous matter, [Note 14] that defendant's mark falsely suggests a connection with plaintiff's name or identity [Note 15], or that defendant's mark is a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and was first used on or in connection with wines or spirits by the applicant on or after January 1, 1996. [Note 16.]

(4) That there was no bona fide use of defendant's mark in commerce prior to the filing of the use-based application for its registration under Trademark Act § 1(a), 15 U.S.C. § 1051(a). [Note 17.]

(5) That defendant did not have a bona fide intent to use the mark in connection with the identified goods/services as of the filing date of the application under Trademark Act § 1(b), 15 U.S.C. § 1051(b). [Note 18.] A plaintiff need not allege and prove that the defendant acted in bad faith and intended to deceive the USPTO. The requirements for pleading and proving a lack of a bona fide intent to use a mark do not equate to the requirements for pleading and proving fraud. [Note 19.]

(6) That defendant's mark is a mere background design that does not function as a mark separate and apart from the words displayed thereon. [Note 20.]

(7) That defendant is not (and was not, at the time of the filing of its application for registration) the rightful owner of the registered mark. [Note 21.]

(8) That defendant'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 defendant's goods, [Note 22], that defendant's mark, consisting of a particular sound applied to its goods, is not inherently distinctive and has not acquired distinctiveness, or that defendant's mark, consisting of trade dress, product design or packaging, is not inherently distinctive and has not acquired distinctiveness. [Note 23.]

(9) That the term for which registration is sought or for which registration has been obtained has not been used as a trademark or service mark. [Note 24.]

(10) That defendant's mark represents multiple marks in a single application (or registration) ("phantom mark"). [Note 25.]

(11) That defendant's mark has been abandoned due to nonuse with intent not to resume use, and nonuse for three consecutive years shall be prima facie evidence of abandonment, [Note 26]; or due to a course of conduct that has caused the mark to lose significance as an indication of source. [Note 27.]

(12) That defendant's mark consists of or comprises the name of a particular living individual without the individual's consent. Trademark Act § 2(c), 15 U.S.C. § 1052(c). [Note 28.]

(13) That defendant's product design is generic. [Note 29.]

(14) That defendant's mark would dilute the distinctive quality of plaintiff's famous mark. [Note 30.]

(15) That defendant has used its mark so as to misrepresent the source of its goods or services. [Note 31.]

(16) That defendant has misused the federal registration symbol with intent to deceive the purchasing public or others in the trade into believing that the mark is registered. [Note 32.]

(17) That defendant committed fraud in the procurement of its registration or during the prosecution of its application for registration. [Note 33.]

(18) That defendant's registered mark interferes with the registration of a foreign owner's mark under Article 8 of the General Inter-American Convention for Trademark and Commercial Protection of Washington, 1929 ("Pan American Convention"), 46 Stat. 2907. [Note 34.]

(19) That defendant's application is barred from registration by claim or issue preclusion. [Note 35.] *See also* TBMP § 311.02(b).

(20) That defendant's mark is the title of a single creative work and not considered a trademark. [Note 36.]

(21) Trademark Act § 2(b), 15 U.S.C. § 1052(b): Registration of a mark which is "the flag or coat of arms or other insignia of the United States, or of any State or municipality" is prohibited. [Note 37.]

(22) That defendant has not established a commercial presence in the country from which its underlying foreign registration issued where such foreign registration forms the basis of the U.S. registration or application for registration. Trademark Act § 44(e); 15 U.S.C. § 1126(e). [Note 38.]

(23) That the intent-to-use application was assigned or transferred in contravention of Trademark Act § 10; 15 U.S.C. § 1060. [Note 39.]

(24) That the mark is generic. [Note 40.] A mark registered on the Supplemental Register is subject to cancellation on the basis that it is generic. [Note 41.]

(25) That the mark is not in lawful use in commerce where the provision of the identified goods and/or services is unlawful under federal law. [Note 42.]

The following is a brief discussion of the elements of a claim of likelihood of confusion, the most frequently encountered issue in Board inter partes proceedings.

Pursuant to Trademark Act § 2(d), 15 U.S.C. § 1052(d), plaintiff must assert, and then prove at trial, that defendant's mark, as applied to its goods or services, so resembles plaintiff's previously used or registered mark or its previously used trade name as to be likely to cause confusion, mistake, or deception.

NOTES:

1. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998). *See also Enbridge, Inc. v. Excelerate Energy LP*, 92 USPQ2d 1537, 1543 n.10 (TTAB 2009) (if plaintiff can show standing on one ground, has right to assert any other grounds); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1396 n.1 (TTAB 2009) (grounds for opposition not pursued at trial or otherwise argued by opposer in its brief deemed waived).

2. *See Young v. AGB Corp.*, 152 F.3d 1377, 47 USPQ2d 1752, 1754 (Fed. Cir. 1998); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021, 2023 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB 1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628 (Fed. Cir. 1988); *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 189 (CCPA 1982); *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (Board does not have authority to determine whether a party has engaged in criminal or civil wrongdoings), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008); *Flash & Partners S.p.A. v. I.E. Manufacturing LLC*, 95 USPQ2d 1813 (TTAB 2010) (ex parte examination issues do not form a basis for cancellation); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1586 (TTAB 2008); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (parties' agreement prohibits applicant's use of its mark); *Carano v. Vina Concha y Toro S.A.*, 67 USPQ2d 1149, 1152 (TTAB 2003) (Board has no jurisdiction to determine copyright infringement claim but may determine some limited copyright issues as necessary to determine questions of trademark registration); *Capital Speakers Inc. v. Capital Speakers Club of Washington D.C. Inc.*, 41 USPQ2d 1030, 1034 n.3 (TTAB 1996) (Board lacks authority to determine claim that Congress may not lawfully regulate registrant's activities); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1386 (TTAB 1991); *Marmark Ltd. v. Nutrexpa S.A.*, 12 USPQ2d 1843,

1844 (TTAB 1989); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 910 n.10 (TTAB 1984) (Board cannot decline to consider an issue because it is ex parte in nature).

Cf. Young v. AGB Corp., 152 F.3d 1377, 47 USPQ2d 1752, 1755 (Fed. Cir. 1998) ("economic damage" is not a ground for opposition although it is relevant to issue of opposer's standing); *Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587, 1591 (TTAB 2009) (Paris Convention does not provide independent cause of action); *on final decision*, 110 USPQ2d 1623 (TTAB 2014), *aff'd in part and rev'd in part on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), *vacated and remanded* 819 F.3d 697 (4th Cir. 2016) (affirming TTAB); *Franpovi SA v. Wessin*, 89 USPQ2d 1637, 1640 (TTAB 2009) (potential plaintiff cannot exercise rights established by Santiago Convention because it cannot fulfill condition of application to the Inter American Bureau as set forth in Convention); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (asserted error by examining attorney is not a proper ground for opposition); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.3 (TTAB 2006) (Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPs") does not provide separate cause of action or defense); *Saint-Gobain Abrasives Inc. v. Unova Industrial Automation Systems Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (whether description of the mark is adequate is an examination issue and fails to state a proper ground for opposition); *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1157-58 (TTAB 2003) (no authority for assertion of unclean hands as a ground for opposition); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (laches and acquiescence are affirmative defenses, not grounds for opposition); *Phonak Holding AG v. ReSound GmbH*, 56 USPQ2d 1057, 1059 (TTAB 2000) (opposer's failure to submit copy of the foreign registration, which was the basis for issuance of opposer's pleaded registration, was an examination error and did not constitute a ground for counterclaim); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358 (TTAB 1989) (the insufficiency of the specimens, per se, does not constitute grounds for cancellation; the proper ground for cancellation is that the term has not been used as a mark); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989) ("it is not the adequacy of the specimens, but the underlying question of service mark usage which would constitute a proper ground for opposition").

3. *See* Trademark Act § 43(c), 15 U.S.C. § 1125(c); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1292 (TTAB 2016) (party alleging fame must show that mark became famous prior to any established, continuous use of defendant's involved mark as a trademark or tradename, and not merely prior to use in association with the specific goods or services set forth in a defendant's subject application or registration); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) (party alleging fame must show that mark became famous before applicant's use of challenged mark), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-1060 (TTAB 2008) (dilution claim in pleading must include an allegation that opposer's mark at issue is famous); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application); *Toro Co. v. ToroHead, Inc.*, 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798, 1800 (TTAB 2000) (must allege when mark became famous).

4. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007).

5. *See, e.g., United Global Media Grp., Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014) ("When an opposer pleads ownership of the underlying applications in the notice of opposition, the opposer may make the registrations which issue during the opposition of record without having to amend the notice of

opposition to assert reliance on the registrations"); *Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1424 n.14 (TTAB 2014) (opposer may not rely on registrations that were unpleaded, the underlying applications were unpleaded and opposer did not assert that the pleadings should be amended); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1503 (TTAB 2007) ("In its brief, opposer listed a seventh registration, but it was not pleaded and a copy was not made of record by notice of reliance (NOR) or through testimony, so it has not been considered"); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1919-20 (TTAB 2006). *Cf. Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1583 n.3 (TTAB 2008) ("The notice of reliance also includes status and title copies of several registrations which were not pleaded in the notice of opposition. Because applicant has not objected to opposer's reliance on the unpleaded registrations, and moreover has, in effect, treated them as of record in his brief, we deem opposer's pleading amended to assert the registrations under Fed. R. Civ. P. 15(b)").

6. *See, e.g., Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004); *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003); *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002).

See also First Niagara Insurance Brokers Inc. v. First Niagara Financial Group Inc., 476 F.3d 867, 81 USPQ2d 1375, 1378 (Fed. Cir. 2007) (claim of prior intrastate use); *Primrose Ret. Cmtys., LLC v. Edward Rose Senior Living, LLC*, 122 USPQ2d 1030, 1040 (TTAB 2016) (dismissing opposition; third party evidence demonstrates weakness of mark); *Wise F&I, LLC; et al. v. Allstate Ins. Co.*, 120 USPQ2d 1103, 1109 (TTAB 2016) (family of marks may have different owners if there is unity of control); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009) (doctrine of foreign equivalents inapplicable but likelihood of confusion found); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) (earliest date respondent may rely upon is the filing date of its underlying application in absence of evidence of earlier use; petitioner must show earlier common law use in absence of registration); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008) (dissimilarity of marks controlling issue in likelihood of confusion analysis); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393 (TTAB 2007); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1959 (TTAB 2008) (although opposer failed to make its registrations of record, its burden is to demonstrate that it owns a trademark, which was used prior to applicant's mark, and not abandoned); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1490 (TTAB 2007) (family of marks); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007) (determination of likelihood of confusion based on an analysis of all facts in evidence); *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1565 (TTAB 2007) (several factors considered); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624 (TTAB 2007)(design marks compared); *Miss Universe L.P., v. Community Marketing, Inc.*, 82 USPQ2d 1562, 1566 (TTAB 2007) ("Our likelihood of confusion determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue (the *du Pont* factors)"); and *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1113 (TTAB 2007) (doubt resolved in favor of prior user).

7. *See* Trademark Act § 2(e)(1), 15 U.S.C. § 1052 (e)(1). *See also, e.g., The Hoover Co. v. Royal Appliance Manufacturing Co.*, 238 F.3d 1357, 57 USPQ2d 1720, 1722-23 (Fed. Cir. 2001) (deceptive misdescriptiveness) and *Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1922-23 (TTAB 2002) (mere descriptiveness).

Regarding claims under Trademark Act § 2(f), 15 U.S.C. § 1052(f), see *Cold War Museum Inc. v. Cold War Air Museum Inc.*, 586 F.3d 1352, 92 USPQ2d 1626, 1629 (Fed. Cir. 2009) (in cancellation proceeding,

presumption of validity of registration under Trademark Act § 2(f) includes presumption of acquired distinctiveness, and party seeking cancellation must overcome this presumption by preponderance of evidence; "burden" to prove that mark has acquired distinctiveness shifts to registrant only after plaintiff establishes prima facie case that mark has not acquired distinctiveness); *Yamaha International Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 6 USPQ2d 1001, 1005 (Fed. Cir. 1988) (in opposing a claim under Trademark Act § 2(f), opposer has initial burden of challenging or rebutting applicant's evidence of distinctiveness) *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc.*, 107 USPQ2d 1750, 1764-1767 (TTAB 2013) (burden on petitioner to rebut presumption that mark registered under Section 2(f) has acquired distinctiveness), *aff'd* , 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Target Brands Inc. v. Hughes*, 85 USPQ2d 1676, 1680 (TTAB 2007) (ultimate burden of persuasion under Trademark Act § 2(f) rests with applicant); *Kellogg Co. v. General Mills Inc.*, 82 USPQ2d 1766, 1768 (TTAB 2007) (mere descriptiveness; whether claim under Trademark Act § 2(f) is sufficient).

8. *See* Trademark Act § 2(e)(2), 15 U.S.C. § 1052 (e)(2). *See also, e.g.*, *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1504 (TTAB 2008) (whether mark is descriptive and/or primarily geographically descriptive, applicant has shown acquired distinctiveness); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385 (TTAB 1994). *Cf. Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1524-25 (TTAB 2013) (assertion that a registration is not entitled to Section 15 incontestability because of alleged fraud in obtaining and maintaining the registration does not state a valid ground for cancellation of a registration that is more than five years old on the basis that the registered mark is primarily geographically descriptive).

9. *See* Trademark Act § 2(e)(3), 15 U.S.C. § 1052 (e)(3). *See also In re California Innovations, Inc.*, 329 F.3d 1334, 66 USPQ2d 1853 (Fed. Cir. 2003) (the test for determining whether a mark is geographically deceptive under Trademark Act § 2(a), 15 U.S.C. § 1052(a) is the same as determining whether a mark is primarily geographically deceptively misdescriptive under Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3)); *In re Save Venice New York, Inc.*, 259 F.3d 1346, 59 USPQ2d 1778, 1781-82 (Fed. Cir. 2001) (describing § 2(e)(3) analysis); *Corporacion Habanos SA v. Guantanamera Cigars Co.*, 102 USPQ2d 1085, 1090-91 (TTAB 2012) (reopened for the limited purpose of having the parties address whether a significant portion of the relevant consumers would be materially influenced to purchase the goods by the geographic meaning of the mark), *on remand from*, 729 F. Supp. 2d 246, 98 USPQ2d 1078 (D.D.C. 2010) (remanding on third factor of the test for determining whether a mark is primarily geographically deceptively misdescriptive); *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1876 (TTAB 2011) (primarily geographically deceptively misdescriptive sufficiently pled); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640, 1642 (TTAB 2011) (mark would be perceived as a misspelling of geographic location and found primarily geographically deceptively misdescriptive for the goods); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1790-91 (TTAB 2008) (primarily geographically deceptively misdescriptive and deceptive claims); *United States Playing Card Co., v. Harbro, LLC*, 81 USPQ2d 1537, 1541 (TTAB 2006) (addressing deceptiveness of a geographic term); *In re Wada*, 48 USPQ2d 1689, 1690-91 (TTAB 1998), *aff'd*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999).

10. *See* Trademark Act § 2(e)(4), 15 U.S.C. § 1052 (e)(4). *See also, e.g., In re Integrated Embedded*, 120 USPQ2d 1504, 1516 (TTAB 2016); *In re Eximius Coffee*, LLC, 120 USPQ2d 1276, 1283 (TTAB 2016); *In re Adlon Brand Gmbh & Co. KG*, 120 USPQ2d 1717, 1725 (TTAB 2016); *Michael S. Sachs Inc. v. Cordon Art B.V.*, 56 USPQ2d 1132, 1136 (TTAB 2000); *Allied Mills, Inc. v. Kal Kan Foods, Inc.*, 203 USPQ 390, 391-92 (TTAB 1979); *Food Specialty Co. v. Carnation Co.*, 170 USPQ 522, 523 (TTAB 1971). *Cf. In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174, 1174-75 (Fed. Cir. 2005) ("Section 44 applications are subject to the section 2 bars to registration, of which the surname rule is one."); *In re Piano Factory Group Inc.*, 85 USPQ2d 1522, 1526-27 (TTAB 2007) (surname plus "& SONS" refused as "primarily a surname").

11. *See* Trademark Act § 2(e)(5), 15 U.S.C. § 1052 (e)(5); *TrafFix Devices Inc. v. Marketing Displays Inc.*, 532 U.S. 23, 58 USPQ2d 1001, 1006 (2001); *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161, 1165(1995). *See also, e.g., In re Becton, Dickinson and Co.*, 675 F.3d 1368, 102 USPQ2d 1372, 1377 (Fed. Cir. 2012) and *Valu Engineering Inc. v. Rexnord Corp.*, 278 F.3d 1268, 61 USPQ2d 1422, 1426 (Fed. Cir. 2002), citing *In re Morton-Norwich Products Inc.*, 671 F.2d 1332, 213 USPQ 9, 15-16 (CCPA) for factors considered in determining functionality; *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d 1829, 1833 (TTAB 2013) (overall design of product configuration dictated by utilitarian concerns and as a whole is functional); *In re Florists' Transworld Delivery Inc.*, 106 USPQ2d 1784 (TTAB 2013) (color black aesthetically functional for packaging for flowers); *Doyle v. Al Johnson's Swedish Restaurant & Butik Inc.*, 101 USPQ2d 1780, 1783-84 (TTAB 2012) (petitioner failed to relate claim of functionality of goats on a roof to respondent's restaurant and gift shop services); *Kistner Concrete Products Inc. v. Contech Arch Technologies Inc.*, 97 USPQ2d 1912, 1918-19 (TTAB 2011) (registration on Supplemental Register for a precast concrete bridge unit); and *M-5 Steel Manufacturing Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (product design for roof vents). *Cf. ERBE Elektromedizin GmbH v. Canady Technology LLC*, 629 F.3d 1278, 97 USPQ2d 1048, 1056-58 (Fed. Cir. 2010) (same legal principles apply to a determination of functionality whether on the Principal Register or Supplemental Register); *Duramax Marine, LLC v. R.W. Fernstrum & Co.*, 80 USPQ2d 1780, 1794 (TTAB 2006) (prohibition on the registration of functional marks does not extend to registration of two-dimensional design mark for custom manufacturing services).

12. *See, e.g,., Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 USPQ2d 1894, 1898 (TTAB 1992) (mark's geographic deceptiveness must be established as of the time the registration issues). *Cf. Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785, 1790 (TTAB 2008) (Board declines to consider geographically deceptive claim under Trademark Act § 2(a), 15 U.S.C. § 1052(a)); *United States Playing Card Co., v. Harbro, LLC*, 81 USPQ2d 1537, 1541 (TTAB 2006) (addressing deceptiveness of a geographic term under the ambit of Trademark Act § 2(e)(3), 15 U.S.C. § 1052(e)(3) rather than Trademark Act § 2(a), 15 U.S.C. § 1052(a) ("The amended Lanham Act gives geographically deceptively misdescriptive marks the same treatment as geographically deceptive marks under § 1052(a).") (citing *In re California Innovations Inc.*, 329 F.3d 1334, 66 USPQ2d 1853, 1856 (Fed. Cir. 2003)); *K-Swiss Inc. v. Swiss Army Brands Inc.*, 58 USPQ2d 1540, 1543 (TTAB 2001) (can be cancelled if a registrant, through its own actions, causes its mark to become geographically deceptive subsequent to the issuance of the registration).

13. *See, e.g., Blackhorse v. Pro-Football, Inc.*, 111 USPQ2d 1080 (TTAB 2014) (disparage Native Americans), *aff'd* 112 F.Supp. 3d 439, 115 USPQ2d 1524 (E.D. Va. 2015), *on appeal*, No. 15-1874 (4th Cir.); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (disparage religious affiliation); *In re Heeb Media, LLC*, 89 USPQ2d 1071 (TTAB 2008) (disparage religious affiliation); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (disparage professional baseball team); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006) (disparage Native Americans); *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212 (TTAB 2006); *aff'd unpub'd*,240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S.1109 (2008) (while individual male citizen sufficiently alleged a "real interest" in the proceedings, he failed to properly allege "belief of damage," as he does not inherently possess an immutable trait directly implicated by the mark or allege that others share his belief of damage); *Boswell v. Mavety Media Group Ltd.*, 52 USPQ2d 1600 (TTAB 1999) (women in general and African American women in particular); *Order Sons of Italy in America v. Memphis Mafia Inc.*, 52 USPQ2d 1364 (TTAB 1999) (members of plaintiff's Order and Italian-Americans in general); and *Harjo v. Pro-Football Inc.*, 50 USPQ2d 1705, 1740-48 (TTAB 1999), *rev'd*, 284 F. Supp. 2d 96, 125, 68 USPQ2d 1225, 1248 (D.D.C. 2003), *remanded*, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), and *aff'd*, 565 F.3d 880, 90 USPQ2d 1593 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009) (cancellation action brought by Native Americans on grounds of disparagement barred by laches).

Please Note: In December 2015, the Federal Circuit, in an en banc decision in *In re Tam*, 808 F.3d 1321, 117 USPQ2d 1001 (Fed. Cir. 2015) (en banc), held that the disparagement provision in § 2(a) is facially unconstitutional under the First Amendment. The U.S. Supreme Court granted a petition for certiorari to review the Federal Circuit's *Tam* decision and consider the constitutionality of the disparagement provision. Therefore, the TTAB has suspended action on all ex parte appeals and inter partes proceedings that present issues under the disparagement provision in § 2(a) with the following exception: complaining parties in inter partes proceedings are given the option to dismiss claims based on § 2(a) disparagement without prejudice and to obtain a decision on the merits of their remaining claims. Any suspension of a TTAB matter based on the disparagement provision of § 2(a) will remain in place until the U.S. Supreme Court issues a decision in *Tam*, after which the USPTO will re-evaluate the need for further suspension.

14. *See, e.g., In re Fox*, 702 F.3d 633, 639-40, 105 USPQ2d 1247, 1251-52 (Fed. Cir. 2012) (word mark that created a double entendre was unregistrable where a substantial composite of the general public would recognize that one meaning was vulgar); *In re Luxuria s.r.o.*, 100 USPQ2d 1146 (TTAB 2011) (design configuration of a bottle in the shape of a hand with the middle finger extended upwards found to be vulgar and thus unregistrable as scandalous or immoral); *Corporacion Habanos S.A. v. Anncas Inc.*, 88 USPQ2d 1785 (TTAB 2008) (deceptiveness); *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581, 1588 (TTAB 2008) (scandalous or immoral); *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 67 USPQ2d 1475 (Fed. Cir. 2003) (use of dictionary evidence to determine whether mark is scandalous); *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 31 USPQ2d 1923 (Fed. Cir. 1994) (analyzing scandalous in terms of "vulgarity"). *See also Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (standing to oppose on Trademark Act § 2(a),15 U.S.C. § 1052(a) scandalousness grounds); *In re South Park Cigar, Inc.*, 82 USPQ2d 1507 (TTAB 2007) (deception involving geographical mark); *In re Red Bull GmbH*, 78 USPQ2d 1375 (TTAB 2006) (scandalous mark); *In re Wilcher Corp.*, 40 USPQ2d 1929 (TTAB 1996) (design mark scandalous); *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1220 (TTAB 1993) (design mark not scandalous). *Cf. McDermott v. San Francisco Womens Motorcycle Contingent*, 81 USPQ2d 1212, 1214 (TTAB 2006), *aff'd unpub'd*, 240 Fed. Appx. 865 (Fed. Cir. 2007), *cert. denied*, 552 U.S. 1109 (2008) (authority of Trademark Act §2(a), 15 U.S.C. § 1052(a) does not extend to goods or services that may be viewed as scandalous or immoral in nature).

In December 2015, the Federal Circuit, in an en banc decision in *In re Tam*, 808 F.3d 1321, 117 USPQ2d 1001 (Fed. Cir. 2015) (en banc), held that the disparagement provision in § 2(a) is facially unconstitutional under the First Amendment. The U.S. Supreme Court granted a petition for certiorari to review the Federal Circuit's *Tam* decision and consider the constitutionality of the disparagement provision. Related cases which may be affected by the Court's decision include *In re Brunetti*, 2014 LEXIS 328 (TTAB Aug. 1, 2014) (non-precedential), on appeal to the Federal Circuit from the TTAB's affirmance of a § 2(a) refusal under the scandalousness provision. Therefore, the TTAB has suspended action on all ex parte appeals and inter partes proceedings that present issues under the scandalousness provision in § 2(a) with the following exception: complaining parties in inter partes proceedings are given the option to dismiss claims based on the § 2(a) scandalous provision without prejudice and to obtain a decision on the merits of their remaining claims. Any suspension of a TTAB matter based on the scandalousness provision of § 2(a) will remain in place until the Federal Circuit issues a decision in *Brunetti*, after which the USPTO will re-evaluate the need for further suspension.

15. *See, e.g., University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co. Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir.1983); *Boston Red Sox Baseball Club L.P. v. Sherman*, 88 USPQ2d 1581, 1593 (TTAB 2008); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996); *Greyhound Corp. v. Both Worlds Inc.*, 6 USPQ2d 1635 (TTAB 1988); *Buffett v. Chi Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). *See also Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 USPQ2d 1025, 1031-32 (TTAB

2015) (insufficiently pled claim where no assertion that public would recognize applicant's mark as pointing uniquely to opposer).

16. *See Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1899 (TTAB 2006) (certification mark recognized as a geographical indication). *Cf. In re Spirits International N.V.*, 86 USPQ2d 1078, 1080 n.2 (TTAB 2008) (refusal based on "deceptiveness" provision of Trademark Act § 2(a), 15 U.S.C. § 1052(a) and not that the mark is a geographical indication); *In re Wada*, 48 USPQ2d 1689, 1692 n.7 (TTAB 1998) (disclaimer of geographical indication cannot obviate a Trademark Act § 2(a), 15 U.S.C. § 1052(a) refusal).

17. *See, e.g., Lens.com Inc. v. 1-800 Contacts Inc.*, 686 F.3d 1376, 103 USPQ2d 1672, 1676-77 (Fed. Cir. 2012) (software that is merely a conduit through which online retail services are rendered is not "in use in commerce" in association with software); *International Mobile Machines Corp. v. International Telephone and Telegraph Corp.*, 800 F.2d 1118, 231 USPQ 142 (Fed. Cir. 1986); *Avakoff v. Southern Pacific Co.*, 765 F.2d 1097, 226 USPQ 435 (Fed. Cir. 1985); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1769 (TTAB 1994) ("use in commerce" involves the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark), *aff'd unpub'd*, 108 F.3d 1392 (Fed. Cir. 1997); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1929-30 (TTAB 2014) (claim of nonuse at time of filing for § 66(a) application legally insufficient for registration based on § 66(a) because time of nonuse begins from the date of registration); *Clorox Co. v. Salazar*, 108 USPQ2d 1083, 1086-87 (TTAB 2013) (applicant's mark not in use in commerce as of the filing date of the use-based application); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012) (respondent's mark not in use in commerce at time of filing of his use-based application); *Nutrasweet Co. v. K & S Foods Inc.*, 4 USPQ2d 1964 (TTAB 1987); *Pennwalt Corp. v. Sentry Chemical Co.*, 219 USPQ 542, 558 (TTAB 1983); *Bonaventure Associates v. Westin Hotel Co.*, 218 USPQ 537, 543 (TTAB 1983).

But see Christian Faith Fellowship Church v. Adidas AG, 841 F.3d 986, 120 USPQ2d 1640 (Fed. Cir. 2016) (reversing Board decision that respondent failed to use its mark in commerce prior to obtaining registration). *In re JobDiva, Inc.*, 843 F.3d 936, 121 USPQ2d 1122, 1126 (Fed. Cir. 2016) (vacating Board decision to the extent it applied a per se rule that use of mark for computer software services for personal placement services could not demonstrate use of mark for the service of personal placement and recruitment; and remanding case for further consideration in light of opinion).

Cf. Sinclair Oil Corp. v. Kendrick, 85 USPQ2d 1032, 1033 (TTAB 2007) (opposer's nonuse claim dismissed as moot upon Board's acceptance of applicant's amendment of the filing basis of its application from Trademark Act § 1(a) to 1(b), 15 U.S.C. § 1051(a) to (b)); *CarX Service Systems, Inc. v. Exxon Corp.*, 215 USPQ 345, 351 (TTAB 1982) (plaintiff must plead and prove that there was no use prior to filing date; mere claim that dates of use are incorrect does not state a claim of action).

18. *See, e.g., M.Z. Berger & Co. v Swatch AG*, 787 F.3d 1368, 114 USPQ2d 1892, 1897 (Fed. Cir. 2015) (lack of bona fide intent is a proper statutory grounds on which to challenge a trademark application), *affirming* 108 USPQ2d 1463, 1471-77 (TTAB 2013) (documentary evidence, testimony and other record evidence do not support applicant's claimed bona fide intent to use); *Kelly Servs., Inc. v. Creative Harbor, LLC*, 846 F.3d 857, 121 USPQ2d 1357, 1369-70 (6th Cir. 2017) (applying Board precedential decisions and affirming district court determination that applicant lacked a bona fide intent to use its mark as to some, but not all the goods listed in its applications, but vacating the judgment to the extent that applicant's applications were voided in their entirety); *Swiss Grill Ltd. v. Wolf Steel Ltd.*, 115 USPQ2d 2001, 2008-09 (TTAB 2015) (lack of bona fide intent to use found where no documentary evidence predated application filing date); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1443 (TTAB 2012) (lack of a bona fide intent to use found where there was no documentary evidence, affirmative statement that no documents exist, no industry experience, no development or business plan, vague allusions to using the mark through licensing

or outsourcing, and applicant's demonstrated pattern of filing intent-to-use applications for disparate goods under the well-know and famous marks of others); *Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1548-49 (TTAB 2011) (lack of a bona fide intent to use found where there was no documentary evidence, an affirmative statement that no such documents exist, and no other evidence to explain lack of documentary evidence); *SmithKline Beecham Corp. v. Omnisource DDS LLS*, 97 USPQ2d 1300, 1304-05 (TTAB 2010) (lack of a bona fide intent to use; no documentary evidence; record devoid of any other evidence of intended use); *Honda Motor Co. v. Friedrich Winkelmann*, 90 USPQ2d 1660 (TTAB 2009) (lack of bona fide intent to use); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581, 1587 (TTAB 2008) (lack of bona fide intent to use); *Lane Ltd. v. Jackson International Trading Co.*, 33 USPQ2d 1351, 1352 (TTAB 1994); *Commodore Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1504 (TTAB 1993).

Cf. Rolex Watch U.S.A. Inc. v. AFP Imaging Corp., 101 USPQ2d 1188, 1190 (TTAB 2011) (capacity to market and manufacture the goods, and identified goods consistent with a nature extension of current product line, rebut the lack of documentary evidence), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1643 (TTAB 2007) (capacity to market and /or manufacture goods, having produced them in the past under different marks, rebuts claim that applicant lacked bona fide intent to use).

19. *See SmithKline Beecham Corp. v. Omnisource DDS LLS*, 97 USPQ2d 1300, 1305 (TTAB 2010).

20. *See, e.g., In re Grande Cheese Co.*, 2 USPQ2d 1447, 1449 (TTAB 1986); *General Foods Corp. v. Ito Yokado Co.*, 219 USPQ 822, 825 (TTAB 1983), *aff'd unpub'd*, slip. op. 84-517 (Fed. Cir. 1984).

21. *See, e.g., Wonderbread 5 v. Gilles*, 115 USPQ2d 1296, 1304-07 (TTAB 2015) (facts inconsistent with individual former band member's claim that he was the owner the mark); *UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1249 (TTAB 2015) (presumption that a manufacturer is the owner of a disputed mark may be rebutted); *Conolty v. Conolty O'Connor NYC LLC*, 111 USPQ2d 1302 (TTAB 2014) (ownership claim determined under accelerated case resolution); *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257 (TTAB 2013); *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland Inc.*, 29 USPQ2d 1146 (TTAB 1993); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990); *Kemin Industries, Inc. v. Watkins Products, Inc.*, 192 USPQ 327, 328 (TTAB 1976). *Cf., e.g., Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464 (TTAB 1993) (where opposer was asserting that applicant's mark is a descriptive term which cannot be owned exclusively by anyone, rather than alleging that someone other than applicant is the owner of the term as a mark) *recon. den.*, 36 USPQ2d 1328 (TTAB 1994).

22. *See, e.g., Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 34 USPQ2d 1161 (1995); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008); *Brunswick Corp. v. British Seagull Ltd.*, 35 F.3d 1527, 32 USPQ2d 1120 (Fed. Cir.1994), *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116, 227 USPQ 417, (Fed.Cir.1985); *Goodyear Tire & Rubber Co. v. Vogue Tyre & Rubber Co.*, 47 USPQ2d 1748 (TTAB 1998); *Kassnar Imports v. Plastilite Corp.*, 180 USPQ 156, 157 (TTAB 1973), *aff'd*, 508 F.2d 824, 184 USPQ 348, 350 (CCPA 1975).

23. *See* Trademark Act § 1, Trademark Act § 2 and Trademark Act § 45, 15 U.S.C. § 1051, 15 U.S.C. § 1052 and 15 U.S.C. § 1127; *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393 (TTAB 2009)("chirp" sound). *Cf. In re Vertex Group LLC*, 89 USPQ2d 1694, 1700 (TTAB 2009) (registration on the Principal Register of the sound emitted by applicant's product in its normal course of operation only available on a showing of acquired distinctiveness).

For product design *see Wal-Mart Stores, Inc. v. Samara Brothers*, 529 U.S. 205, 54 USPQ2d 1065, 1069 (2000) (product design can never be inherently distinctive and requires showing of acquired distinctiveness); *AS Holdings, Inc. v. H & C Milcor, Inc.*, 107 USPQ2d at 1839 (product configuration of pipe boot design has not acquired distinctiveness); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549 (TTAB 2009) (product configuration).

For product packaging *see also Two Pesos Inc. v. Taco Cabana Inc.*, 505 US 763, 23 USPQ2d 1081 (1992) (trade dress packaging may be inherently distinctive); *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 USPQ2d 1681, 1684 (Fed. Cir. 2010) (court applies four-part test from *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342, 196 USPQ 289, 291 (CCPA 1977) to determine if trade dress packaging is inherently distinctive, or requires showing of acquired distinctiveness).

24. *See, e.g., D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1716 (TTAB 2016) (I DC fails to function as a mark); *Couture v. Playdom, Inc.*, 778 F.3d 1379, 113 USPQ2d 2012 (Fed. Cir. 2015) (service must be offered and actually provided to constitute use in commerce); *Aycock Engineering, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 USPQ2d 1301, 1309 n.12 (Fed. Cir. 2009) (registration on Supplemental Register never becomes immune from threat of invalidation on grounds that mark was not used prior to filing date); *Anheuser-Busch Inc. v. The Florists Association of Greater Cleveland, Inc.*, 29 USPQ2d 1146, 1160 (TTAB 1993) (allegation that slogan was used as mere advertising and not as a trademark); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355 (TTAB 1989).

25. *See, e.g., Cineplex Odeon Corp. v. Fred Wehrenberg Circuit of Theatres*, 56 USPQ2d 1538 (TTAB 2000). *See also In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 57 USPQ2d 1807, 1812-1813 (Fed. Cir. 2001); *In re International Flavors & Fragrances Inc.*, 47 USPQ2d 1314 (TTAB 1998), *aff'd*, 183 F.3d 1361, 51 USPQ2d 1513 (Fed. Cir. 1999).

26. Trademark Act § 45, 15 U.S.C. § 1127. *See, e.g., Linville v. Rivard*, 41 USPQ2d 1731 (TTAB 1996), *aff'd*, 133 F.3d 1446, 45 USPQ2d 1374 (Fed. Cir. 1998); *Imperial Tobacco Ltd. v. Philip Morris Inc.*, 899 F.2d 1575, 14 USPQ2d 1390 (Fed. Cir. 1990); *City National Bank v. OPGI Management GP Inc./Gestion OPGI Inc.*, 106 USPQ2d 1676-79 (TTAB 2013) (abandonment of a registration under Trademark Act § 44(e), 15 U.S.C. § 1126(e), based on over three years of nonuse where respondent did not use mark with recited services since at least the issuance date of the involved registration and where the nature of the use shown by respondent did not constitute use in commerce); *ShutEmDown Sports Inc. v. Lacy*, 102 USPQ2d 1036 (TTAB 2012) (more than three years of nonuse, commencing with filing date for majority of the identified goods, and no evidence rebutting prima facie showing); *Auburn Farms, Inc. v. McKee Foods Corp.*, 51 USPQ2d 1439 (TTAB 1998). *Cf. General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179 (TTAB 2008) (plaintiff could not prove priority because it abandoned mark with no intent to resume use prior to use by defendant); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (plaintiff must allege ultimate facts pertaining to the alleged abandonment).

See also Saddlesprings Inc. v Mad Croc Brands Inc., 104 USPQ2d 1948, 1550-52 (TTAB 2012) (claim of abandonment is available with respect to a claim against a § 66(a) registration, which is a registered extension of protection under 15 U.S.C. § 1141f(a)).

27. Trademark Act § 45, 15 U.S.C. § 1127. *See, e.g., Noble House Home Furnishings, LLC v. Floorco Enters., LLC*, 118 USPQ2d 1413, 1422 (TTAB 2016) (abandonment found where parent company's use of the mark cannot inure to the benefit of the subsidiary that owned the mark); *Jack Wolfskin Ausrustung Fur Draussen GmbH v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1133-34 (Fed. Cir. 2015) (no abandonment found where it was found that consumers would not view stylistic modifications as a different mark, resulting in the same continuing commercial impression), *cert. denied*, No. 15-660 (Jan.

25, 2016); *Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009) (failure to police third party use of marks); *Tea Board of India v. The Republic of Tea, Inc.*, 80 USPQ2d 1881 (TTAB 2006); *Woodstock's Enterprises Inc. v. Woodstock's Enterprises Inc.*, 43 USPQ2d 1440 (TTAB 1997), *aff'd mem.*, 152 F.3d 942 (Fed. Cir. Mar. 5, 1998).

28. *See* Trademark Act § 2(c), 15 U.S.C. § 1052(c). *See also Chester L. Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904, 1909 (TTAB 2005), *aff'd*, slip. op. 2007-1364 (Fed. Cir. Dec. 7, 2007); *Nike, Inc. v. Palm Beach Crossfit, Inc.*, 116 USPQ2d 1025, 1032-33 (TTAB 2015) (claim insufficiently pled where no assertion that licensing relationship gave opposer a proprietary right to assert the claim on behalf of third party); *Ross v. Analytical Technology, Inc.*, 51 USPQ2d 1269 (TTAB 1999) (plaintiff must establish that the "name," as used on the goods or services, points uniquely to plaintiff as a "particular living individual"); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 (TTAB 1994) (party asserting Trademark Act § 2(c), 15 U.S.C. § 1052(c) ground must have cognizable or proprietary right in the name). *Cf. Societe Civile Des Domaines Dourthe Freres v. S.A. Consortium Vinicole De Bordeaux Et De La Gironde*, 6 USPQ2d 1205, 1209 (TTAB 1988) (Trademark Act § 2(c), 15 U.S.C. § 1052(c) does not apply to family surnames).

29. *See Stuart Spector Designs, Ltd. v. Fender Musical Instruments Corp.*, 94 USPQ2d 1549, (TTAB 2009); *Sunrise Jewelry Manufacturing Corp. v. Fred, S.A.*, 175 F.3d 1322, 50 USPQ2d 1532, 1534 (Fed. Cir. 1999) (the term "generic name" as used in Trademark Act § 14(3), 15 U.S.C. § 1064(3) includes trade dress such as product design or configuration).

30. *See* Trademark Act § 13(a) and Trademark Act § 14, 15 U.S.C. § 1063(a) and 15 U.S.C. § 1064; *Toro Co. v. ToroHead Inc.*, 61 USPQ2d 1164 (TTAB 2001). *See also* Trademark Act § 43(c), 15 U.S.C. § 1125(c); *Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1297 (TTAB 2016) (party alleging dilution by blurring must prove that mark(s) became famous prior to any established, continuous use of Applicant's involved marks, whether as a trademark or trade name, and not just prior to Applicant's use in commerce of its challenged marks in connection with the goods identified in involved applications); *N.Y Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497, 1509-10 (TTAB 2015) (parody defense will not be considered as part of the assessment of a dilution claim; whether an applicant's mark is registrable because it is being used in commerce to indicate source is counter to whether such use is noncommercial or fair use); *McDonald's Corp. v. McSweet LLC*, 112 USPQ2d 1268, 1286 (TTAB 2014) (dilution also applies to family of marks); *Chanel, Inc. v. Makarczyk*, 110 USPQ2d 2013, 2023-24 (TTAB 2014) (dilution by blurring, opposer may rely on applicant's filing (constructive use) date to satisfy second prong of test); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187 (TTAB 2012) (full analysis of factors finding dilution by blurring); *Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1191-97 (TTAB 2011) (same), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013); *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1886-90 (TTAB 2011) (same); *Nike Inc. v. Maher*, 100 USPQ2d 1018 (TTAB 2011) (same); *National Pork Board and National Pork Producers Council v. Supreme Lobster and Seafood Co.*, 96 USPQ2d 1479 (TTAB 2010) (commodity promotion slogan dilution by blurring); *Coach Services, Inc. v. Triumph Learning LLC*; 96 USPQ2d 1600 (TTAB 2010) (dilution by blurring and tarnishment), *aff'd-in-part, rev'd-in-part and remanded on other grounds*, 668 F.3d 1356, 101 USPQ2d 1713 (Fed. Cir. 2012); *Citigroup Inc. v. Capital City Bank Group Inc.*, 94 USPQ2d 1645, 1649 (TTAB 2010) (party alleging fame must show that mark became famous before applicant's use of challenged mark), *aff'd*, 637 F.3d 1344, 98 USPQ2d 1253 (Fed. Cir. 2011); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1059-60 (TTAB 2008) (dilution claim in pleading must include an allegation that opposer's mark at issue is famous); *Moseley v. V Secret Catalogue Inc.*, 537 US 418, 65 USPQ2d 1801 (2003); *Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001) (dilution pleading legally insufficient where opposer failed to allege that its mark became famous before constructive use date of involved intent-to-use application); *Toro Co. v. ToroHead*,

Inc., 61 USPQ2d 1164, 1174 n.9 (TTAB 2001); *Polaris Industries Inc. v. DC Comics*, 59 USPQ2d 1798 (TTAB 2000); *Enterprise Rent-A-Car Co. v. Advantage Rent-A-Car, Inc.*, 62 USPQ2d 1857 (TTAB 2002), *aff'd*, 300 F.3d 1333, 66 USPQ2d 1811 (Fed. Cir. 2003). *But see Fiat Group Automobiles, S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1113 (TTAB 2010) (the "well known mark" doctrine does not constitute a basis for pleading dilution in the United States, absent a specific pleading of intent to use, the filing of an application for registration, and some basis for concluding that recognition of the mark in the United States is sufficiently widespread as to create an association of the mark with particular products or services, even if the source thereof is anonymous and even if the products or services are not available in the United States).

31. *See Bayer Consumer Care AG v. Belmora LLC*, 90 USPQ2d 1587 (TTAB 2009) (motion to dismiss misrepresentation of source claim denied), *on final decision*, 110 USPQ2d 1623 (TTAB 2014) (petition granted on claim of misrepresentation), *rev'd on other grounds*, 84 F. Supp. 3d 490 (E.D. Va. 2015), vacated and remanded 819 F.3d 697 (4th Cir. 2016) (affirming TTAB); *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1863 (TTAB 2007) (pleading of misrepresentation of source must be supported by allegations of blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation of petitioner); *The E.E. Dickinson Co. v. The T.N. Dickinson Co.*, 221 USPQ 713 (TTAB 1984) (petitioner allowed to go forward on claim of misrepresentation of source).

32. *See Copelands' Enterprises Inc. v. CNV Inc.*, 945 F.2d 1563, 20 USPQ2d 1295 (Fed. Cir. 1991); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1758 (TTAB 2009) (mistaken belief that registration of mark in foreign country permits use of symbol); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007) (allegation that opposer has misused federal registration symbol construed "as a species of the equitable affirmative defense of unclean hands"); *Johnson Controls, Inc. v. Concorde Battery Corp.*, 228 USPQ 39, 44 (TTAB 1985); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1846 n.3 (TTAB 2008). *Cf. Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976) (raised as affirmative defense).

33. *See* Fed. R. Civ. P. 9(b); *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Daniel J. Quirk, Inc. v. Village Car Co.*, 120 USPQ2d 1146 (TTAB 2016) (fraud claim based on statements made in application oath dismissed); *Nationstar Mortgage LLC v. Ahmad*, 112 USPQ2d 1361 (TTAB 2014) (claim of fraud sustained); *Dragon Bleu (SARL) v. VENM, LLC*, 112 USPQ2d 1925, 1928 (TTAB 2014) (failure to state a claim of fraud because statements were not false, not material and no allegation regarding intent, no leave to replead as would be futile); *Caymus Vineyards v. Caymus Medical Inc.*, 107 USPQ2d 1519, 1522-24 (TTAB 2013) (motion to dismiss denied where fraud claim sufficiently alleged); *DaimlerChrysler Corp. v. American Motors Corp.*, 94 USPQ2d 1086 (TTAB 2010) (summary judgment on fraud claim denied); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537 (TTAB 2009). *See also Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009) ("[P]leadings on information and belief require an allegation that the necessary information lies within the defendant's control, and … such allegations must also be accompanied by a statement of the facts upon which the allegations are based") (citing *Kowal v. MCI Communications Corp.*, 16 F.3d 1271, 1279 n.3 (D.C. Cir. 1994)); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986); *King Auto., Inc. v. Speedy Muffler King, Inc.*, 667 F.2d 1008, 212 USPQ 801, 803 (CCPA 1981) (fraud must be pleaded with particularity); *Smith International, Inc. v. Olin Corp.*, 209 USPQ 1033, 1044 (TTAB 1981) (fraud requires a willful intent to deceive); *G&W Laboratories Inc. v. GW Pharma Ltd.*, 89 USPQ2d 1571, 1574 (TTAB 2009) (a finding of fraud as to one class in a multiple-class registration does not require cancellation of all classes in a registration); *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1509 (TTAB 2008) (false claim of use of mark); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917 (TTAB 2006) (same).

Cf. Asian and Western Classics B.V. v. Selkow, 92 USPQ2d 1478 (TTAB 2009) (improperly pleaded fraud claim cannot be basis for summary judgment); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1762 (TTAB 2008) (timely proactive corrective action taken with respect to pleaded registrations raises rebuttable presumption that opposer did not intend to commit fraud); *University Games Corp. v. 20Q.net Inc.*, 87 USPQ2d 1465, 1468 (TTAB 2008) (rebuttable presumption that opposer lacked willful intent to deceive Office arises when registrant amended identification of goods during ex parte prosecution); *Tri-Star Marketing LLC v. Nino Franco Spumanti S.R.L.*, 84 USPQ2d 1912, 1916 (TTAB 2007) (fraud not found where statement identifying goods in application, although inartfully worded, was not false).

Please Note: The Federal Circuit's decision in *In re Bose*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009), clarified that fraud in a Board proceeding may not be based merely on a finding that a party "knew or should have known" that it was not using its mark on all of the goods or services recited in an application. Accordingly, consideration of the holdings in cases involving fraud in a goods/services use statement pre- *Bose* should be reviewed under the standard for fraud as set forth in *Bose* and cases following *Bose*, and not as set forth in the line of Board cases following the "knew or should have known" standard set forth in *Medinol Ltd. v. Neuro Vasx, Inc.*, 67 USPQ2d 1205 (TTAB 2003).

34. *See British-American Tobacco Co. v. Phillip Morris Inc.*, 55 USPQ2d 1585 (TTAB 2000). *Cf. Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1322 (TTAB 2007) (Board has subject matter jurisdiction to entertain affirmative defense of priority pursuant to Article 7 of the Pan American Convention).

35. *See Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310 (Fed. Cir. 2005) (opposition not barred by claim or issue preclusion); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854 (Fed. Cir. 2000) (claim preclusion doctrine did not bar petition to cancel); *Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1870 (TTAB 2016) (claim preclusion inapplicable because fraud claim based on different transactional facts, defendant's motion for summary judgment denied); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106 (TTAB 2011) (claim preclusion barred petitions to cancel against two registrations but not a third registration; "defendant preclusion" does not apply to facts of case and further discussed in contrast to "plaintiff preclusion"); *Nextel Communications Inc. v. Motorola Inc.*, 91 USPQ2d 1393, 1398 (TTAB 2009) (finding in prior Board proceeding that mark failed to function with respect to "two-way radios" entitled opposer to judgment with respect to those goods under principles of issue preclusion). *Cf. Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369 (Fed. Cir. 2008) (cancellation petition barred by doctrine of "defendant preclusion"); *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1863 (TTAB 2016) (issue preclusion may bar re-litigation of a standing determination made in a prior Board proceeding); *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1411-1413 (TTAB 2015) (claim preclusion bars cancellation proceeding in view of earlier opposition proceeding which was dismissed for failure of plaintiff to submit any evidence in support of its case; and where plaintiff in cancellation concedes it is same as plaintiff in opposition); *Stephen Slesinger Inc. v. Disney Enterprises Inc.*, 98 USPQ2d 1890 (TTAB 2011) (ownership of the marks at issue established in court proceeding; defendant entitled to summary judgment based on issue preclusion), *aff'd*, 702 F.3d 640, 105 USPQ2d 1472 (Fed. Cir. 2012), *cert denied*, 134 S. Ct. 125 (2013). *See also Zachry Infrastructure LLC v. American Infrastructure Inc.*, 101 USPQ2d 1249 (TTAB 2011) (no claim preclusion based on district court's determination because civil action focused on respective uses and rights to use while Board proceeding focused on right to registration; issue preclusion based on district court determination found; no claim preclusion based on abandonments in related opposition because trademark owner allowed to make decision on which oppositions to defend).

36. *See Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140, 1142-44 (TTAB 2011).

37. *See, e.g., In re City of Houston*, 101 USPQ2d 1534 (TTAB 2012), *aff'd* 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *In re District of Columbia*, 101 USPQ2d 1588 (TTAB 2012), *aff'd sub nom. In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013).

38. *Kallamni. v. Khan*, 101 USPQ2d 1864 (TTAB 2012).

39. *See Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ2d 1134, 1146-50 (TTAB 2013); *The Clorox Co. v. Chemical Bank*, 40 USPQ2d 1098 (TTAB 1996).

40. *See H. Marvin Ginn Corp. v. International Association of Fire Chiefs, Inc.*, 782 F.2d 987, 228 USPQ 528, 531-32 (Fed. Cir. 1986) (two-step determination of whether a term is generic involves 1) what is the genus of the goods or services at issue and 2) is the term understood by the relevant public primarily to refer to that genus). *Accord Princeton Vanguard, LLC v. Frito-Lay North America, Inc.*, 786 F.3d 960, 114 USPQ2d 1827, 1830-31 (Fed. Cir. 2015) (there is only one legal standard for genericness). *But see Luxco, Inc. v. Consejo Reglador del Tequila, A.C.*, 121 USPQ2d 1477, 1497 (TTAB 2017) (opposition dismissed for failure to prove that TEQUILA is generic for spirits distilled from agave plant).

41. *Turtle Wax, Inc. v. Blue Coral, Inc.*, 2 USPQ2d 1534, 1536 (TTAB 1987).

42. *In re JJ206, LLC*, 120 USPQ2d 1568, 1570 (TTAB 2016) (finding applicant's use and intended use of the applied for marks on marijuana vaporizers unlawful because the goods constitute illegal drug paraphernalia under the Controlled Substances Act).

A. Priority

A plaintiff must plead (and later prove) priority of use. [Note 43.] In order to properly assert priority, a plaintiff must allege facts showing proprietary rights in its pleaded mark that are prior to defendant's rights in the challenged mark. [Note 44.]Such rights may be shown by, for example, ownership of an application with a filing date (or a registration with an underlying application filing date) prior to any date of first use on which defendant can rely; [Note 45] prior trademark or service mark use; [Note 46] or prior use analogous to trademark or service mark use. [Note 47.]

However, priority is not in issue in an opposition where opposer pleads (and later proves) that it owns a registration for its pleaded mark, [Note 48] provided that there is no counterclaim or separate petition to cancel the pleaded registration, or any counterclaim or separate petition to cancel the pleaded registration by the applicant is ultimately dismissed and the registration remains uncancelled. [Note 49.]

A plaintiff may be permitted to assert the proprietary rights or registration(s) of a third-party as a basis for a Trademark Act § 2(d), 15 U.S.C. § 1052(d) ground if plaintiff can show a legitimate interest in preventing confusion between the pleaded mark(s) and the defendant's mark. [Note 50.]

NOTES:

43. Trademark Act § 2(d), 15 U.S.C. § 1052(d). *See West Florida Seafood, Inc., v. Jet Restaurants, Inc.*, 31 F.2d 1122, 31 USPQ2d 1660, 1663 (Fed. Cir. 1994) (in determining whether a party has established prior use, Board should look at the evidence as a whole); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1195 (TTAB 2012) (failure to prove priority at common law for goods not covered by pleaded registrations of record); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1960 (TTAB 2008) (failure to prove priority by preponderance of the evidence); *Media Online Inc.*

v. El Clasificado Inc., 88 USPQ2d 1285, 1287 (TTAB 2008) (respondent not precluded from moving for judgment on the pleadings on the issue of priority, despite its failure to assert priority as an affirmative defense, because priority is a required element of petitioner's Trademark Act § 2(d), 15 U.S.C. § 1052 claim); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007) (priority established by proof of prior use).

44. *See Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 USPQ2d 2021 (Fed. Cir. 1987), *on remand*, 5 USPQ2d 1622 (TTAB1987), *rev'd*, 853 F.2d 888, 7 USPQ2d 1628, 1632 (Fed. Cir. 1988); *Otto Roth & Co. v. Universal Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981); *Golomb v. Wadsworth*, 592 F.2d 1184, 201 USPQ 200, 201 (CCPA 1979); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (applicant may rely without further proof upon the filing date of its application as a "constructive use" date for purposes of priority); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1852 (TTAB 2008) (priority based on acquisition of acquired distinctiveness of merely descriptive mark); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1722 (TTAB 2008) (underlying application for registration predates filing date of applicant's application); *Media Online Inc. v. El Clasificado Inc.*, 88 USPQ2d 1285, 1288 (TTAB 2008) (respondent may rely on filing date of registration at issue as constructive date of first use, predating petitioner's claim of date of first use as verified in its petition); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1108 (TTAB 2007) (oral testimony, even of a single witness, if sufficiently probative, may be sufficient to prove priority); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1505 (TTAB 2007) (priority based on prior use and pleaded registrations); *L. & J.G. Stickley, Inc. v. Ronald C. Cosser*, 81 USPQ2d 1956 (TTAB 2007); *Fram Trak Industries Inc. v. WireTracks LLC*, 77 USPQ2d 2000, 2005 (TTAB 2006); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435 (TTAB 1996); *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549 (TTAB 1994); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216 (TTAB 1992); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134 (TTAB 1992) (priority of acquired distinctiveness); *Rolex Watch U.S.A., Inc. v. Madison Watch Co.*, 211 USPQ 352 (TTAB 1981) (proprietary right is a right residing in owner of mark and those in privity).

Cf. Otter Products LLC v. BaseOneLabs LLC, 105 USPQ2d 1252, 1255-56 (TTAB 2012) (reliance solely on a Supplemental Registration insufficient to establish proprietary rights); *Stephen Slesinger Inc., v. Disney Enterprises Inc.*, 98USPQ2d 1890, 1896 n.17 (TTAB 2011) (plaintiff cannot establish priority because it cannot prove ownership of some prior right in view of the district court's finding that plaintiff transferred all its rights to defendant), *aff'd*, 702 F.3d 640, 105 USPQ2d 1472 (Fed. Cir. 2012) *cert den.* 134 S. Ct. 125 (2013); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1322 (TTAB 2007) (in view of decision in applicant's favor on issue of priority, opposer cannot as a matter of law prevail on likelihood of confusion claim); *CDS Inc. v. I.C.E.D. Management, Inc.*, 80 USPQ2d 1572, 1580 (TTAB 2006) (in a concurrent use proceeding, after the jurisdictional requirement has been met, Board must then consider the issue of likelihood of confusion); *Aktieselskabet af 21 November 2001 v. Fame Jeans, Inc.*, 77 USPQ2d 1861, 1864 (TTAB 2006), *motion granted*,511 F. Supp. 2d 1 (D.D.C. 2007), *aff'd in part and rev'd in part*,525 F.3d 8, 86 USPQ2d 1527 (D.C. Cir. 2008) (priority of trademark rights in the United States depends solely upon priority of use in U.S., and not on priority of use anywhere in the world; opposer must rely upon filing date of its Trademark Act § 44, 15 U.S.C. § 1126 application for its use date).

45. *See Spirits International B.V. v. S. S. Taris Zeytin Ve Zeytinyagi Tarim Satis Kooperatifleri Birligi*, 99 USPQ2d 1545, 1549 (TTAB 2011) (opposer may rely on its earlier- filed intent-to-use application filing date as a constructive use date for purposes of priority; any judgment is contingent upon registration of opposer's application); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1754 (TTAB 2009) (priority established by making pleaded registrations of record); *Christian Broadcasting Network Inc. v. ABS-CBN*

International, 84 USPQ2d 1560, 1565 (TTAB 2007) (where both petitioner and respondent are owners of registrations, petitioner must prove priority of use; may rely on filing date of application for registration); *Kohler C. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1106 (TTAB 2007) (respondent may rely on the filing date of the application underlying its registration in establishing priority, in absence of allegation or proof of date of first use earlier than this date); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006) (priority established by introduction of status and title copy of registration during testimony deposition); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1339 (TTAB 2006) (plaintiff may rely on plaintiff's application filing dates, subject to issuance of the registrations, for purposes of priority); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1844 (TTAB 1995) (owner of an intent-to-use application may rely on its application filing date as a constructive use date for purposes of priority); *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542, 1544 (TTAB 1991).

46. *See Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (insufficient record evidence of prior use); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1023 (TTAB 2009) (in absence of pleaded registration, petitioner must show prior common law use); *Mattel Inc. v. Funline Merchandise Co.*, 81 USPQ2d 1372, 1374 (TTAB 2006) (petitioner's use of mark prior to respondent's first use); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1284 (TTAB 2008) (opposer's use, while not large, was sufficient to constitute more than token use); *General Motors Corp. v. Aristide & Co., Antiquaire de Marques*, 87 USPQ2d 1179, 1181 (TTAB 2008) (opposer must show use prior to applicant's priority date; licensing by itself without sales is not use of the mark); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) (pleading of reliance on analogous use established priority); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1107 (TTAB 2007); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (interstate or intrastate commerce is sufficient); *Jimlar Corp. v. The Army and Air Force Exchange Service*, 24 USPQ2d 1216, 1221 (TTAB 1992). *Cf. NASDAQ Stock Market Inc. v. Antartica S.r.l.*, 69 USPQ2d 1718, 1727 (TTAB 2003) (use of mark on collateral promotional items in connection with its service did not give rise to a claim of priority based solely on use of the mark on collateral products).

47. *See T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879, 1881 (Fed. Cir. 1996) (must show that the activities claimed to constitute analogous use have had "substantial impact" on the purchasing public); *West Florida Seafood, Inc., v. Jet Restaurants, Inc.*, 31 F.2d 1122, 31 USPQ2d 1660 (Fed. Cir. 1994) (use in advertising); *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846, 1850 (Fed. Cir. 1993) (trade name use); *National Cable Television Association Inc. v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1428 (Fed. Cir. 1991) (trade name use); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1539 (TTAB 2007) (analogous use may be asserted against an intent-to-use application); *L. & J.G. Stickley Inc. v. Cosser*, 81 USPQ2d 1956, 1965 (TTAB 2007) (use in intrastate commerce may be asserted by plaintiff); *Shalom Children's Wear Inc. v. In-Wear A/S*, 26 USPQ2d 1516, 1519 (TTAB 1993) (priority of use against ITU application may be established with prior use analogous to trademark use); *Corporate Document Services Inc. v. I.C.E.D. Management Inc.*, 48 USPQ2d 1477, 1479 (TTAB 1998) (owner of ITU application may rely on prior use analogous to trademark use). *Cf. Westrex Corp. v. New Sensor Corp.*, 83 USPQ2d 1215, 1218 (TTAB 2007) (opposer failed to acquire rights through analogous trademark use).

48. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974); ("Board must consider existing registrations of subsequent-user opposers because ... [Trademark Act § 2(d), 15 U.S.C. § 1052(d) provides that] an applicant can register, unless his mark is likely to cause confusion with a mark 'registered in the Patent Office or ... previously used ..."); *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1436 n.7 (TTAB 2012) (there can be no priority dispute when an opposer properly introduces its registrations into the record and there is no counterclaim); *Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1190 (TTAB 2012) (priority not at issue for the goods and

services recited in the pleaded registrations of record); *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1712 (TTAB 2011) (priority not at issue on a motion for involuntary dismissal where pleaded registrations were made of record with notice of opposition); *Rocket Trademarks Pty. Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1072 (TTAB 2011) (priority not at issue as to the marks and goods covered by the pleaded registrations, which are of record); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1119 (TTAB 2009) (had opposer properly introduced its pleaded registrations, priority would have been removed as an issue to be proved); *L.C. Licensing Inc. v. Berman*, 86 USPQ2d 1883, 1887 (TTAB 2008) (pleaded registrations show current ownership and that each is valid and subsisting; priority is not an issue); *Demon International LC v. Lynch*, 86 USPQ2d 1058, 1060 (TTAB 2008) (opposer must properly introduce its pleaded registrations into the record so that priority will not be an issue); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 (TTAB 2007) (having submitted status and title copies of its pleaded registrations, opposer not required to prove acquired distinctiveness of marks); *Apple Computer v. TVNET.net Inc.*, 90 USPQ2d 1393, 1396 (TTAB 2007); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1206 (TTAB 2006) (where petitioner fails to properly make its pleaded registration of record it must rely on common law rights for purposes of likelihood of confusion analysis), *aff'd unpub*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 2006); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1225 (TTAB 2005); *SCOA Industries, Inc. v. Kennedy & Cohen, Inc.*, 188 USPQ 411, 413 (TTAB 1975), *appeal dismissed*, 189 USPQ 15 (CCPA 1976); and *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998).

See also Otter Products LLC v. BaseOneLabs LLC, 105 USPQ2d 1252, 1254-55 (TTAB 2012) (priority not at issue in opposition where pleaded registration of record resides on Supplemental Register).

Cf. regarding cancellation proceedings, *Calypso Technology Inc. v. Calypso Capital Management LP*, 100 USPQ2d 1213, 1219-20 (TTAB 2011) (where respondent did not introduce evidence of earlier use, petitioner's priority established based on the filing date of the underlying application which matured into its pleaded registration); *Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1851 (TTAB 2008); *Brewski Beer Co. v. Brewski Brothers Inc.*, 47 USPQ2d 1281, 1284 (TTAB 1998) (in a cancellation proceeding the registrations of each party offset each other and petitioner must, in the first instance, establish prior rights); and *American Standard Inc. v. AQM Corp.*, 208 USPQ840, 841 (TTAB 1980) (priority must be proven in cancellation proceeding).

49. *See, e.g.*, *Massey Junior College, Inc. v. Fashion Institute of Technology* , 492 F.2d 1399, 181 USPQ 272, 275 n.6 (CCPA 1974) ("prior use need not be shown by an opposer relying on a registered mark unless the applicant counterclaims for cancellation"); *Contour Chair-Lounge Co. v. The Englander Co.* , 324 F.2d 186, 139 USPQ 285, 286 (CCPA 1963) (as long as a registration relied on by an opposer remains uncancelled, it will be treated as valid and entitled to all statutory presumptions; having dismissed petition to cancel pleaded registrations, and since no appeal was taken, Board was obligated to treat opposer's registrations as valid and as though no such petition had been filed); *Ultratan Suntanning Centers Inc. v. Ultra Tan International AB* , 49 USPQ2d 1313, 1315 (Comm'r Pat. 1998) ("prior use need not be shown by an opposer relying on a registration of its pleaded mark for its pleaded goods or services unless the applicant counterclaims for cancellation"). *See also* 37 CFR § 2.106(b)(3)(ii) (attack on registration must be made by counterclaim or separate claim); *Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ2d 1134, 1139 (TTAB 2013) (plaintiff must prove priority in cancellation and in oppositions where there is a counterclaim to cancel its pleaded registration); *Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (better practice is to raise defense as a counterclaim); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (applicant's arguments in its brief that opposer's marks are functional, non-distinctive, and lack source-indicating significance constitute an impermissible collateral attack on opposer's pleaded registrations, which arguments cannot be considered in the absence of a counterclaim for cancellation). *Cf. Penguin Books Ltd. v. Eberhard*,

48 USPQ2d 1280, 1286 (TTAB 1998) (petition or counterclaim to restrict the scope of goods in registration under Trademark Act § 18, 15 U.S.C. § 1068 was not a collateral attack on the validity of that registration).

Please Note: In cases where a plaintiff has relied on its ownership of a pleaded registration, any counterclaim or petition to cancel that registration is normally decided before the issues in the underlying opposition. *See, e.g., Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1328 (TTAB 1992); *General Mills Inc. v. Health Valley Foods*, 24 USPQ2d 1270, 1272 (TTAB 1992).

50. *See 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) (interest of trade association found sufficient); *Association pour la Defense et la Promotion de l'Oeuvre de Marc Chagall dite Comite Marc Chagall v. Bondarchuk*, 82 USPQ2d 1838, 1841 (TTAB 2007) (petitioner committee's right derived through inheritance found sufficient); *Internet Inc. v. Corporation for National Research Initiatives*, 38 USPQ2d 1435, 1438 (TTAB 1996) (petitioners failed to allege that they, or anyone else, possessed proprietary rights in the term); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (fraternal organization has standing); *Holmes Products Corp. v. Duracraft Corp.*, 30 USPQ2d 1549, 1552 (TTAB 1994) (no legitimate interest in preventing confusion alleged).

B. Likelihood of Confusion

The evidentiary factors the Board considers in determining likelihood of confusion are set out in *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). These factors include the similarity of the marks, the relatedness of the goods and/or services, the channels of trade and classes of purchasers for the goods and/or services, the number and nature of similar marks in use on similar goods, the nature and extent of any actual confusion, and the fame of the prior mark. [Note 51.] The relevance and weight to be given the various factors may differ from case to case and a single *du Pont* factor may be dispositive in certain cases. [Note 52.]

Direct or Hypothetical Pleading of Likelihood of Confusion: A plaintiff may plead likelihood of confusion directly or hypothetically. [Note 53.] A hypothetical pleading may consist of assertions 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. [Note 54.] 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 opposition 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 Trademark Act § 2(d), 15 U.S.C. § 1052(d)); etc. Thus, a plaintiff wishing to plead likelihood of confusion hypothetically in a proceeding based upon Trademark Act § 2(d), 15 U.S.C. § 1052(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. [Note 55.]

Reverse Confusion:"Reverse confusion" does not have to be specifically pleaded so long as the plaintiff asserts that the respective marks are so similar as applied to the respective goods or services as to be likely to cause confusion. [Note 56.]

NOTES:

51. *See In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). *See, e.g., Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En*, 1772, 396 F.3d 1369, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (to determine whether the marks are similar for purposes of assessing the likelihood of confusion, the Board will consider the appearance, sound, connotation and commercial impression of each mark); *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) (the nature and scope of a party's goods or services must be determined on the basis of the goods or services recited in the application or registration); *The North Face Apparel Corp. v. Sanyang Industries, Inc.*, 116 USPQ2d 1217, 1225 (TTAB 2015) (no context provided for figures in support of fame; burden of proving fame not met); *Anheuser-Busch, LLC v. Innvopak Systems Pty. Ltd.*, 115 USPQ2d 1816, 1820-21 (TTAB 2015) (fame of mark proved, which weighs heavily in likelihood of confusion finding); *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000).

See also Research in Motion Limited v. Defining Presence Marketing Group Inc., 102 USPQ2d 1187, 1194 (TTAB 2012) (likelihood of confusion found based on evidence relevant to factors bearing on issue for certain classes of goods but not for one class of goods); *Brown Shoe Co. v. Robbins*, 90 USPQ2d 1752, 1756 (TTAB 2009) (doctrine of foreign equivalents not applied where both marks were Spanish words); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020 (TTAB 2009) (no likelihood of confusion found upon consideration of relevant factors); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1723 (TTAB 2008) (the Board will not take judicial notice that items of outerwear and undergarments are related items for purposes of determining whether parties' goods are related); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 (TTAB 2007) (unnecessary to prove likelihood of confusion with respect to all goods set forth in application); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1505 (TTAB 2007) (fame); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1342 (TTAB 2006) (dissimilarity of marks dispositive); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1897 (TTAB 2006) (test for determining likelihood of confusion with respect to certification mark based on comparison of the mark as applied to the goods of the certification mark users); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1206 (TTAB 2006) *aff'd unpub'd*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 2006) (several factors considered); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1228 (TTAB 2005) (whether adoption of mark was in bad faith); *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004) (likelihood of confusion in pharmaceutical context); *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650, 1657 (TTAB 2002); *Baroid Drilling Fluids Inc. v. Sun Drilling Products*, 24 USPQ2d 1048, 1052-53 (TTAB 1992) (family-of-marks).

52. *See Odom's Tennessee Pride Sausage, Inc. v. FF Acquisition, LLC*, 600 F.3d 1343, 93 USPQ2d 2030, 2032 (Fed. Cir. 2010) (Board did not err in basing its decision on dissimilarity of marks alone); *Shen Manufacturing Co. v. Ritz Hotel Ltd.*, 393 F.3d 1238, 73 USPQ2d 1350, 1353 (Fed. Cir. 2004) ("Neither we nor the board, however, need consider every *duPont* factor"); *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1473 (Fed. Cir. 1992); *Kellogg Co. v. Pack'em Enterprises Inc.*, 14 USPQ2d 1545 (TTAB 1990), *aff'd*, 951 F.2d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). *See also Herbko International Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 USPQ2d 1375, 1378 (Fed. Cir. 2002); *Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008) (dissimilarity of marks dispositive); *Mattel Inc. v. Funline Merchandise Co.*, 81 USPQ2d 1372, 1374 (TTAB 2006) (key considerations are similarities between the marks and goods recited in both parties' registrations); *Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1342 (TTAB 2006) (dissimilarity of marks dispositive); and *Sports Authority Michigan Inc. v. PC Authority Inc.*, 63 USPQ2d 1782, 1800 (TTAB 2001).

53. *See* Fed. R. Civ. P. 8(d)(2).

54. *See John T. Clark Co. v. Colgate-Palmolive Co.*, 176 USPQ 93 (TTAB 1972); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971). *Cf. Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); *Lia Jene Inc. v. Vitabath, Inc.*, 162 USPQ 469, 470 (TTAB 1969) (representations made by petitioner in attempting to overcome reference to secure its own registration cannot estop petitioner from taking a different position in proceeding to cancel such registration).

55. *See Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, notwithstanding that it is the senior user, because the subject registration has been cited as a reference by the examining attorney). *See also Central Garden & Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ2d 1134, 1150 (TTAB 2013) (Board did not consider hypothetical question of likelihood of confusion sought by senior party); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting likelihood of confusion as ground for cancellation); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

56. *See Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1175 n.18 (TTAB 2011); *American Hygienic Laboratories Inc. v. Tiffany & Co.*, 12 USPQ2d 1979, 1983 n.7 (TTAB 1989).

309.03(d) Remedy Under Trademark Act § 18, 15 U.S.C. § 1068, (Partial Opposition or Partial Cancellation)

15 U.S.C. § 1068 ***[Trademark Act § 18]*** *In such proceedings the Director may refuse to register 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 under this chapter may be established in the proceedings....*

37 CFR § 2.111(b) *Any person who believes that he, she or it is or will be damaged by a registration may file a petition, addressed to the Trademark Trial and Appeal Board, for cancellation of 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 Board will allow the party time in which to file a motion that the application or registration be amended to conform to the findings of the 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.*

Under Trademark Act § 18, 15 U.S.C. § 1068, the Board has the authority to cancel registrations in whole or in part, to restrict the goods or services identified in an application or registration, or to "otherwise restrict or rectify...the registration of a registered mark." [Note 1.] However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use proceeding. [Note 2.] For information concerning concurrent use proceedings, *see* TBMP Chapter 1100.

Relief under Trademark Act § 18, 15 U.S.C. § 1068, may be sought separately and apart from,or in addition to, any other ground. [Note 3.] A claim under Trademark Act § 18, 15 U.S.C. § 1068, is in the nature of an equitable remedy and does not require pleading and proof of specific grounds for cancellation or opposition, such as abandonment. [Note 4.]

Please Note:A claim in which the plaintiff seeks to delete specific items on the grounds that the defendant is no longer using, and has no intent to resume use of its mark on those goods or services, is not a claim under Trademark Act § 18, 15 U.S.C. § 1068 but is essentially a "straightforward" pleading of abandonment. [Note 5.]

A claim to restrict or limit the goods or services under Trademark Act § 18, 15 U.S.C. § 1068. A plaintiff may seek to partially cancel a registration, or partially oppose registration only as to specific items in the identification of goods or services, or only to the extent of restricting the goods or services in a particular manner in terms of type, use, customers, trade channels, etc. [Note 6.]In such case, essentially a plaintiff is seeking either to delete specific items or limit the identification in some way. For example, a plaintiff may seek to restrict or modify the goods or services in a particular manner, that is, by the addition of wording that identifies the goods or services with greater particularity in terms of type, use, channels of trade, etc.

However, the Board will not permit an action to restrict or modify the goods or services in this manner where such a claim is divorced from the question of likelihood of confusion. [Note 7.] Thus, a party seeking to restrict an opponent's broadly worded identification of goods or services, in a case involving likelihood of confusion, must plead and prove that (i) the entry of a proposed restriction to the goods or services in its opponent's application or registration will avoid a finding of likelihood of confusion and (ii) the opponent is not using its mark on those goods or services that will be effectively excluded from the application or registration if the proposed restriction is entered. [Note 8.]

In considering a restriction of a registration, the Board will look to the nature of the use made by registrant as of the time the restriction is sought, not as of the time registration was sought. [Note 9.]

A petition to partially cancel a registration by restricting the goods or services in a particular manner in terms of type, use, channels of trade, etc., in order to avoid a likelihood of confusion can be made against registrations over 5 years old as well as those less than 5 years old. [Note 10.] This is so because such a claim is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration. [Note 11.]

A claim to restrict or rectify with respect to the register the registration. A petition to restrict or clarify the description of a mark in a registration would fall under the provision giving the Board authority to "restrict or rectify" the register. [Note 12.] As in the case of a petition to restrict goods or services, a proper pleading to restrict the description of a mark could include allegations that, for example, the description of

the mark in the registration is ambiguous or overly broad and not specific to the mark actually used by the defendant, and that the limitation would avoid a finding of a likelihood of confusion. [Note 13.]

That same provision, along with the authority to "register the mark...for the person...entitled thereto," allows the Board to correct, respectively, a registration or application to identify the true owner, if such correction is warranted. [Note 14.]

Similarly, under this provision, a plaintiff may seek relief in the nature of entry of a disclaimer of an assertedly generic term forming only a portion of the mark, provided that the registration is less than five years old. [Note 15.]

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. [Note 16.] *See also* TBMP § 309.03, TBMP § 314 and TBMP § 507. In addition, the claim must be specific in nature so that the defendant has fair notice of the specific restriction being sought. [Note 17.] Any claim that is not pleaded in the complaint, as originally filed or as amended (or deemed amended) pursuant to Fed. R. Civ. P. 15(a) or 15(b), will not be entertained by the Board. [Note 18.] *See also* TBMP § 309.03, TBMP § 314 and TBMP § 507.

A defense which seeks to restrict a plaintiff's pleaded registration will not be entertained in the absence of a timely counterclaim, or separate petition, to cancel the registration in whole or in part. [Note 19.] *See* TBMP § 309.03(c), TBMP § 311.01(c) and TBMP § 313.01.

For information on a request by defendant to restrict its identification of goods or services under Trademark Act § 18 , 15 U.S.C. § 1068, *see* TBMP § 311.02(b); TBMP § 507 and TBMP § 514. For information on asserting a counterclaim to partially cancel a registration , *see* TBMP § 313.01.

For information concerning the extent of default for failure to file an answer to a claim for partial opposition or cancellation , *see* TBMP § 312.01.

NOTES:

1. Trademark Act § 18, 15 U.S.C. § 1068. *See also* 37 CFR § 2.111(b) and 37 CFR § 2.133 (b); *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (Board has equitable power to restrict the goods and services under Section 18); *Montecash LLC v. Anzar Enterprises, Inc.* 95 USPQ2d 1060, 1063 (TTAB 2010); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998); and *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1994). *Cf. ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1354 (TTAB 2007) (proposed amendment denied); *Seculus Da Amazonia S/A v. Toyota Jidosha Kabushiki Kaisha*, 66 USPQ2d 1154, 1156 (TTAB 2003) (opposition based on applicant's alleged misconduct and unclean hands in its dealing with the U.S. Customs Service fails to constitute a claim that is cognizable under Trademark Act § 18, 15 U.S.C. § 1068).

2. *See* 37 CFR § 2.99(h) and 37 CFR § 2.133(c); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990). *Cf. Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1106 n.3 (TTAB 2007) (proposed counterclaim to partially cancel petitioner's pleaded registrations by further limiting their geographic scope denied).

3. *Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1829 (TTAB 2013) (Section 18 relief may be sought in the alternative); *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1063

(TTAB 2010); *Dak Industries, Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 (TTAB 1995).

4. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1994). *See also DAKIndustries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995) ("…a claim for partial cancellation by restriction or modification of the goods or services listed in a plaintiff's pleaded registration is an equitable remedy under Section 18 of the Trademark Act, not tied to a ground to cancel.").

5. *Johnson & Johnson v. Obschestvo s Ogranitchennoy*, 104 USPQ2d 2037, 2038 n.2, 2039 (TTAB 2012) (counterclaim seeking partial cancellation as to only three of the items identified in the class based on abandonment due to nonuse without an intent to resume use is a counterclaim of abandonment sufficiently stated notwithstanding reference to Section 18); *DAKIndustries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995) (because applicant sought to strike from opposer's registration goods specifically listed therein, such as "open reel audio tape," on the grounds that opposer was no longer using and had no intent to resume use of its mark on such goods, it was proper to plead abandonment and applicant did not need to plead that a finding of likelihood of confusion will be avoided by the restriction it sought). *See also Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192, 1195 & n.9 (TTAB 1996) (respondent's counterclaim alleging that respondent may have prior use of the mark in the trade channels sought to be excluded in petitioner's registration, was legally insufficient pleading of either likelihood of confusion or abandonment because likelihood of confusion is not available ground for cancellation of registration over five years old and because counterclaim lacked pleading of allegation that petitioner had not, as of the filing date of the counterclaim, commenced using its mark in connection with the goods which counterclaimant sought to have deleted from registration).

6. *See Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1196-97 (TTAB 2014); *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995); and *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1270 (TTAB 1994). *Cf. IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1954 (TTAB 2009) (amendment denied).

7. *See DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995) ("the Board will not exercise its authority under Section 18 to permit an action for partial cancellation by restriction or modification of the goods listed in an application or registration where such a claim is divorced from the question of likelihood of confusion."); *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 (TTAB 1994) (discretion to limit a registration will only be exercised when such partial cancellation or restriction will avoid the finding of likelihood of confusion). *Cf. Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB) (a defendant may assert an affirmative defense by moving to restrict its own goods and/or services in order to avoid any likelihood of confusion alleged by plaintiff).

Please Note: To the extent that cases decided prior to *Eurostar* permitted a restriction in the absence of a pleading that the restriction sought will avoid a likelihood of confusion, and to the extent that those cases required the pleading and proof of a separate ground of nonuse or abandonment, those cases were expressly overruled by *Eurostar*.

8. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 (TTAB 1994). *See also, e.g., Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (applicant's attempt to restrict opposer's registration for computer programs to "computer programs except computer programs

for maintenance management" was rejected as it did not serve to avoid likelihood of confusion since proposed restriction failed to delineate different users or different channels of trade).

9. *See Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192 (TTAB 1996).

10. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1994).

11. See *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1994). *See also, e.g., Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

12. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009); *Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479 (TTAB 1998).

13. *See Wellcome Foundation Ltd. v. Merck & Co.*, 46 USPQ2d 1478, 1479-80 (TTAB 1998). *See also Covidien LP v. Masimo Corp.*, 109 USPQ2d 1696, 1699 (TTAB 2014) (sufficient to allege that a feature of the description of the mark renders the description not specific to the mark as actually used and that the proposed amendment of the description to the color actually used would avoid a likelihood of confusion).

14. *See 8440 LLC v. Midnight Oil Co.*, 59 USPQ2d 1541, 1541 (TTAB 2001) (where the record showed that plaintiff, rather than defendant, was the true owner of the marks in the challenged application and registration and where the parties filed a joint motion that registration be issued in the name of plaintiff and that the register be rectified to show plaintiff as the owner of the existing registration, Board exercised authority under Trademark Act § 18, and granted motion). *See also Chapman v. Mill Valley Cotton*, 17 USPQ2d 1414, 1415 (TTAB 1990).

15. *See Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1063 (TTAB 2010) (petitioner, seeking entry of a disclaimer of a purportedly generic term that formed a portion of a mark that is not generic in its entirety, and that resided on the Principal Register for more than five years, failed to state a claim upon which relief may be granted); *Kellogg Co. v. Pack'em Enterprises, Inc.*, 14 USPQ2d 1545, 1549 (TTAB 1990) (counterclaim plaintiff seeking, in the alternative, that an amendment be entered to disclaim a purportedly descriptive portion of an asserted mark registered for less than five years stated a claim upon which relief may be granted).

16. *See Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1287 (TTAB 1998) (restriction proposed for first time in reply brief untimely); *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1272 (TTAB 1994); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 n.10 (TTAB 1990) (petitioner's request to restrict channels of trade for respondent's goods denied when raised at end of rebuttal period). *Cf. ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 (TTAB 2007) (applicant's proposed restriction to application denied; Board will only exercise this authority where the issue of restriction has been raised in either the pleadings or by motion or has been tried by the parties, and the possible restriction has been stated with precision). *But see Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (motion to amend, filed prior to opening of opposer's testimony period, to add counterclaim to restrict the goods and services identified in opposer's pleaded registrations granted).

17. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1272 (TTAB 1994) (party that seeks to restrict a registration or application should state with as much precision as possible the restriction it seeks, so that the issue is properly framed for trial); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1749 (TTAB 1992) (counterclaim failed to specify the least restrictive language applicant would accept); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1218 (TTAB 1990) (counterclaim that opposer's registration should be amended "to accurately describe the services" was vague); *Pegasus Petroleum Corp. v. Mobil Oil Corp.*, 227 USPQ 1040, 1044 (TTAB 1985).

18. *See Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1272 (TTAB 1994); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (petitioner's request to restrict channels of trade for respondent's goods denied when raised at end of rebuttal period).

19. 37 CFR § 2.106(b)(3)(ii).

309.04 Defects in Complaint That May Affect Institution of Proceeding

An opposition or a petition for cancellation must be filed via ESTTA. However, if ESTTA is unavailable due to technical problems, or due to extraordinary circumstances, an opposition or petition for cancellation may be filed on paper, (except for an opposition against a § 66(a) application) if accompanied by a Petition to the Director under 37 CFR § 2.146 and the required fee. [Note 1.] Following are circumstances that affect the institution of the proceeding, some of which are specific to paper filings.

No proceeding will be instituted, and any submitted filing fee for the proceeding will be refunded in the following circumstances:

(1) 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 through mistake. *See* TBMP § 303.05.

(2) In the rare circumstance that an opposition or a petition for cancellation *in paper form, accompanied by a Petition to the Director and the required fee*, and the opposition or petition to cancel is deemed prematurely filed (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, even if the registration has issued by the time of the Board's action). *See* TBMP § 306.03 and TBMP § 307.03. **Please Note:** ESTTA does not permit a party to file a notice of opposition prior to the opposition period or a petition to cancel prior to registration of the mark.

(3) In the rare circumstance that an opposition is filed *in paper form accompanied by a Petition to the Director and the required fee*, and the 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; or if the opposed application was abandoned before the opposition was filed. *See* TBMP § 218, TBMP § 306.04, TBMP § 308 and TBMP § 309.02(b)). **Please Note:** ESTTA does not permit a plaintiff to file a notice of opposition after the expiration of the opposition period or without payment of the required fee. [Note 2.]

(4) If a party files an opposition, but the notice of opposition misidentifies the application serial number, and it is clear from the notice of opposition that another serial number was intended, should it come to the Board's attention as the Board is manually instituting the opposition that a notice of allowance has issued with respect to the intended serial number or that the mark has been registered, the proceeding will not be instituted and the filing fee will be refunded.

(5) In the rare circumstance that a petition for cancellation is filed *in paper form accompanied by a Petition to the Director and the required fee*, but the petition to cancel is not accompanied by a fee sufficient to pay in full for each named petitioner for each class in the registration(s) for which cancellation is sought, the cancellation may not be instituted. [Note 3.]

No proceeding will be instituted and the filing fee will not be refunded in the following circumstances:

(1) If a party files an opposition or petition for cancellation in *paper form* without the Petition to the Director and the required fee under37 CFR §2.146, the proceeding will not be instituted and the filing fee will not be refunded.

(2) If a party files an opposition or petition for cancellation in *paper form accompanied by the Petition to the Director and the required fee* and the required showing in the Petition to the Director is found to be insufficient, the proceeding will not be instituted and the filing fee will not be refunded.

Proceedings will be instituted and the filing fee charged in the following circumstances:

(1) In the rare circumstance that a party files a petition for cancellation *in paper form, accompanied by a Petition to the Director and the required fee*, and the Petition to the Director is granted, and the petition to cancel is filed against a Principal Register registration that is more than five years old, but does not allege any ground upon which such a registration can be cancelled (*see* Trademark Act § 14, 15 U.S.C. § 1064), the cancellation will still be instituted. (The insufficiency of pleaded claims must be raised by motion, such as under Fed. R. Civ. P. 12. It may also be addressed during a discovery conference conducted with Board participation.) Any fee submitted with the petition will not be refunded. **Please Note:** when a plaintiff uses ESTTA to file a notice of opposition or petition to cancel, ESTTA presents a checklist of available grounds and prompts the filer to select grounds for opposition or cancellation. [Note 4.] Failure to select or include any grounds will halt the filing process. For a petition to cancel, if the involved registration is more than five years old, ESTTA will present a listing of available grounds under Trademark Act § 14(3) and Trademark Act § 14(5), 15 U.S.C. § 1064(3) and 15 U.S.C. § 1064(5), and will not allow a party to select other (unavailable) grounds.

(2) In the rare circumstances that a petition for cancellation is filed *in paper form, accompanied by a Petition to the Director and the required fee*, and at the time of the filing of the petition, the registration sought to be cancelled was not a "live" registration (e.g., the time for filing an affidavit of use under Trademark Act § 8, 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), the proceeding will be instituted, and then dismissed as moot. Any fee submitted with the petition for cancellation will not be refunded. **Please Note:** The ESTTA filing system prompts the user to input the registration number of the mark for which cancellation is sought. If the registration is not "live," ESTTA will halt the process. ESTTA will also refuse to continue an opposition filing process if the potential opposer inputs a serial number for a mark that has not yet been published for opposition or for which the opposition period has expired.

(3) In the rare circumstances that a party files an opposition or a petition for cancellation *in paper form, accompanied by a Petition to the Director and the required fee*, and the filer 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 ordinarily will be denied, the proceeding will be instituted, and no refund will be made. However, in cases where the Petition to the Director to file on paper is granted and there is a defect in the opposition or petition for cancellation which precludes institution, no proceeding will be instituted, and any submitted fee for the opposition or petition to cancel will be refunded.

(4) If a party files an opposition or a petition for cancellation but misidentifies the application serial number or registration number, and the proceeding is instituted against the incorrect serial or registration number, the filing fee will not be refunded. [Note 5.] *See* TBMP § 306.01.

When a proceeding is erroneously instituted, the proceeding will be dismissed as a nullity, rather than vacated, so as to maintain the integrity of the proceeding numbers. If the opposition or cancellation was filed on paper, the Board will appropriately dispose all physical papers because the papers are scanned shortly after filing and appear in the docket for the instituted, though dismissed, proceeding. If the proceeding was instituted through ESTTA, the electronic file record for the erroneous opposition or cancellation will be retained in TTABVUE.

NOTES:

1. 37 CFR § 2.101(b)(1); 37 CFR § 2.101(b)(3); 37 CFR § 2.101(b)(2); 37 CFR § 2.101(d); 37 CFR § 2.111(c)(1); 37 CFR § 2.111(c)(2).

2. *See* 37 CFR § 2.101(d); *Vibe Records Inc. v. Vibe Media Group LLC*, 88 USPQ2d 1280, 1283 (TTAB 2008) (where ESTTA filing process not completed because no fee was paid, date appearing on the ESTTA "Validate" screen is inoperative; opposition dismissed as a nullity). *See also Birlinn Ltd. v. Stewart*, 111 USPQ2d 1905, 1908 (TTAB 2014) (Board applies opportunity to cure provision in § 2.119(e) to improperly signed complaint, which defines the time period for cure as "within the time limit set in the notification of this defect by the Office").

3. *See* 37 CFR § 2.111(d).

4. 37 CFR § 2.104(a) and 37 CFR § 2.112(a); *See O.C. Seacrets Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 n.4 (TTAB 2010) ("When an opposer uses ESTTA to file a notice of opposition, ESTTA prompts the filer to list grounds for opposition").

5. *See* 37 CFR § 2.194(b)(1); *Yahoo! Inc., v. Loufrani*, 70 UPSQ2d 1735, 1736 (TTAB 2004).

310 Notification to Parties of Proceeding and Setting Time to Answer

310.01 Notification to Parties of Proceeding

37 CFR § 2.105 ***Notification to parties of opposition proceeding(s).***

(a) *When an opposition in proper form(see §§ 2.101 and 2.104) has been filed with the correct fee(s), and the opposition has been determined to be timely and complete, the Trademark Trial and Appeal Board shall prepare a notice of institution, which shall identify the proceeding as an opposition, number of the proceeding, and the application(s) involved; and the notice shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service of the notice of opposition to the applicant.*

(b) *The Board shall forward a copy of the notice to opposer, as follows:*

(1) *If the opposition is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the opposition or to the attorney designated in the power of attorney, provided that the person is an "attorney" as defined in §11.1 of this chapter, at the email or correspondence address for the attorney..*

(2) *If opposer is not represented by an attorney in the opposition, but opposer has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless opposer designates in writing another correspondence address.*

(3) *If opposer is not represented by an attorney in the opposition, and no domestic representative has been appointed, the Board will send the notice directly to opposer, at the email or correspondence address of record for opposer, unless opposer designates in writing another correspondence address.*

(c) *The Board shall forward a copy of the notice to applicant, as follows:*

(1) *If the opposed application contains a clear indication that the application is being prosecuted by an attorney, as defined in §11.1 of this chapter, the Board shall send the notice described in this section to applicant's attorney at the email or correspondence address of record for the attorney.*

(2) *If the opposed application is not being prosecuted by an attorney but a domestic representative has been appointed, the Board will send the notice described in this section to the domestic representative, at the email or correspondence address of record for the domestic representative, unless applicant designates in writing another correspondence address.*

(3) *If the opposed application is not being prosecuted by an attorney, and no domestic representative has been appointed, the Board will send the notice described in this section directly to applicant, at the email or correspondence address of record for the applicant, unless applicant designates in writing another correspondence address.*

37 CFR § 2.113 ***Notification of cancellation proceeding.***

(a) *When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.*

(b) *The Board shall forward a copy of the notice to petitioner, as follows:*

(1) *If the petition for cancellation is transmitted by an attorney, or a written power of attorney is filed, the Board will send the notice to the attorney transmitting the petition for cancellation or to the attorney designated in the power of attorney, provided that person is an "attorney" as defined in §11.1 of this chapter, to the attorney's email or correspondence address of record for the attorney.*

(2) *If petitioner is not represented by an attorney in the cancellation proceeding, but petitioner has appointed a domestic representative, the Board will send the notice to the domestic representative, at the email or correspondence address of record for the domestic representative, unless petitioner designates in writing another correspondence address.*

(3) *If petitioner is not represented by an attorney in the cancellation proceeding, and no domestic representative has been appointed, the Board will send the notice directly to petitioner, at the email or correspondence address of record for petitioner, unless petitioner designates in writing another correspondence address.*

(c) (1) *The Board shall forward a copy of the notice to the party shown by the records of the Office to be the current owner of the registration(s) sought to be cancelled at the email or address of record for the current owner, 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(s).*

(2) *If the respondent has appointed a domestic representative, and such appointment is reflected in the Office's records, the Board will send the notice only to the domestic representative at the email or correspondence address of record for the domestic representative.*

(d) *When the party alleged by the petitioner, pursuant to §2.112(a), as the current owner of the registration(s) is not the record owner, a courtesy copy of the notice with a web link or web address to*

access the electronic proceeding record shall be forwarded to the alleged current owner. The alleged current owner may file a motion to be joined or substituted as respondent.

37 CFR § 2.119 ***Service and signing.***

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, … must be served upon the other party or parties.* * * *

A notice of opposition must be filed through ESTTA (see 37 CFR § 2.101(b)(1)). When a timely opposition in proper form (*See* 37 CFR § 2.101 and 37 CFR § 2.104), has been filed, the required fee(s) have been submitted, and the opposition has been determined to be timely and complete, the opposition will be instituted. [Note 1.] The defendant in the opposition is the party shown by the records of the United States Patent and Trademark Office to be the current owner of the opposed application, except that the Board, in its discretion, may join or substitute as defendant a party that makes a showing of a current ownership interest in the application. [Note 2.] *See* TBMP § 512.

When a timely petition to cancel in proper form (*See* 37 CFR § 2.111(a) and 37 CFR § 2.112) has been filed and the required fee has been submitted, the cancellation will be instituted. [Note 3.] The defendant in the cancellation proceeding is the party shown by the records of the Office 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. [Note 4.] *See* TBMP § 512.

A petition for cancellation must be filed through ESTTA (see 37 CFR § 2.111(c)(1)). However, when a timely petition to cancel in proper form is submitted *on paper* , accompanied by the Petition to the Director and the requisite fee, (*see* 37 CFR § 2.111(c)(2)), and the paper filing is permitted by the Director, on petition, the Board checks the assignment records of the Office 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 is instituted. *Cf.* TBMP § 124. **Please Note:** A petition to cancel should indicate the name, address, and email address of the current owner of record of the registration. [Note 5.] To determine the correspondence address of the owner of the registration in the Office's Trademark Status and Document Retrieval (TSDR) system, the petitioner may access TSDR through http://tsdr.uspto.gov/. [Note 6.] The TSDR display of information includes an active link to assignment information; the petitioner may consult this display of information to determine whether the registration has been assigned. If the registration has been assigned, the assignee is considered the owner of record and the complaint should name the assignee as defendant in the proceeding. *See* TBMP § 309.02(a). Plaintiffs are encouraged to provide information about a new owner, which may not be reflected in the Office's TSDR database, even if there is a domestic representative. [Note 7.] Also, plaintiffs are encouraged to provide current contact information for attorneys, or in the case of registrations under § 66(a) of the Act, current contact information for the designated representative for the international registration, which may not be in the Office's TSDR database. [Note 8.] Providing such information facilitates the Board's location and service of the proper parties in order to avoid defaults that may subsequently be set aside and thus prolong the process. [Note 9.]

Next, the Board prepares an institution order wherein it notifies the parties of the formal institution of the proceeding. The institution order includes the identification information described in 37 CFR § 2.105(a), for an opposition, or in 37 CFR § 2.113(a), for a cancellation; states that proceedings in the case will be conducted in accordance with the Trademark Rules of Practice, 37 CFR Part 2, and specifies the due date for the filing of defendant's answer to the complaint. The institution order also sets forth the remaining schedule for the case – deadline for the required discovery conference and for initial and expert disclosures, the opening and closing dates for the discovery period, and assigning each party's time for pretrial disclosures and for taking testimony. [Note 10.] The Board will send notification of the proceeding to the email or

correspondence address of the parties. [Note 11.] With regard to cancellations, presently, the Board will send notification to defendants by U.S. mail, pending system enhancements to facilitate email service. [Note 12.] The notice, which will include a web link or web address to access the electronic proceeding record in TTABVUE, the Board's electronic docket information and file database, constitutes service of the opposition or petition for cancellation on defendant. [Note 13.]

As a reminder, 37 CFR § 2.18(b)(1) requires applicants and registrants and parties to Board proceedings to promptly notify the Office of any change in physical address or email address. In addition, parties are reminded of the importance of maintaining correct and current email address information with the Office and taking steps to ensure that Office emails are not blocked by servers or spam filters, or diverted to junk mail folders.

In any proceeding, when a notice from the Board of the commencement of a proceeding, sent to any defendant (respondent or applicant) in electronic or paper form, is returned to the Office undelivered, additional notice may be given by publication in the Official Gazette, available via the Office's website (**http://www.uspto.gov**). [Note 14.]

The Board sends the institution order to the attorney representing the plaintiff [Note 15], or, if the plaintiff is representing itself, to the plaintiff itself, unless the plaintiff has designated in writing another correspondence address. [Note 16.] If the plaintiff is not represented by an attorney, but the plaintiff has appointed a domestic representative, the Board will send the institution order to the domestic representative, unless the plaintiff designates in writing another correspondence address. [Note 17.]

In an opposition, the Board sends the institution order, together with instructions and a web link or web address for viewing the opposition and any exhibits thereto in the electronic file for the proceeding via the Board's TTABVUE system, to the attorney or other authorized representative of the applicant, or, if the applicant is representing itself, to the applicant itself. If the applicant is not represented by an attorney but the applicant has appointed a domestic representative, the Board will send the institution order to the domestic representative unless the applicant designates in writing another correspondence address. [Note 18.] In a cancellation, the institution order is sent, together with instructions and a web link or web address for viewing the petition and any exhibits thereto in the electronic file for the proceeding via the Board's TTABVUE system, to the respondent itself, or to the respondent's domestic representative, if one is appointed, even if there is an attorney or other authorized representative of record in the application file after the mark has registered. [Note 19.]

The reason why the institution order is sent to the defendant's attorney or other authorized representative, if any, in an opposition, but is 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 an application file after the mark has registered 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 file has not taken any action on behalf of the client registrant for some years, may no longer represent registrant, may not know where registrant is currently located or may no longer be in practice, etc. However, if the Board is unable to locate the registrant for purposes of notifying registrant of the filing of the petition for cancellation, and the registration file reflects that an attorney or other authorized representative 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. [Note 20.] In the case of a registered extension of protection to the United States, the Board may contact the designated representative on record with the International Bureau. The Board may also contact petitioner in an attempt to obtain a better address for registrant.

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 to the alleged current owner a courtesy copy of the institution order, together with instructions and a web link or web address for viewing the petition and any exhibits thereto in the electronic file for the proceeding via the Board's TTABVUE system. 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. [Note 21.] *See* TBMP § 512.

NOTES:

1. *See* 37 CFR § 2.105(a).

2. *Cf.* 37 CFR § 2.113(c)(1). *See e.g,., Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1188 n.1 (TTAB 2012) (joinder of party defendant in opposition due to assignment); *Liberty & Co. v. Liberty Trouser Co.*, 216 USPQ 65, 66 n.1 (TTAB 1982) (substitution of party defendant in opposition as reflected in assignment records in the Office).

3. 37 CFR § 2.113(a).

4. *See* 37 CFR § 2.113(c)(1) and 37 CFR § 3.73(b)(1); *Gold Eagle Products Co. v. National Dynamics Corp.*, 193 USPQ 109, 110 (TTAB 1976). *Cf. Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 (TTAB 2006) (cancellation respondent's motion to set aside default judgment on ground that it never received actual or constructive notice of proceeding granted under Fed. R. Civ. P. 60(b)(4) where assignment of mark to respondent recorded before proceeding instituted but notification of proceeding sent to prior owner).

5. *See* 37 CFR § 2.112(a).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42243 (August 1, 2007).

7. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

9. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

10. *See* 37 CFR § 2.120(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42243 (August 1, 2007). An example of a trial order can be found in the Appendix of Forms.

11. 37 CFR § 2.105(b) and 37 CFR § 2.105(c); and 37 CFR § 2.113(b) and 37 CFR § 2 .113(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69953 (October 7, 2016).

12. 37 CFR § 2.113(b) and 37 CFR § 2.113(c); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69958 (October 7, 2016).

13. 37 CFR § 2.105(a) and 37 CFR § 2.113(a).

14. *See* 37 CFR § 2.118; MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42243-44 (August 1, 2007)); NOTICE OF FINAL RULEMAKING, 54 Fed. Reg. 34886, 34891 (August 22, 1989).

15. 37 CFR § 2.105(b)(1); 37 CFR § 2.113(b)(1).

16. 37 CFR § 2.105(b)(3); 37 CFR § 2.113(b)(3).

17. 37 CFR § 2.105(b)(2) and 37 CFR § 2.113(b)(2). *See* 37 CFR § 2.119(d).

18. *See* 37 CFR § 2.105(c); *Nabisco Brands Inc. v. Keebler Co.* , 28 USPQ2d 1237, 1238 (TTAB 1993). *See also* 37 CFR § 2.119(d).

19. *See* 37 CFR § 2.113(c).

20. *See* Notice of Final Rulemaking, 54 Fed. Reg. 34886, 34891 (August 22, 1989). *See also* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 19296, 19297 (to be codified at 37 CFR pt. 2 (proposed April 4, 2016)) ("The Board would continue its practice of using other appropriate and available means to contact a party to ensure the real party in interest is notified of the proceeding.").

21. *See* 37 CFR § 2.113(d).

310.02 Defendant's Copy of Institution Order Returned as Undeliverable

37 CFR § 2.118 ***Undelivered Office notices.*** *When a notice sent by the Office to any registrant or applicant is returned to the Office undelivered, including notification to the Office of non-delivery in paper or electronic form, additional notice may be given by publication in the Official Gazette.*

If an applicant in an opposition is not represented by an attorney or other authorized representative, and the applicant's copy of the notice of institution is returned to the Board as undeliverable, including notification of non-delivery in paper or electronic form, the Board will make all reasonable efforts to locate the applicant. If the Board is unable to locate the applicant, additional notice of the proceeding may be given by publication in the Official Gazette. [Note 1.] It should be noted, however, that it is the responsibility of an applicant representing itself to keep the Office informed of its current address.

If, in a cancellation proceeding, the defendant's copy of the notice of institution is returned to the Board as undeliverable, including notification of non-delivery in paper or electronic form, the Board will make all reasonable efforts to locate the defendant, including inquiring of the plaintiff as to the defendant's current address and email address(es). If the Board is unable to locate the defendant after reasonable investigation, or if the plaintiff is unable to furnish respondent's current address and/or email address(es) or notifies the Board that the defendant 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. [Note 2.]

When notice of the filing of an opposition or petition to cancel is published in the Official Gazette, the published notice allows the defendant thirty days from the publication date thereof in which to appear in the proceeding. If the defendant fails to appear within the time allowed, default judgment may be entered against it.

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 § 1106.05.

NOTES:

1. 37 CFR § 2.118; MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69954 (October 7, 2016); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42248 (August 1, 2007).

2. *See* 37 CFR § 2.118.

310.03 Setting Time for Filing Answer

310.03(a) In General

37 CFR § 2.105 ***Notification to parties of opposition proceeding(s).***

(a) *When an opposition in proper form (see §§ 2.101 and 2.104) has been filed with the correct fee(s), and the opposition has been determined to be timely and complete, the Trademark Trial and Appeal Board shall prepare a notice of institution, which shall identify the proceeding as an opposition, the number of the proceeding, and the application(s) involved; and the notice shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a Web link or Web address to access the electronic proceeding record, constitutes service of the notice of opposition to the applicant.* * * * *

37 CFR § 2.113 ***Notification of cancellation proceeding.***

(a) *When a petition for cancellation in proper form (see §§ 2.111 and 2.112) has been filed and the correct fee has been submitted, the Trademark Trial and Appeal Board shall prepare a notice of institution which shall identify the proceeding as a cancellation, number of the proceeding and the registration(s) involved; and shall designate a time, not less than thirty days from the mailing date of the notice, within which an answer must be filed. The notice, which will include a web link or web address to access the electronic proceeding record, constitutes service to the registrant of the petition to cancel.* * * * *

As provided by 37 CFR § 2.105(a) and 37 CFR § 2.113(a), in part, the Board's notice of institution 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 notice, 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 notice of institution setting the time for filing an answer. [Note 1.]

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 notice of institution in which to file its answer.

For information on the time for filing an answer to a counterclaim, *see* TBMP § 313.06.

NOTES:

1. *Cf. Nabisco Brands Inc. v. Keebler Co.*, 28 USPQ2d 1237, 1238 (TTAB 1993).

310.03(b) [Removed and Reserved]

310.03(c) Extension of Time to File Answer

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions must be made to the Trademark Trial and Appeal Board via ESTTA.*

(b) *In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, submissions may be filed in paper form.*

* * * *

The time for filing an answer may be extended or reopened by stipulation of the parties, approved by the Board, or on motion granted by the Board, or by order of the Board. [Note 1.] *See* TBMP § 509.

The discovery period does not open until after an answer has been filed, and concurrently with the deadline for the mandatory discovery conference.

Please Note: Extensions of time to file an answer are to be filed via ESTTA unless ESTTA is unavailable due to technical problems or when extraordinary circumstances are present. [Note 2.] The ESTTA system will prompt the filer to enter new deadlines in a manner that will generate an appropriate schedule in the proper form.

NOTES:

1. Fed. R. Civ. P. 6(b).

2. 37 CFR § 2.126(a) and 37 CFR § 2.126(b).

311 Form and Content of Answer

311.01 Form of Answer

37 CFR § 2.116 ***Federal Rules of Civil Procedure.***

(c) *The notice of opposition or the petition for cancellation and the answer correspond to the complaint and answer in a court proceeding.*

37 CFR § 2.106(b)(1) ***Answer.***

(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).*

37 CFR § 2.114(b)(1) ***Answer.***

(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).*

37 CFR § 2.126 ***Form of submissions to the Trademark Trial and Appeal Board.***

(a) *Submissions shall be made to the Trademark Trial and Appeal Board via ESTTA.*

(1) *Text in an electronic submission must be filed in at least 11-point type and double-spaced.*

(2) *Exhibits pertaining to an electronic submission must be made electronically as an attachment to the submission and must be clear and legible.*

(b) *. . . . A paper submission, including exhibits and depositions, must meet the following requirements:*

(1) *A paper submission must be printed in at least 11-point type and double-spaced, with text on one side only of each sheet;*

(2) *A paper submission must be 8 to 8.5 inches (20.3 to 21.6 cm.) wide and 11 to 11.69 inches (27.9 to 29.7 cm.) long, and contain no tabs or other such devices extending beyond the edges of the paper;*

(3) *If a paper submission contains dividers, the dividers must not have any extruding tabs or other devices, and must be on the same size and weight paper as the submission;*

(4) *A paper submission must not be stapled or bound;*

(5) *All pages of a paper submission must be numbered and exhibits shall be identified in the manner prescribed in §2.123(g)(2);*

(6) *Exhibits pertaining to a paper submission must be filed on paper and comply with the requirements for a paper submission.*

(c) *To be handled as confidential, submissions to the Trademark Trial and Appeal Board that are confidential in whole or part pursuant to § 2.125(f) must be submitted using the "Confidential" selection available in ESTTA or, where appropriate, under a separate paper cover. Both the submission and its cover must be marked confidential and must identify the case number and the parties. A copy of the submission for public viewing with the confidential portions redacted must be submitted concurrently.*

An answer to a notice of opposition or petition to cancel corresponds to an answer to a complaint in a court proceeding. [Note 1.]

The form of an answer must meet the general requirements for submissions to the Board set forth in 37 CFR § 2.126. *See* TBMP § 106.03. If an answer is filed electronically through ESTTA, the text in the electronic submission must be in at least 11-point type and double-spaced and any exhibits pertaining to the electronic submission must be made electronically as an attachment to the answer and be clear and legible. [Note 2.] If the answer is submitted on paper, due to technical problems, or when extraordinary circumstances are

present, (see 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1)) the submission, including any exhibits, may not be stapled or bound or have any extruding tabs, and must otherwise comply with the requirements of 37 CFR § 2.126(b) in order to permit efficient scanning.

A party may no longer make submissions in CD-ROM format that could otherwise be filed electronically as a digital image through ESTTA. [Note 3.] The Board will not return an inappropriately filed CD-ROM to the party which filed it.

NOTES:

1. *See* 37 CFR § 2.116(c).

2. *See* 37 CFR § 2.126(a)(1) and 37 CFR § 2.126(a)(2).

3. *See* 37 CFR § 2.126(a) and 37 CFR § 2.126(b). *Cf. Hunter Industries, Inc. v. Toro Co.*, 110 USPQ2d 1651, 1654 (TTAB 2014) (parties may not override Trademark Rule 2.126 provisions for form of submissions by agreement, exhibits submitted on flash drives and CD-ROM not considered; however, video and audio recordings may be submitted on CD-ROM or DVD), *on appeal*, No. 14-CV-4463 (D. Minn.).

311.01(a) Format for Answer

An answer need not follow a particular format, as long as the answer meets the requirements for the particular type of submission to the Board (37 CFR § 2.126(a) for electronic filings through ESTTA and 37 CFR § 2.106(b)(1), 37 CFR § 2.145(b)(1), and 37 CFR § 2.126(b) for paper filings (when permitted on Petition)), and otherwise includes the necessary information. The format for an answer is similar to a complaint and should include the following information:

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 of the proceeding (e.g., "ABC Corporation v. XYZ Company"), the proceeding number (e.g., "Opposition No. 91156789" or "Cancellation No. 92042567"), and a title describing the nature of the paper (e.g., "ANSWER," "ANSWER AND COUNTERCLAIM," etc.). *Cf.* TBMP § 309.02(a).

Substance of answer: The answer must contain admissions and/or denials of the allegations in the complaint and may include any defenses to those allegations. *See* TBMP § 311.02.

Signature: The answer must be signed and include a description of the capacity in which the signing individual signs, e.g., attorney for defendant, defendant (if defendant is an individual), partner of defendant (if defendant is a partnership), officer of defendant identified by title (if defendant is a corporation), etc. *See* TBMP § 311.01(b).

311.01(b) Signature of Answer

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

An answer need not be verified, but it must be signed. For answers submitted electronically via ESTTA, electronic signatures pursuant to 37 CFR § 2.193(c) are required. The signature may be made by the defendant or by the defendant's attorney or other authorized representative. [Note 1.] *See* TBMP § 106.02.

If a defendant signing for itself is an individual, the individual must make the signature. If defendants are joint applicants of the involved mark, each defendant must sign a combined, single answer. [Note 2.] If a defendant signing for itself is a partnership, a partner must make the signature. If a defendant signing for itself is a corporation, association, or similar juristic entity, 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.).

In the case of an electronically filed answer, the Board views the electronic signature on the ESTTA filing form as pertaining to all attachments thereto. [Note 3.] Thus, a defendant's (or its attorney's or other authorized representative's) electronic signature on the ESTTA filing form serves as its signature for the entire answer being filed, even when there is no electronic signature on the answer, submitted as an attachment to the filing form. [Note 4.]

Although an answer must be signed, an unsigned answer filed in paper form, (when permitted, see 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1)) 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. [Note 5.] *See* TBMP § 106.02.

NOTES:

1. *See* 37 CFR § 2.119(e).

2. *Cf.* TMEP § 712.01 (a response to an Office action by joint applicants who are not represented by an attorney must be signed by each of the applicants, since they are individual parties and not a single entity).

3. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005) ("Since ESTTA's inception, the Board has viewed the ESTTA filing form and any attachments thereto as comprising a single document or paper being filed with the Board."). *See also Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561 (TTAB 2011); *Schott AG v. Scott*, 88 USPQ2d 1862, 1863 n.3 (TTAB 2008) ("[T]he ESTTA generated filing form … is considered part of the plaintiff's initial pleading") MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016) (The ESTTA cover sheet is considered part of the complete opposition pleading).

4. *PPG Industries Inc. v. Guardian Industries Corp.*, 73 USPQ2d 1926, 1928 (TTAB 2005).

5. *See* 37 CFR § 2.119(e).

311.01(c) Filing and Service of Answer

37 CFR § 2.106(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper*

form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).

37 CFR § 2.114(b)(1) *An answer must be filed through ESTTA. In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form. An answer filed in paper form must be accompanied by a Petition to the Director under § 2.146, with the fees therefor and the showing required under this paragraph (b).*

37 CFR § 2.119(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, … must be served upon the other party or parties. Proof of such service must be made before the submission will be considered by the Office.*

37 CFR § 2.119(b) *Service of submissions filed with the Board and any other papers served on a party not required to be filed with the Board, 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 must be made by email, unless otherwise stipulated…*

One copy of the answer, and any exhibits thereto, must be filed with the Board. An answer must be filed through ESTTA. [Note 1.] In the event that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, an answer may be filed in paper form accompanied by a Petition to the Director and the requisite fee. [Note 2.]

Another copy of the answer, with any exhibits thereto, must be served by the defendant upon the attorney for the plaintiff, or on the plaintiff if there is no attorney. [Note 3.] The answer must 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 service was made) that such service has been made before the submission will be considered by the Board. [Note 4.] *See* TBMP § 113 regarding certificates of service. The service of an answer filed with the Board must be made by email, unless otherwise stipulated. [Note 5.] A party who attempts service by email but is unsuccessful due to technical problems or extraordinary circumstances, may effect service by other means. [Note 6.] Service by other means should be accompanied by a written explanation or amended certificate of service. [Note 7.]

For information on the time for filing an answer, *see* TBMP § 310.03.

Please Note: For answers filed on paper, the pendency of the Petition to the Director to file on paper will not act as a stay of proceedings, see 37 CFR § 2.146(g), and parties should adhere to the trial schedule. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1).

2. *See* 37 CFR § 2.106(b)(1) and 37 CFR § 2.114(b)(1).

3. *See* 37 CFR § 2.119(a) and 37 CFR § 2.119(b).

4. *See* 37 CFR § 2.119(a) and 37 CFR § 2.119(b).

5. *See* 37 CFR § 2.119(b).

6. *See* 37 CFR § 2.119(b).

7. *See* 37 CFR § 2.119(b).

8. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

311.02 Substance of Answer

37 CFR § 2.106(b)(2) *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 shall 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 by the party in the position of plaintiff in an original notice of opposition or in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.*

37 CFR § 2.106(b)(3)

(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.*

(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)(2) *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 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 shall not be filed. When a defense attacks the validity of a registration pleaded in the petition, paragraph (b)(3) of this section shall govern. A pleaded registration is a registration identified by number by the party in position of plaintiff in an original petition for cancellation, or a counterclaim petition for cancellation, in any amendment thereto made under Rule 15 of the Federal Rules of Civil Procedure.*

37 CFR § 2.114(b)(3)

(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the party in position of respondent and counterclaim plaintiff must promptly inform the Board, in the context of the primary cancellation proceeding, of the filing of the other proceeding.*

(ii) *An attack on the validity of a registration pleaded by a petitioner for cancellation 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.*

An answer is a formal written response to the plaintiff's notice of opposition or petition to cancel in which the defendant responds to all of the allegations in the complaint and sets forth any defenses to all or part of plaintiff's claims. [Note 1.] Any attack on the validity of a registration pleaded by plaintiff must be pleaded as a counterclaim, unless a separate petition to cancel has been filed to seek cancellation of the registration. [Note 2.] For specific information on answering the allegations in a complaint and asserting any defenses *see* TBMP § 311.02(a) and TBMP § 311.02(b).

NOTES:

1. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2).

2. *See* 37 CFR § 2.106(b)(3)(i); 37 CFR § 2.106(b)(3)(ii); 37 CFR § 2.114(b)(3)(i); and 37 CFR § 2.114(b)(3)(ii).

311.02(a) Admissions and Denials

The defendant should not argue the merits of the allegations in a complaint but rather should state, as to each of the allegations contained in the complaint, that the allegation is either admitted or denied. [Note 1.] If the defendant does not have sufficient information to admit or deny an allegation, the defendant may so state, and this statement will have the effect of a denial as to that allegation. If the complaint consists of numbered paragraphs setting forth the basis of plaintiff's claim of damage, the defendant's admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

A denial of an allegation should fairly meet the substance of the allegation denied, and may take any of the forms described in Fed. R. Civ. P. 8(b). [Note 2.] An answer that fails to deny a portion of an allegation may be deemed admitted as to that portion. *See* Fed. R. Civ. P. 8(b)(6). 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, including the jurisdictional grounds, the defendant may do so by general denial, subject to the obligations set forth in Fed. R. Civ. P. 11 (for a discussion of Fed. R. Civ. P. 11 in relation to pleadings, *see* TBMP § 318). 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. [Note 3.]

In the absence of a general denial of the allegations in a complaint, admissions or denials should be made in numbered paragraphs corresponding to the numbered paragraphs in the complaint.

NOTES:

1. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2); Fed. R. Civ. P. 8(b); *Hewlett-Packard Co. v. Olympus Corp.*, 931 F.2d 1551, 18 USPQ2d 1710, 1713 (Fed. Cir. 1991); *Turner Entertainment Co. v. Ken Nelson*, 38 USPQ2d 1942, 1943 (TTAB 1996) (applicant's answers were argumentative and nonresponsive and Board was ultimately forced to interpret the answer); *National Football League v. Jasper Alliance Corp.*, 16 USPQ2d 1212, 1214 n.2 (TTAB 1990) (applicant's answer was more in the nature of argument than answer); and *Thrifty Corp. v. Bomax Enterprises*, 228 USPQ 62, 63 (TTAB 1985).

2. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2). *See also Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 190 (CCPA 1982) (regarding equivocal admissions or denials).

3. *See* Fed. R. Civ. P. 8(b)(3) and 8(b)(4).

311.02(b) Affirmative Defenses

An answer may also include a short and plain statement of any defenses, including affirmative defenses that the defendant may have to the claim or claims asserted by the plaintiff. [Note 1.] Affirmative defenses may include unclean hands, laches, estoppel, acquiescence, fraud, mistake, prior registration (*Morehouse*) defense, prior judgment, or any other matter constituting an avoidance or affirmative defense. [Note 2.] Such defenses 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) [Note 3], except that geographic restrictions will be considered and determined by the Board only in the context of a concurrent use registration proceeding. [Note 4.] *See* TBMP Chapter 1100. *Cf.* TBMP § 514. A request by defendant to restrict its identification of goods or services under Trademark Act § 18, 15 U.S.C. § 1068, must be made by way of motion under 37 CFR § 2.133 although the ground may also be raised as an affirmative defense in the answer (as originally filed, as amended or as deemed amended), by way of an allegation that sets forth the proposed restriction in detail and alleges that the restriction will avoid a likelihood of confusion and that plaintiff is not using the mark on the products or services being excluded from the registration. [Note 5.] *See* TBMP § 309.03(b). If the defendant offers to amend its identification of goods or services in its originally filed answer, because the Board does not typically review the answer at the pleading stage, the defendant should also file a motion with the Board in order to bring the matter to the Board's attention for consideration. Pleading a restriction in the answer as originally filed, however, serves the purpose of putting plaintiff on early notice of the proposed restriction.

Equitable defenses may not be available against certain grounds for opposition or cancellation or under certain circumstances. For example, the availability of laches and acquiescence is severely limited in opposition and cancellation proceedings. In Board opposition proceedings, these defenses start to run from the time of knowledge of the application for registration (that is, from the time the mark is published for opposition), not from the time of knowledge of use. In Board cancellation proceedings, these defenses start to run from the date of registration, in the absence of actual knowledge before the close of the opposition period. [Note 6.] Moreover, for public policy reasons, the defenses of laches and acquiescence may not be available against claims such as genericness, descriptiveness, fraud, abandonment and functionality, and further, may not apply in a case of likelihood of confusion if it is determined in the case that confusion is inevitable. [Note 7.]

Similarly, the "prior registration" or *Morehouse* defense, an equitable defense in the nature of laches or acquiescence, [Note 8], is not available in all cases. [Note 9.] In addition, the *Morehouse* defense will not be applied where defendant's prior registration is on the Supplemental Register, or if the prior registration did not issue until after commencement of the proceeding in which it is asserted as a basis for this defense, or if plaintiff has petitioned to cancel the prior registration. [Note 10.]

Please Note: The "fair use" defense of Trademark Act §33(b)(4), 15 U.S.C. § 1115(b)(4), is a defense available to a defendant in a federal action charged with infringement of a registered mark, [Note 11], and has no applicability in inter partes proceedings before the Board, which involve only the issue of registrability of a mark. [Note 12.] Further, the "noncommercial use" exception of Trademark Act § 43(c)(3)(C), 15 U.S.C. § 1125(c)(3)(C), does not apply in a Board proceeding involving a mark sought to be registered as a trademark or service mark, because an applicant seeking registration is necessarily relying on a claim of use of its mark, or intended use of its mark, in commerce. [Note 13.]

The elements of a defense should be stated simply, concisely, and directly. [Note 14.] However, the pleading should include enough detail to give the plaintiff fair notice of the basis for the defense. [Note 15.] When one of the special matters listed in Fed. R. Civ. P. 9 (including, inter alia, capacity, fraud, and judgment) is pleaded, the provisions of Fed. R. Civ. P. 9 governing the pleading of that special matter should be followed. [Note 16.]

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. [Note 17.] For example, an applicant whose application for registration has been opposed under Trademark Act §2(d), 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. [Note 18.] *See* TBMP § 309.03(d) 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. [Note 19.]

Evidentiary matters (such as, for example, lists of third-party registrations on which defendant intends to rely) should not be pleaded in an answer. They are matters for proof, not for pleading. [Note 20.]

The Board will not entertain a defense that attacks the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. [Note 21.] *See* TBMP § 313. Moreover, a defense which seeks 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. [Note 22.] *See also* TBMP § 309.03(d) (regarding claims for partial cancellation under Trademark Act § 18, 15 U.S.C. § 1068) and TBMP § 313 (regarding counterclaims). Geographic restrictions will be considered and determined by the Board only within the context of a concurrent use proceeding. [Note 23.] For further information on concurrent use proceedings, *see* TBMP Chapter 1100.

Although 37 CFR § 2.106(b)(3)(ii) and 37 CFR § 2.114(b)(3)(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. [Note 24.] If the defense is raised as a separate petition to cancel, however, the petition itself and any cover letter filed therewith should include a reference to the original proceeding. [Note 25.] *See also* TBMP § 313.

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 unnecessary and redundant. [Note 26.]

For proceedings commenced between October 6, 2006 and October 5, 2012 that assert a claim under Trademark Act 43(c)(6)(B), 15 U.S.C. § 1125(c)(6)(B), a defendant may raise as an affirmative defense to a dilution claim the ownership of a valid registration as a complete bar to the federal claim of dilution. [Note 27.] On October 5, 2012, the Trademark Act was amended to correct the clerical error in the organization of the provisions relating to remedies for dilution. The federal registration defense is no longer available to federal dilution claims. However, the changes are not retroactive.

NOTES:

1. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2); Fed. R. Civ. P. 8(b).

2. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2). *See also Harry Winston, Inc. v. Bruce Winston Gem Corp.*, 111 USPQ2d 1419, 1422-23 n.7 (TTAB 2014) (affirmative defenses deemed waived); *Giersch v. Scripps Networks Inc.*, 90 USPQ2d 1020, 1021 n.4 (TTAB 2009) (affirmative defenses waived if not maintained in party's trial brief); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1287 (TTAB 2008) (comparison of marks for purposes of determining whether marks are essentially the same under the *Morehouse* doctrine); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1222 (TTAB 1995) (Fed. R. Civ. P. 12(b) permits a defendant to assert in the answer the "defense" of failure to state a claim upon which relief can be granted).

See, e.g., with respect to estoppel, *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (contractual and equitable estoppel); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.6 (TTAB 2006) (licensee estoppel); *Freeman v. National Association of Realtors*, 64 USPQ2d 1700, 1703-04 (TTAB 2002) (licensee estoppel); *Leatherwood Scopes International Inc. v. Leatherwood*, 63 USPQ2d 1699, 1702 (TTAB 2002) (licensee estoppel); *M-5 Steel Manufacturing Inc. v. O'Hagin's Inc.*, 61 USPQ2d 1086 (TTAB 2001) (contractual estoppel). *Cf. Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 154 (TTAB 1973) (defense of file wrapper estoppel not available in trademark cases, but since statement in ex parte proceeding may be admitted as possible admission against interest, statement not stricken from answer).

See, e.g., with respect to "*Morehouse*" defense, *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969) (that defendant already owns a substantially similar registered mark for substantially similar goods and/or services such that the second registration (or second registration sought) causes no added injury to the plaintiff). *See also O-M Bread Inc. v. United States Olympic Committee*, 65 F.3d 933, 36 USPQ2d 1041, 1045 (Fed. Cir. 1995) (*Morehouse* defense). *Cf. Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1958 (TTAB 2008) (cannot rely upon expired registration for *Morehouse* defense); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1286 (TTAB 2008) (*Morehouse* defense unavailable where mark is transliteration of foreign term); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.6 (TTAB 2006) (*Morehouse* defense does not apply where marks in the two registrations being compared are not the same); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1209 (TTAB 2006) (*Morehouse* defense fails where goods

in the involved registration are clearly different from those in prior registrations), *aff'd unpub'd*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6, 2006).

See, for example, with respect to prior judgment, *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1372 (Fed. Cir. 2008) (claim of trademark invalidity, made before Board in cancellation proceeding, amounted to collateral attack on court's judgment rendered in first action); *International Nutrition Co. v. Horphag Research Ltd.*, 220 F.3d 1325, 55 USPQ2d 1492, 1493 (Fed. Cir. 2000) (res judicata); *Jet Inc. v. Sewage Aeration Systems*, 223 F.3d 1360, 55 USPQ2d 1854, 1856 (Fed. Cir. 2000), (res judicata, claim preclusion); *NH Beach Pizza LLC v. Cristy's Pizza Inc.*, 119 USPQ2d 1861, 1863 (TTAB 2016) (issue preclusion may bar re-litigation of a standing determination made in a prior Board proceeding, summary judgment granted); *Urock Network, LLC v. Sulpasso*, 115 USPQ2d 1409, 1412 (TTAB 2015) (analyzing the defense doctrine of bar in claim preclusion); *Stephen Slesinger Inc., v. Disney Enterprises Inc.*, 98 USPQ2d 1890 (TTAB 2011) (ownership of the marks at issue established in court proceeding; defendant entitled to summary judgment based on issue preclusion), *aff'd*, 702 F.3d 640, 105 USPQ2d 1472 (Fed. Cir. 2012), *cert den.*, 134 S. Ct. 125 (2013); *Zoba International Corp. v. DVD Format/LOGO Licensing Corp.*, 98 USQP2d 1106 (TTAB 2011) (claim preclusion barred petitions to cancel against two registrations but not a third registration; "defendant preclusion" does not apply to facts of case and further discussed in contrast to "plaintiff preclusion"); *Boston Chicken Inc. v. Boston Pizza International, Inc.*, 53 USPQ2d 1053, 1055 (TTAB 1999) (judicial estoppel); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1321 (TTAB 1990) (claim preclusion, issue preclusion). *Cf. Mayer/Berkshire Corp. v. Berkshire Fashions Inc.*, 424 F.3d 1229, 76 USPQ2d 1310, 1311 (Fed. Cir. 2005) (Board erred in dismissing opposition on res judicata and collateral estoppel grounds where issues and transactional facts arising from prior district court infringement litigation differed from those in opposition proceeding); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (res judicata argument fails because marks at issue in prior proceedings were different); *B.V.D. Licensing Corp. v. Rodriguez*, 83 USPQ2d 1500, 1504 (TTAB 2007) (neither claim nor issue preclusion apply where parties are not the same).

See, for example, with respect to laches, *Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460 (Fed. Cir. 2001). *See also National Cable Television Association, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991) (laches runs from the time action could be taken against the acquisition of trademark rights which flow from registration of mark); *Land O' Lakes Inc. v. Hugunin*, 88 USPQ2d 1957, 1959 (TTAB 2008) (where laches defense based on failure to object to an expired registration, asserted period of delay begins on issue date of prior registration and ends with its expiration); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 (TTAB 2008) (no evidence that opposer knew of applicant's use of its mark in the U.S.); *Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1575 n.3 (TTAB 2008) (laches is unavailable as an affirmative defense against a claim of fraud); *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008) (defense of laches is available when the rights asserted by a petitioner are personal in nature; laches available against claims of false suggestion of a connection, likelihood of confusion, and dilution); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1116 (TTAB 2007) (respondent's expansion into new product lines excused petitioner's delay in filing cancellation; laches defense unavailable); *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1572 (TTAB 2007) (laches requires showing of undue delay and prejudice, and will not lie if confusion is inevitable); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding); *Teledyne Technologies Inc. v. Western Skyways Inc.*, 78 USPQ2d 1203, 1210 n.10 (TTAB 2006) (publication of mark does not provide constructive notice of resultant registration; "in the absence of actual knowledge prior to the close of the opposition period, the date of registration is the operative date for calculating laches;" economic damage may be a direct function of the delay involved; confusion is not inevitable), *aff'd unpub'd*, 208 Fed. Appx. 886, 887 (Fed. Cir. Dec. 6,

2006); *Chester L. Krause v. Krause Publications, Inc.*, 76 USPQ2d 1904, 1914 (TTAB 2005) (same); *Alfacell Corp. v. Anticancer Inc.*, 71 USPQ2d 1301, 1306 (TTAB 2004).

See, for example, with respect to other defenses, *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1322 (TTAB 2007) (Board has subject matter jurisdiction to entertain affirmative defense of priority pursuant to Article 7 of the Pan American Convention); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1887 (TTAB 2006) (holding that certification mark has lost its significance as an indication of geographic source). *Cf. e.g., Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006) ("family" of marks argument rejected); *Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 n.4 (TTAB 2008) (unclean hands defense unavailable); *Great Seats Ltd. v. Great Seats Inc.*, 84 USPQ2d 1235, 1244 n.10 (TTAB 2007) (defense of unclean hands, even if established, does not deprive petitioner of standing); *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001) (defendant not entitled to rely on asserted ownership of "family" of marks as defense to Trademark Act § 2(d), 15 U.S.C. § 1052(d) claim).

3. *See* 37 CFR § 2.133(a). *Cf.* 37 CFR § 2.133(b) and 37 CFR § 2.133(c) . *See also Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828 (TTAB 2013) (a defendant may assert an affirmative defense by moving to restrict its own goods and/or services in order to avoid any likelihood of confusion alleged by plaintiff).

4. *See* 37 CFR § 2.99(h) and 37 CFR § 2.133(c). *See also Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

5. *See* 37 CFR § 2.133(a) and 37 CFR § 2.133(b). *See also Embarcadero Technologies Inc. v. RStudio Inc.*, 105 USPQ2d 1825, 1828-29 (TTAB 2013) (applicant moved to amend its descriptions of goods and services, requested at trial that the amendment be considered in the alternative, and the Board deemed the answer amended to include the affirmative defense under Section 18); *British Seagull Ltd. v Brunswick Corp.*, 28 USPQ2d 1197 (TTAB 1993), *aff'd*, 35 F.3d 1527, 32 USPQ2d 1120, 1125 (Fed. Cir. 1994) (Board had no duty to address defendant's offer to amend in final brief where defendant failed to file a motion or include as affirmative defense in pleading); *Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1062 (TTAB2010) (partial cancellation on the ground that portion of the mark is a generic term unavailable where the registration sought to be cancelled is more than five years old.); *Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1480 (TTAB 2007) (same; motion to strike claim granted); *IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1954 (TTAB 2009) (Board encourages parties to seek Trademark Act § 18, 15 U.S.C. § 1068restriction of cited registrations); *ProQuest Information and Learning Co. v. Island*, 83 USPQ2d 1351, 1353 (TTAB 2007) (proposed restriction must be stated with precision); *Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1898 (TTAB 2006) (applicant's offer to amend its identification of goods given no further consideration because it would not overcome the likelihood of confusion); *Personnel Data Systems Inc. v. Parameter Driven Software Inc.*, 20 USPQ2d 1863, 1865 (TTAB 1991) (mere request by respondent in its trial brief to have its identification of goods amended rejected where petitioner was not put on notice before petitioner presented its case); *Flow Technology Inc. v. Picciano*, 18 USPQ2d 1970, 1972 (TTAB 1991) (applicant's argument on summary judgment that parties' channels of trade were different not persuasive where applicant's claim of entitlement to narrower range of goods was not put in issue by motion or amendment to its pleading). *Cf. Bass Pro Trademarks LLC v. Sportsman's Warehouse Inc.*, 89 USPQ2d 1844, 1846 (TTAB 2008) (amendment in Trademark Act § 8, 15 U.S.C. § 1058 affidavit filed during pendency of cancellation proceeding granted as unconsented motion to amend).

6. *See National Cable Television Association v. American Cinema Editors Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991); *Coach House Restaurant Inc. v. Coach and Six Restaurants Inc.*, 934 F.2d

1551, 19 USPQ2d 1401, 1404-05 (11th Cir. 1991); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1531 (TTAB 2008) (conduct which occurs prior to publication of application for opposition generally cannot support a finding of equitable estoppel); *Jansen Enterprises Inc. v. Rind*, 85 USPQ2d 1104, 1114 (TTAB 2007) (in the absence of actual notice prior to the close of the opposition period, the date of registration is the operative date for calculating laches); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 n.14 (TTAB 2007) (defenses of laches, acquiescence or estoppel generally not available in opposition proceeding); *Turner v. Hops Grill & Bar Inc.*, 52 USPQ2d 1310, 1312 (TTAB 1999); *University Book Store v. University of Wisconsin Board of Regents*, 33 USPQ2d 1385, 1401 n.39 (TTAB 1994) (equitable defenses are not grounds for opposition). *But see, Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 (TTAB 2007) (defendant may assert laches defense in cancellation even though defendant's registration on which defense is based was cancelled during the pendency of the cancellation proceeding for failure to file affidavit under Trademark Act § 8, 15 U.S.C. § 1058); *Aquion Partners L.P. v. Envirogard Ltd.*, 43 USPQ2d 1371, 1373 (TTAB 1991) (laches defense in an opposition may be based on opposer's failure to object to an earlier expired registration of substantially the same mark for substantially the same goods).

7. *See Herbaceuticals Inc. v. Xel Herbaceuticals Inc.*, 86 USPQ2d 1572, 1575 n.3 (TTAB 2008) (laches is unavailable as an affirmative defense against a claim of fraud); *Christian Broadcasting Network Inc. v. ABS-CBN International*, 84 USPQ2d 1560, 1572 (TTAB 2007) (equitable defenses such as laches and acquiescence would not preclude a judgment for plaintiff if confusion is inevitable); *Saint-Gobain Abrasives, Inc. v. Unova Industrial Automation Systems, Inc.*, 66 USPQ2d 1355, 1359 (TTAB 2003) (it is within the public interest to have certain registrations removed from the register and this interest, *quoting W. D. Byron & Sons, Inc. v. Stein Brothers Manufacturing Co.*, 146 USPQ 313, 316 (TTAB 1965) ("cannot be waived by the inaction of any single person or concern no matter how long the delay persists."), *aff'd*, 377 F.2d 1001, 153 USPQ 749 (CCPA 1967). *See also, e.g., Callaway Vineyard & Winery v. Endsley Capital Group, Inc.*, 63 USPQ2d 1919, 1923 (TTAB 2002) (equitable defenses of laches, acquiescence and estoppel cannot be asserted against claim of descriptiveness); *Turner v. Hops Grill & Bar Inc.*, 53 USPQ2d 1310, 1313 (TTAB 1999) (laches will not prevent cancellation where it is determined that confusion is inevitable); *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1131 (TTAB 1990) (same). *Cf. Bridgestone/Firestone Research Inc. v. Automobile Club de l'Ouest de la France*, 245 F.3d 1359, 58 USPQ2d 1460, 1463 (Fed. Cir. 2001) (laches is available defense against Trademark Act § 2(a), 15 U.S.C. § 1052(a) claim of false suggestion of connection because rights protected under that provision "are not designed primarily to protect the public but to protect persons and institutions from exploitation of their persona"); *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1419 (TTAB 2008) (laches is applicable to a claim of dilution because it relates to a personal right of the plaintiff, rather than being in the interest of the general public); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1294 (TTAB 1999) (estoppel not available against claims of mere descriptiveness or geographic descriptiveness); *Ross v. Analytical Technology, Inc.*, 51 USPQ2d 1269 (TTAB 1999) (laches, acquiescence and estoppel can be asserted against Trademark Act § 2(c), 15 U.S.C. § 1052(c) claim that mark comprises name of opposer without his consent in view of personal nature of claim with no overriding public interest precluding assertion of equitable defenses); *Treadwell's Drifters Inc. v. Marshak*, 18 USPQ2d 1318, 1320 (TTAB 1990) (equitable defenses can be asserted against Trademark Act § 2(a), 15 U.S.C. § 1052(a) claim of "false suggestion of a connection").

8. *Morehouse Manufacturing Corp. v. J. Strickland and Co.*, 407 F.2d 881, 160 USPQ 715, 717 (CCPA 1969); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989).

9. *See Green Spot (Thailand) Ltd. v. Vitasoy International Holdings Ltd.*, 86 USPQ2d 1283, 1285 (TTAB 2008) (doctrine of foreign equivalents does not apply with respect to *Morehouse* analysis); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (*Morehouse* defense is unavailable where issue is

abandonment, descriptiveness, or fraud); *Bausch & Lomb Inc. v. Leupold & Stevens Inc.*, 1 USPQ2d 1497, 1499 (TTAB 1986) (*Morehouse* defense inapplicable where opposition based on claims of ornamentation and fraud).

10. *See Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1738 (TTAB 2001). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d1311, 1313-14 (TTAB 1989) (*Morehouse* defense is unavailable where issue is abandonment, descriptiveness or fraud).

11. *See, e.g., KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 72 USPQ2d 1833, 1836 (2004).

12. *See Truescents LLC v. Ride Skin Care LLC*, 81 USPQ2d 1334, 1338 (TTAB 2006); *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445, 1454 (TTAB 1986).

13. *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1298 (TTAB 2010). *See also Research in Motion Limited v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1188 (TTAB 2012) (Board will assess alleged parody as part of the circumstances in determining whether plaintiff has made out its claim).

14. *See* Fed. R. Civ. P. 8(d)(1).

15. *See IdeasOne Inc. v. Nationwide Better Health Inc.*, 89 USPQ2d 1952, 1953 (TTAB 2009) (Trademark Act § 18, 15 U.S.C. § 1068 claim or defense must be specific enough to provide fair notice to adverse party of restriction being sought); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (attempt to tack use of mark alleged to be legally equivalent to mark at issue is denied because adverse party not put on notice in pleading that owner of mark would attempt to prove priority through tacking); *Fair Indigo LLC v. Style Conscience*, 85 USPQ2d 1536, 1538 (TTAB 2007) (elements of each claim should include enough detail to give fair notice of claim); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1292 (TTAB 1999) (primary purpose of pleadings "is to give fair notice of the claims or defenses asserted"); *Cf. Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1864 (TTAB 2007) (bald allegations of misrepresentation of source did not provide fair notice); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (where applicant not given fair notice of opposer's reliance on registration that issued after filing of complaint, unpleaded registration given no consideration); *McDonnell Douglas Corp. v. National Data Corp.*, 228 USPQ 45, 47 (TTAB 1985) (bald allegations in the language of the statute, did not provide fair notice of basis of petitioner's Trademark Act § 2(a), 15 U.S.C. § 1052(a) claim).

16. *See* 37 CFR § 2.106(b)(2) and 37 CFR § 2.114(b)(2); *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938, 1940 (Fed. Cir. 2009); *Enbridge, Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1540 (TTAB 2009); *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1478 (TTAB2009).

17. *See* Fed. R. Civ. P. 8(d)(2) and (3). *Cf. Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1698 (TTAB 1987) (applicant could have raised priority issue in a counterclaim by pleading likelihood of confusion hypothetically notwithstanding the inconsistency of that pleading with its position in the opposition that the marks are not confusingly similar); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 899 (TTAB 1986) (pleading construed as hypothetical pleading of likelihood of confusion which is appropriate where petitioner's standing is based on its inability to secure a registration, albeit it is the senior user, because the subject registration has been cited as a reference by the examining attorney). *Cf. also Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156-57 (TTAB 1975) (fact that petitioner argued before examining attorney that its mark and that of respondent were not confusingly similar does not preclude petitioner from asserting

likelihood of confusion as ground for cancellation); *Revco, D.S., Inc. v. Armour-Dial, Inc.*, 170 USPQ 48, 49 (TTAB 1971) (in seeking to cancel on ground of abandonment, plaintiff asserted proper hypothetical pleading of likelihood of confusion as its basis for standing).

18. *Cf.* 37 CFR § 2.133(b).

19. *See* Fed. R. Civ. P. 8(d)(2).

20. *See McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959).

21. *See* 37 CFR § 2.106(b)(3)(i), 37 CFR § 2.106(b)(3)(ii), 37 CFR § 2.114(b)(3)(i) and 37 CFR § 2.114(b)(3)(ii); *Nasalok Coating Corp. v. Nylok Corp.*, 522 F.3d 1320, 86 USPQ2d 1369, 1373 n.3 (Fed. Cir. 2008); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (allegedly admitted periods of nonuse by opposer disregarded in absence of counterclaim to cancel registration); *Contour Chair-Lounge Co. v. The Englander Co.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition had been dismissed); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986); *Textron, Inc. v. The Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (defense attacking validity of pleaded registration must be raised by way of cancellation of registration). *Cf. Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 n.5 and n.12 (TTAB 2006) (a showing of descriptiveness or genericness of part of a mark does not constitute a collateral attack on the registration; however arguments directed to show opposer failed to exercise control over logo mark, where only word mark registration was challenged, constitutes impermissible attack on logo mark). *See also Clorox Co. v. State Chemical Manufacturing Co.*, 197 USPQ 840, 844 (TTAB 1977); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975).

22. *See* 37 CFR § 2.133(d); *Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1287 (TTAB 1998) (applicant's request raised in reply brief for a restriction of opposer's registration [beyond applicant's initial counterclaim to restrict] was untimely as it should have been raised by promptly moving to amend). *But see Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1186 (TTAB 2014) (motion to amend to add counterclaims prior to plaintiff's testimony was granted in prior Board order).

23. *See* 37 CFR § 2.99(h) and 37 CFR § 2.133(c). *See also Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1815 (TTAB 1990).

24. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

25. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

26. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1220 (TTAB 1990); *Continental Gummi-Werke AG v. Continental Seal Corp.*, 222 USPQ 822, 825 (TTAB 1984) (motion to strike affirmative defense predicated on same facts alleged in counterclaim granted as representing, in effect, a collateral attack on registration); *W. R. Grace & Co. v. Arizona Feeds*, 195 USPQ 670, 671 (Comm'r 1977) (motion to strike affirmative defense which allegations formed basis for counterclaim granted since, although Board did not find that applicant was attempting to collaterally attack registration, the affirmative defense was repetitious and unnecessary).

27. Trademark Act 43(c)(6)(B), 15 U.S.C. § 1125(c)(6)(B). *See also Academy of Motion Picture Arts and Sciences v. Alliance of Professionals & Consultants Inc.*, 104 USPQ2d 1234 (TTAB 2012).

311.02(c) Unpleaded Affirmative Defenses

Except as provided in Fed. R. Civ. P. 12(b) and 12(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 Fed. R. Civ. P. 15(a) or 15(b), to assert the matter. [Note 1.]

For additional information concerning unpleaded matters, *see* TBMP § 314.

NOTES:

1. *See* Fed. R. Civ. P. 8(b), 8(c), and 12(b); Trademark Act § 19, 15 U.S.C. § 1069. *See also Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (unpleaded prior registration defense not considered on summary judgment); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana, Inc.*, 98 USPQ2d 1921, 1926 (TTAB 2011) (unpleaded affirmative defenses of prior registration defense and tacking not considered), *aff'd* __F. Supp. 3d __, 2016, , No. 1:11-cv-01623-RC (D.D.C. May 27, 2016); *H.D. Lee Co. v. Maidenform Inc.*, 87 USPQ2d 1715, 1720 (TTAB 2008) (the reason for requiring an affirmative defense to be pleaded is to give the plaintiff notice of the defense and an opportunity to respond; defense of tacking must be pleaded to put opposer on notice of new matter that applicant is placing at issue); *Diaz v. Servicios De Franquicia Pardo's S.A.C.*, 83 USPQ2d 1320, 1322 (TTAB 2007) (answer deemed amended to assert applicant's priority over opposer pursuant to Article 7 of the Pan American Convention); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1290 (TTAB 2007) (applicant's affirmative defense deemed to have been tried by the implied consent of the parties); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense that opposer lacks proprietary rights in its common law mark raised for first time in final brief was neither pleaded nor tried); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 341 (TTAB 1984) (laches is an affirmative defense which must be specifically pleaded); *Trans Union Corp. v. Trans Leasing International, Inc.*, 200 USPQ 748, 754 (TTAB 1978) (defense of laches, which was raised by applicant in its final brief, was not pleaded in answer but was tried by implied consent of opposer); *United States Mineral Products Co. v. GAF Corp.*, 197 USPQ 301, 304 n.5 (TTAB 1977) (the equitable defenses set forth in Trademark Act § 19, 15 U.S.C. § 1069 are affirmative defenses which must be affirmatively pleaded and in this case were neither pleaded nor tried); *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 USPQ 585, 590 (TTAB 1977) (laches, while not affirmatively pleaded, was nevertheless tried and briefed by both parties without objection); *Hershey Foods Corp. v. Cerreta*, 195 USPQ 246, 251 (TTAB 1977) (laches and acquiescence were neither pleaded nor tried); *Taffy's of Cleveland, Inc. v. Taffy's, Inc.*, 189 USPQ 154, 156 (TTAB 1975) (laches is affirmative defense that must be pleaded in order to be considered).

311.02(d) Other Affirmative Pleadings - Amplifying Denials

An answer may include affirmative assertions that, 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. [Note 1.]

NOTES:

1. *See Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1637-38 (TTAB 2011) (affirmative defense of secondary meaning interpreted to be an elaboration of respondent's denial of petitioner's allegation that the term is disparaging); *Morgan Creek Productions Inc. v. Foria International Inc.*, 91 USPQ2d 1134, 1136 (TTAB 2009) (applicant's "affirmative defenses" for the most part amplified its denials of opposer's allegations regarding likelihood of confusion); *Order of Sons of Italy in America v. Profumi Fratelli Nostra AG*, 36 USPQ2d 1221, 1223 (TTAB 1995) (motion to strike third affirmative defense denied because it was an amplification of a denial, giving fuller notice of the claim); *Humana Inc. v. Humanomics Inc.*, 3 USPQ2d 1696, 1697 n.5 (TTAB 1987) (allegations under heading "affirmative defenses" were in the nature of arguments in support of denial of claim rather than true affirmative defenses and were treated as such); *Maytag Co. v. Luskin's, Inc.*, 228 USPQ 747, 747 n.3 (TTAB 1986) (same); *Textron, Inc. v. Gillette Co.*, 180 USPQ 152, 153 (TTAB 1973) (denying motion to strike paragraph in answer which amplified applicant's denial and provided opposer with fuller notice of applicant's defense); *McCormick & Co. v. Hygrade Food Products Corp.*, 124 USPQ 16, 17 (TTAB 1959) (allegation that registered mark is weak does not constitute a collateral attack on validity of opposer's registrations). *Cf. Harsco Corp. v. Electrical Sciences Inc.*, 9 USPQ2d 1570, 1572 (TTAB 1988).

311.03 Reply to Answer Should Not be Filed

Although 37 CFR § 2.106(b) and 37 CFR § 2.114(b) require that an answer to a counterclaim be filed, within the time designated by the Board, they specifically provide that a reply to an affirmative defense need not be filed. [Note 1.] Similarly, Fed. R. Civ. P. 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 "[o]nly these pleadings are 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.

NOTES:

1. *See* 37 CFR § 2.106(b)(2), 37 CFR § 2.106(b)(3)(iii), 37 CFR § 2.114(b)(2) and 37 CFR § 2.114(b)(3)(iii).

312 Default

312.01 In General

37 CFR § 2.106(a) *If no answer is filed within the time initially set, or as may later be reset by the Board, the opposition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.*

37 CFR § 2.114(a) *If no answer is filed within the time initially set, or as may later be reset by the Board, the petition may be decided as in case of default. The failure to file a timely answer tolls all deadlines, including the discovery conference, until the issue of default is resolved.*

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 neither an answer nor any extension of time to answer has been filed; that notice of default under Fed. R. Civ. P. 55(a) is entered; and that defendant is allowed 30 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 that does not show good cause, default judgment may be entered against it. [Note 1.] *Cf.* TBMP § 508.

If the defendant fails to file a response to the notice, or files a response which does not show good cause in a case where the plaintiff is seeking to partially cancel a registration or partially oppose an application under Trademark Act § 18, 15 U.S.C. § 1068, default judgment will be entered only to the extent that the restriction requested by plaintiff will be entered. [Note 2.]

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. [Note 3.] *Cf.* TBMP § 508. 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 Fed. R. Civ. P. 55(c) standard, that is, whether the defendant has shown good cause why default judgment should not be entered against it. [Note 4.]

When a defendant who 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 late 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 its copy of the complaint, and its copy of the 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.

In the case where a notice of default has not yet issued and a defendant files a late answer, a party is technically in default. [Note 5.] If the parties have continued to litigate after a late-filed answer, it will generally be viewed as a waiver of the technical default. [Note 6.]

Please Note: In instances where the defendant is in default, the parties' obligations to conference and, subsequently, to make initial disclosures are stayed until the issue of default is resolved. [Note 7.] If default is set aside, the Board will reset the deadline for the discovery conference as well as all subsequent dates. [Note 8.] For more information regarding the parties' obligations with respect to initial disclosures and the discovery conference, *see* TBMP § 401.01, TBMP § 401.02, TBMP § 408.01(a), and TBMP § 408.01(b).

NOTES:

1. *See* 37 CFR § 2.106(a) and 37 CFR § 2.114(a); Fed. R. Civ. P. 55(a), 55(b) and 55(c); *DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990); *Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977).

2. *See Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co.* KG, 34 USPQ2d 1266, 1275 n.4 (TTAB 1994) (concurring opinion). *Cf. Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997) (where registrant defaulted in case involving petition to partially cancel registration to delete certain items identified therein on ground of abandonment and registration was cancelled in its entirety, Board, while noting that it may have been error to order cancellation of registration in its entirety, declined to set aside order, finding that default was properly entered and therefore not "void" under Fed. R. Civ. P. 60(b)(4)).

3. *See, e.g., DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (motion for default judgment); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990) (plaintiff's motion for default judgment and defendant's motion to accept late answer); *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (motion to accept late answer filed before notice of default issued).

4. *See, e.g., Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (motion to accept late answer filed before notice of default issued was treated as response to notice of default). *See also DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1902 (Comm'r 1990).

5. *DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1223 n.4 (TTAB 2000).

6. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (October 7, 2016).

7. 37 CFR § 2.106(a) and 37 CFR § 2.114(a); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952 (October 7, 2016).

8. 37 CFR § 2.106(b)(3)(iv); 37 CFR § 2.114(b)(3)(iv); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42255 (August 1, 2007).

312.02 Setting Aside Notice of Default

If a defendant who 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. [Note 1.] 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. [Note 2.] The showing of a meritorious defense does not require an evaluation of the merits of the case. All that is required is a plausible response to the allegations in the complaint. [Note 3.]

The determination of whether default judgment should be entered against a party lies within the sound discretion of the Board. [Note 4.] 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. [Note 5.]

NOTES:

1. *See* Fed. R. Civ. P. 55(c).

2. *See DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (willful conduct shown where although applicant may not have intended that proceedings be resolved by default, applicant

admittedly intended not to answer for six months); *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1903-04 (Comm'r 1990) (no evidence that failure was willful; costs incurred in preparing and filing motion not sufficient to support finding of prejudice); *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) (failure to answer due to inadvertence on part of applicant's counsel; answer had been prepared and reviewed by applicant but counsel inadvertently failed to file it; nine-day delay would cause minimal prejudice; by submission of answer which was not frivolous meritorious defense was shown). *Cf.* regarding a motion to set aside judgment under Fed. R. Civ. P. 60(b), *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (the two other factors having been shown, applicant was allowed time to show meritorious defense by submission of answer).

3. *See DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000).

4. *See, e.g., Identicon Corp. v. Williams*, 195 USPQ 447, 449 (Comm'r 1977) (fact that in response to order to show cause applicant filed answer but no response to show cause order does not mandate entry of default judgment; applicant allowed time to show cause).

5. *See DeLorme Publishing Co v. Eartha's Inc.*, 60 USPQ2d 1222, 1224 (TTAB 2000) (although no specific prejudice to opposer, and while meritorious defense was shown, Board found applicant's conduct amounted to gross neglect and granted motion for default judgment where applicant filed its answer six months late, viewing the notice of opposition as "incomplete," instead of filing appropriate motion or taking other appropriate action).

312.03 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 on a showing of good cause. [Note 1.] *See* TBMP § 312.02. However, once default judgment has actually been entered against a defendant pursuant to Fed. R. Civ. P. 55(b), the judgment may be set aside only in accordance with Fed. R. Civ. P. 60(b), which governs motions for relief from final judgment. The stricter standard reflects public policy favoring finality of judgments and termination of litigation. [Note 2.]

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 Fed. R. Civ. P. 55. [Note 3.] 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. [Note 4.]

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. [Note 5.]

Nevertheless, because default judgments for failure to timely answer the complaint are not favored by the law, a motion under Fed. R. Civ. P. 55(c) or 60(b) seeking relief from such a judgment is generally treated with more liberality by the Board than are other motions under Fed. R. Civ. P. 60(b) for relief from other types of judgments such as default judgments entered against plaintiffs for failure to prosecute the case. [Note 6.]

For information concerning motions under Fed. R. Civ. P. 60(b) for relief from final judgment, *see* TBMP § 544.

NOTES:

1. *See* Fed. R. Civ. P. 55(c).

2. *See Waifersong Ltd. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632, 1634 (6th Cir. 1992); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997).

3. Compare *Paolo's Associates L.P. v. Bodo*, 21 USPQ2d 1899, 1902-03 (Comm'r 1990), and *Fred Hayman Beverly Hills, Inc. v. Jacques Bernier, Inc.*, 21 USPQ2d 1556, 1557 (TTAB 1991) both of which involved the question whether default judgment should be entered against defendant, *with Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991), and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1156 (TTAB 1991) both involving relief from default judgment. *See also* 10A C.WRIGHT, A. MILLER& M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 2692 (4th ed. 2017); *Waifersong Ltd. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632, 1634 (6th Cir. 1992).

4. *See Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997) (motion based on alleged failure to receive correspondence from the Board denied given presumption of receipt of correspondence, passage of 12 years and resulting hardship to third parties); *Djeredjian v. Kashi Co.*, 21 USPQ2d 1613, 1615 (TTAB 1991) (motion granted pending showing of meritorious defense where other two elements were established); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1155-56 (TTAB 1991) (motion granted; respondent's employees had limited knowledge of English and were unaware opposition and cancellation were separate proceedings).

5. *See Waifersong Ltd. v. Classic Music Vending*, 976 F.2d 290, 24 USPQ2d 1632, 1633 (6th Cir. 1992) (while the factors are similar, the methodology for considering the factors in deciding motion under Fed. R. Civ. P. 60(b)(1) and the weight to be accorded them differs); *Jack Lenor Larsen Inc. v. Chas. O. Larson Co.*, 44 USPQ2d 1950, 1952 (TTAB 1997) (a significant factor is the hardship that reopening a judgment may cause to others and whether other actions have been taken in reliance on the judgment); 10A C.WRIGHT, A. MILLER& M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 2692 (4th ed. 2017).

6. *See Information System and Networks Corp. v. United States*, 994 F.2d 792, 795 (Fed. Cir. 1993) ("Rule 60(b) is applied most liberally to judgments in default.") (quoting *Seven Elves, Inc. v. Eskenazi*, 635 F.2d 396, 403 (5th Cir. 1981)); *Ruiz v. Quarterman*, 504 F.3d 523, 532 (5th Cir. 2007) ("[T]his lesser standard of review has been applied most liberally to motions to re-open default judgments").

Compare Djeredjian v. Kashi Co., 21 USPQ2d 1613, 1615 (TTAB 1991) and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154, 1155 (TTAB 1991) both of which involved default judgments for failure to answer, *with CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1303 (TTAB 1999) (motion to set aside judgment denied since opposer is equally as accountable as its counsel for lack of attention to case); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982) (motion to set aside judgment against opposer for failure to prosecute denied; incompetent attorney); *Marriott Corp. v. Pappy's Enterprises, Inc.*, 192 USPQ 735, 736 (TTAB 1976) (motion to set aside judgment for failure to prosecute denied; inattention and carelessness not excusable); *Williams v. Five Platters, Inc.*, 181 USPQ 409, 410 (TTAB 1974) (motion to set aside default judgment for failure to respond to motion for summary judgment denied; carelessness and inattention of counsel), *aff'd*, 510 F.2d 963, 184 USPQ 744 (CCPA 1975). *See also Smart Inventions Inc. v. TMB Products LLC*, 81 USPQ2d 1383, 1384 (TTAB 2006) (cancellation respondent's motion to set aside default judgment on ground that it never received actual

or constructive notice of proceeding granted under Fed. R. Civ. P. 60(b)(4) where assignment of mark to respondent recorded before proceeding instituted but notification of proceeding sent to prior owner); 10A C.WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE Civil § 2693 (4th ed. 2017).

313 Counterclaims

313.01 In General

37 CFR § 2.106(b)(3)

(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.*

(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.*

(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 by the Board within which an answer to the counterclaim must be filed.*

(iv) *The times for pleading, discovery, testimony, briefs or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

37 CFR § 2.114(b)(3)

(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the party in position of respondent and counterclaim plaintiff must promptly inform the Board, in the context of the primary cancellation proceeding, of the filing of the other proceeding.*

(ii) *An attack on the validity of a registration pleaded by a petitioner for cancellation 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 by the Board within which an answer to the counterclaim must be filed. Such response period may be reset as necessary by the Board, for a time period to be determined by the Board.*

(iv) *The times for pleading, discovery, testimony, briefs, or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

The Board cannot entertain an attack upon the validity of a registration pleaded by a plaintiff unless the defendant timely files a counterclaim or a separate petition to cancel the registration. [Note 1.]

Although 37 CFR § 2.106(b)(3)(ii) and 37 CFR § 2.114(b)(3)(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. [Note 2.]If the defense is raised as a separate petition to cancel, however, the petition itself and any cover letter should include a reference to the original proceeding. Further, a defendant that 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. [Note 3.] *See also* TBMP § 313.04.

The only type of counterclaim that may be entertained by the Board is a counterclaim for cancellation of a registration owned by an adverse party. [Note 4.]

As provided in Trademark Act § 18, 15 U.S.C. § 1068, a counterclaim may seek to cancel a registration in whole or in part, or to restrict or rectify with respect to the register the registration in some manner. For example, the counterclaimant may seek to cancel the registration only as to some of the listed goods or services, 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). [Note 5.] *See* TBMP § 309.03(d). In order to restrict or rectify the register, a counterclaimant may seek to have a description or a disclaimer entered. [Note 6.] *See* TBMP § 309.03(d). However, geographic limitations will be considered and determined by the Board only within the context of a concurrent use registration proceeding. [Note 7.] *See* TBMP Chapter 1100. A counterclaim to partially cancel a registration by deleting some of the goods or services therein, or by restricting the manner of use of the goods or services therein, or to restrict or rectify the register as to the registration in order to avoid a likelihood of confusion, is in the nature of an equitable remedy and does not constitute an attack on the validity of a registration or have to be tied to a properly pleaded ground for opposition or cancellation. [Note 8.] *See* TBMP § 309.03(d). The counterclaimant must allege that the partial cancellation will avoid a likelihood of confusion, i.e., that it will be commercially significant, and that the registrant does not use the mark on the goods or services for which deletion is being sought. [Note 9.] On the other hand, a counterclaim to delete goods or services from the registration on the ground that registrant does not use the mark on those goods or services and has no intent to resume use, without regard to likelihood of confusion, is a straightforward abandonment claim and not a claim under Trademark Act § 18, 15 U.S.C. § 1068 and in such case, counterclaimant need not allege that a likelihood of confusion will be avoided through the restriction. [Note 10.]

A counterclaim is the legal equivalent of a petition to cancel. Thus, the provisions of 37 CFR § 2.111-37 CFR § 2.115 , governing petitions to cancel, are applicable to counterclaims, including filing the counterclaim electronically through ESTTA. [Note 11.] Because it is not an initial pleading commencing the proceeding, in the rare instance that a counterclaim is filed in paper, accompanied by a showing that ESTTA is unavailable due to technical problems, or when extraordinary circumstances are present, a Petition to the Director is not required.

In instances where a counterclaim has been filed, the Board will set the time for answer thereto, as well as reset the deadline for the discovery conference, for making initial disclosures, and all subsequent dates. [Note 12.] *See* TBMP § 401.01 - TBMP § 401.03. 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 (including conferencing and initial and expert disclosure dates), pretrial disclosures, testimony, briefs and/or oral argument will be reset or extended. A party that believes that such a resetting or extension is necessary should file a motion therefor with the Board; however, the Board may reset such deadlines as it may deem necessary. [Note 13.] *See also* TBMP § 509, regarding motions to extend.

NOTES:

1. *See* 37 CFR § 2.106(b)(3)(ii) and 37 CFR § 2.114(b)(3)(ii); *Food Specialty Co. v. Standard Products Co.*, 406 F.2d 1397, 161 USPQ 46, 46 (CCPA 1969); *Gillette Co. v. "42" Products Ltd., Inc.*, 396 F.2d 1001, 158 USPQ 101, 104 (CCPA 1968) (since no counterclaim had been filed, Court disregarded applicant's claims that opposer had admitted periods of nonuse); *Contour Chair-Lounge Co. v. The Englander Co.*, 324 F.2d 186, 139 USPQ 285, 287 (CCPA 1963) (improper for Board to allow applicant to collaterally attack registration in opposition where, although registration had been directly attacked by applicant in separate petition to cancel, said petition to cancel had been dismissed); *Skincode AG v. Skin Concept AG*, 109 USPQ2d 1325, 1329 n.5 (TTAB 2013) (absent a counterclaim, applicant's argument regarding the possible connotation of the Swiss flag is an impermissible collateral attack on opposer's pleaded registration); *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1174 n.17 (TTAB 2011) (plaintiff's mark is registered without either a disclaimer of the term at issue or a claim of acquired distinctiveness, and there is no counterclaim so Board cannot entertain any attack on the term as being merely descriptive); *Fort James Operating Co. v. Royal Paper Converting Inc.*, 83 USPQ2d 1624, 1626 n.1 (TTAB 2007) (applicant's contentions in its brief that opposer's marks are functional, non-distinctive, and lack source-indicating significance constitute an impermissible collateral attack on opposer's pleaded registrations, and cannot be considered absent a counterclaim for cancellation); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007) (defendant's argument that plaintiff's registered marks are descriptive may be considered only in timely counterclaim or separate petition to cancel, but Board will consider defendant's position to extent it goes to the strength of plaintiff's mark in view of use of term by others); *Chicago Bears Football Club, Inc. and NFL Properties LLC v. 12th Man/Tennessee LLC*, 83 USPQ2d 1073, 1083 (TTAB 2007) (applicant cannot argue that opposers' pleaded registrations are functional without counterclaiming or petitioning to cancel the marks on this basis); and *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 229 USPQ 955, 961 (TTAB 1986). *See also Tea Board of India v. Republic of Tea Inc.*, 80 USPQ2d 1881, 1884 nn.5 and 12 (TTAB 2006) (a showing of descriptiveness or genericness of part of a mark does not constitute a collateral attack on the registration; however arguments directed to show opposer failed to exercise control over logo mark, where only word mark registration was challenged, constitutes impermissible attack on logo mark).

2. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

3. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989).

4. *See UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1873 (TTAB 2011) (scope of applicant's request, to restrict all of opposer's registrations, pending applications, and future applications, is in the nature of an injunction and not considered); *Pyttronic Industries Inc. v. Terk Technologies Corp.*, 16 USPQ2d 2055, 2056 n.2 (TTAB 1990) (counterclaim to cancel "any registration which might issue in the future from pleaded application" stricken as improper); *International Telephone and Telegraph Corp. v. International Mobile Machines Corp.*, 218 USPQ 1024, 1026 (TTAB 1983) (counterclaim to "refuse any application filed by petitioner" was improper).

5. *See* Trademark Act § 18, 15 U.S.C. § 1068; 37 CFR § 2.111(b) and 37 CFR § 2.133(b).

6. *See Montecash LLC v. Anzar Enterprises, Inc.*, 95 USPQ2d 1060, 1063 (TTAB 2010) (partial cancellation on the ground that portion of the mark is a generic term unavailable where the registration sought to be cancelled is more than 5 years old); *Dak Industries, Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995) ("a claim for cancellation by restriction or modification …is an equitable remedy …, not tied to a ground to cancel").

7. *See* 37 CFR § 2.99(h) and 37 CFR § 2.133(c); *Snuffer & Watkins Management Inc. v. Snuffy's Inc.*, 17 USPQ2d 1815, 1816 (TTAB 1990).

8. *See Dak Industries, Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995) ("a claim for cancellation by restriction or modification …is an equitable remedy …, not tied to a ground to cancel"); *Eurostar, Inc. v. "Euro-Star" Reitmoden GmbH & Co. KG*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1995) ("[t]he restriction provisions of Section 18 are in the nature of an equitable remedy"). *See also, e.g., Penguin Books Ltd. v. Eberhard*, 48 USPQ2d 1280, 1286 (TTAB 1998) (counterclaim to partially cancel pleaded registration to restrict scope of goods therein did not preclude opposer's reliance on pleaded registration to establish priority in the opposition).

9. *See Board of Regents, University of Texas System v. Southern Illinois Miners, LLC*, 110 USPQ2d 1182, 1198 (TTAB 2014) (proposed restrictions found not commercially significant because entry thereof would not avoid finding of likelihood of confusion, and "fairness" does not "demand" such restriction); *Eurostar Inc. v. "Euro-Star" Reitmoden Gmbh & Co.*, 34 USPQ2d 1266, 1271 n.3 (TTAB 1995). *Cf. Embarcadero Technologies, Inc. v. RStudio, Inc.*, 105 USPQ2d 1825 (TTAB 2013) (successful use of Section 18 as an affirmative defense to a claim of likelihood of confusion in an opposition; amended applications allowed to proceed to registration).

10. *See Johnson & Johnson v. Obschestvo s Ogranitchennoy*, 104 USPQ2d 2037, 2038 n.2, 2039 (TTAB 2012) (counterclaim seeking partial cancellation as to only three of the items identified in the class based on abandonment due to nonuse without an intent to resume use is a counterclaim of abandonment sufficiently stated notwithstanding reference to Section 18) *; DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437-38 (TTAB 1995) (party may seek partial cancellation of a registration based on a theory of abandonment as to discrete goods and services without the need to resort to Section 18).

11. *See* 37 CFR § 2.106(b)(3)(iii) and 37 CFR § 2.114(b)(3)(iii); 37 CFR § 2.111(c).

12. *See* 37 CFR § 2.106(b)(3)(iii) and 37 CFR § 2.114(b)(3)(iii). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42255 (August 1, 2007) ("In short, there are many potential triggers that will prompt the Board to reset discovery, disclosure and trial dates").

13. *See* 37 CFR § 2.106(b)(3)(iv) and 37 CFR § 2.114(b)(3)(iv).

313.02 Fee For Counterclaim

37 CFR § 2.106(b)(3)(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 by the Board within which an answer to the counterclaim must be filed.*

37 CFR § 2.114(b)(3)(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 by the Board within which an answer to the counterclaim must be filed. Such response period may be reset as necessary by the Board, for a time period to be determined by the Board.*

37 CFR § 2.111(d) *The petition for cancellation must be accompanied by the required fee for each party joined as petitioner for each class in the registration(s) for which cancellation is sought (see § 2.6).*

* * * *

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. [Note 1.] That is, the required fee (see 37 CFR § 2.6) 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. [Note 2.] *Cf.* TBMP§ 308.02.

A counterclaim must be filed via ESTTA, which requires the petition to cancel to include a fee sufficient to pay in full for each named petitioner and for each class sought to be cancelled in the registration, as specified in the petition. [Note 3.] In the rare instances that a counterclaim petition to cancel is submitted in paper form, if no fee is submitted with the counterclaim, or the fee is insufficient to pay in full for each named petitioner and for each class in the registrations for which cancellation is sought, the counterclaim may not be instituted. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.106(b)(3)(iii); 37 CFR § 2.114(b)(3)(iii); and 37 CFR § 2.111(d); *Williamson-Dickie Manufacturing Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518, 520 (CCPA 1966) (payment of fee is necessary to give Board jurisdiction); *Aries Systems Corp. v. World Book Inc.*, 23 USPQ2d 1742, 1748 (TTAB 1992), *summ. judgment granted in part*, 26 USPQ2d 1926 (TTAB 1993) (same); *Sunway Fruit Products, Inc. v. Productos Caseros, S. A*, 130 USPQ 33, 33 (Comm'r 1960) (requirement for fee is statutory and cannot be waived). *Cf. Fred Beverages, Inc. v. Fred's Capital Management Co.*, 605 F.3d 968, 94USPQ2d 1958, 1960 (Fed. Cir. 2010) (Board's decision denying petitioner's motion for leave to amend cancellation petition because petitioner did not pay fee for amendment at time of filing the motion, reversed; case remanded to Board for further consideration of motion to amend.)

2. *See* 37 CFR § 2.111(d) and 37 CFR § 2.112(b) .

3. *See* 37 CFR § 2.111(d) and 37 CFR § 2.112(b) .

4. *See* 37 CFR § 2.111(d) and 37 CFR § 2.112(b) .

313.03 Form and Substance of Counterclaim; Service of Counterclaim

37 CFR §2.119 ***Service and signing.***

(a) *Except for the notice of opposition or the petition to cancel, every submission filed in the Office in inter partes cases, … must be served upon the other party or parties.*

* * * *

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 § 309.02). 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.

A counterclaimant must serve a copy of the counterclaim (with any exhibits thereto) on every other party to the proceeding, and must make proof of such service before the Board will consider the counterclaim. [Note 1.]

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. [Note 2.]

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 that are not in the nature of a counterclaim. Trademark Act § 14, 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 on 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 on which a counterclaim may be based. [Note 3.]

The counterclaim plaintiff must identify the particular registrations for which it seeks a cancellation or restriction where more than one registration is asserted. If the petition to cancel does not identify the registration(s) when filing in ESTTA, the Board may look to the ESTTA cover sheet to determine the registration(s) sought to be cancelled. [Note 4.]

NOTES:

1. *See* 37 CFR § 2.119(a).

2. *See Finanz St. Honore B.V. v. Johnson & Johnson*, 85 USPQ2d 1478, 1479 (TTAB 2007); *Carefirst of Maryland, Inc. v. FirstHealth of the Carolinas Inc.*, 77 USPQ2d 1492, 1502 (TTAB 2005); *Ohio State University v. Ohio University*, 51 USPQ2d 1289, 1293 (TTAB 1999); *Ceccato v. Manifattura Lane Gaetano Marzotto & Figli S.p.A.*, 32 USPQ2d 1192, 1195 n.7 (TTAB 1994); *Syntex (U.S.A.) Inc. v. E.R. Squibb & Sons Inc.*, 14 USPQ2d 1879, 1880 (TTAB 1990) (finding of no likelihood of confusion in the opposition did not remove defendant's standing to counterclaim for abandonment); *Bankamerica Corp. v. Invest America*, 5 USPQ2d 1076, 1078 (TTAB 1987) (defendant seeking to cancel pleaded registration on ground of descriptiveness or genericness in an opposition based on likelihood of confusion need not allege that it has an interest in using the term sought to be cancelled); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 95 (TTAB 1984) (counterclaimant clearly has personal stake in the controversy); *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 856 (TTAB 1981) (damage assumed, and with properly pleaded ground is sufficient to place validity of registration in issue); *General Mills, Inc. v. Nature's Way Products*, 202 USPQ 840, 841 (TTAB 1979).

3. *See, e.g., Williamson-Dickie Manufacturing Co. v. Mann Overall Co.*, 359 F.2d 450, 149 USPQ 518, 522 (CCPA 1966); *UMC Industries, Inc. v. UMC Electronics Co.*, 207 USPQ 861, 862 n.3 (TTAB 1980) (grounds not limited where petition to cancel registration pleaded in opposition was not filed until after fifth anniversary date of registration, because opposition wherein opposer relied on registration was filed before anniversary date); *Humble Oil & Refining Co. v. Sekisui Chemical Co. Ltd. of Japan*, 165 USPQ 597, 598 n.4 (TTAB 1970) (grounds were not limited where, although counterclaim to cancel pleaded registration was not properly filed until after fifth anniversary date of registration, opposition wherein opposer relied on said registration was filed before anniversary date); *Sunbeam Corp. v. Duro Metal Products Co.*, 106 USPQ 385, 386 (Comm'r 1955). *See also* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 20:67 (2017). *Cf. Ashland Licensing & Intellectual Property LLC v. Sunpoint International Group USA Corp.*, 119 USPQ2d 1125, 1128, 1130 (TTAB 2016) (the commencement of a cancellation proceeding prior to the fifth-year anniversary of the registration tolls Trademark Act Section

14 for the purpose of petitioner adding claims against the registration during the pendency of the Board proceeding); regarding concurrent use proceedings, *Arman's Systems, Inc. v. Armand's Subway, Inc.*, 215 USPQ 1048, 1050 (TTAB 1982) (5-year period tolled where applicant, prior to expiration of 5-year period files a proper concurrent application or an amendment converting an unrestricted application to one seeking concurrent use naming registrant as exception to applicant's right to exclusive use).

4. *UMG Recordings Inc. v. Mattel Inc.*, 100 USPQ2d 1868, 1872-73 (TTAB 2011) (applicant paid two fees for a counterclaim but did not identify the registrations in the attached counterclaim, only indicating on the ESTTA cover sheet one registration,the Board found that the counterclaim pertained to only one registration based on the ESTTA cover sheet).

313.04 Compulsory Counterclaims

37 CFR § 2.106(b)(3)(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the applicant must promptly inform the Board, in the context of the opposition proceeding, of the filing of the other proceeding.*

37 CFR § 2.114(b)(3)(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 the claim is the subject of another proceeding between the same parties or anyone in privity therewith; but the party in position of respondent and counterclaim plaintiff must promptly inform the Board, in the context of the primary cancellation proceeding, of the filing of the other proceeding.*

Counterclaims for cancellation of pleaded registrations in Board proceedings are governed by 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i). [Note 1.] If the defendant knows the grounds for a counterclaim to cancel a pleaded registration when the answer is filed, the counterclaim must be pleaded with or as part of the answer. [Note 2.] If grounds are learned during the course of the proceeding, through discovery or otherwise, the counterclaim must be pleaded promptly after the grounds therefor are learned. [Note 3.] The counterclaim must be filed in ESTTA. [Note 4.]

A defendant who 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, on motion, on the ground that the substance of the petition constitutes a compulsory counterclaim in another proceeding, and that it was not timely asserted. [Note 5.]

If a defendant confronted with a motion for summary judgment knows of grounds for a counterclaim that 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. [Note 6.]

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 on 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 the defendant knows grounds for cancellation of a plaintiff's unpleaded registration when the defendant files its answer, the defendant is under no compulsion to seek to cancel the registration unless and until the plaintiff pleads the registration. [Note 7.]

If the parties or their privies are involved in another proceeding involving the same claims that could be the subject of a counterclaim in the opposition or the primary cancellation proceeding, the Board must be promptly notified in the opposition or primary cancellation proceeding. [Note 8.]

NOTES:

1. *See* 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i). *See also TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1313 (TTAB 1989) (although parties referred to the "when justice requires" element of Fed. R. Civ. P. 13(f), counterclaims to cancel pleaded registrations in oppositions are governed by 37 CFR § 2.106(b)(2)(i)). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ2d 1395, 1397 (TTAB 1989) (Board applied Fed. R. Civ. P. 13(f) "when justice requires" standard where grounds for counterclaim filed as a separate petition to cancel were known at time of answer to opposition). **Please Note:** Effective December 1, 2009, Fed. R. Civ. P. 13(f) was abrogated as being redundant of Fed. R. Civ. P. 15(a)(2). That section still holds that leave should be freely given "when justice so requires."

2. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *TBC Corp. v. Grand Prix Ltd.*, 12 USPQ2d 1311, 1314 (TTAB 1989) (since it was unclear from applicant's submissions to amend whether counterclaim was timely, i.e., whether grounds were known by applicant at time original answer was filed, applicant was allowed time to explain why it was not pleaded with answer); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987) (motion to amend answer to add additional ground to existing counterclaim denied since such ground was available at time of original answer); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986) (petitioner cannot avoid effect of its failure to timely assert counterclaim at time it filed its answer as defendant in prior opposition since grounds existed and were known to petitioner at that time). *But see See's Candy Shops Inc. v. Campbell Soup Co.*, 12 USPQ 1395, 1397 (TTAB 1989) (although counterclaim [filed as separate petition to cancel] was premised on facts known by applicant at time it filed its answer in the opposition, Board allowed the petition to go forward, notwithstanding that the petition was filed two weeks after answer was filed in the opposition).

3. *See VitalineCorp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989); *Zanella Ltd. v. Nordstrom Inc.*, 90 USPQ2d 1758, 1759 (TTAB 2008) (motion to amend answer to assert counterclaim granted); *Turbo Sportswear Inc. v. Marmot Mountain Ltd.*, 77 USPQ2d 1152, 1155 (TTAB 2005) (motion to amend answer to assert counterclaim granted); *Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd.*, 22 USPQ2d 1594, 1597 (TTAB 1992) (petitioner permitted to brief and present evidence on the issue of whether he had prior knowledge of the facts forming the basis of the newly-asserted counterclaim for cancellation), *counterclaim dismissed*, 24 USPQ2d 1376 (TTAB 1992); *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989) (counterclaim pleaded promptly after obtaining the information necessary to assert counterclaim during discovery and before discovery had closed); *S & L Acquisition Co. v. Helene Arpels Inc.*, 9 USPQ2d 1221 (TTAB 1987); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984). *See also J.B. Williams Co. v. Pepsodent G.m.b.H.*, 188 USPQ 577,

579 (TTAB 1975) (if applicant learns through discovery that grounds exist for counterclaim, applicant may move to amend answer to assert such counterclaim); *Johnson & Johnson v. Rexall Drug Co.*, 186 USPQ 167, 170 (TTAB 1975) (applicant would not be barred by the dismissal with prejudice of its counterclaim in prior proceeding thirteen years earlier from asserting new counterclaim on same ground, *i.e.*, that registered mark has become common descriptive name of identified goods, provided new counterclaim is based solely on circumstances occurring subsequent to termination of prior proceeding); *Neville Chemical Co. v. Lubrizol Corp.*, 183 USPQ 184, 187 (TTAB 1974) (same).

4. 37 CFR § 2.111(c)(1).

5. *See Vitaline Corp. v. General Mills Inc.*, 891 F.2d 273, 13 USPQ2d 1172, 1174 (Fed. Cir. 1989) (Trademark Rule requiring the pleading of compulsory counterclaims was "clearly violated" by an assertion of a claim not as a counterclaim in the original proceeding but as a "purportedly new claim in a separate [cancellation] proceeding"); *Consolidated Foods Corp. v. Big Red, Inc.*, 231 USPQ 744, 746 (TTAB 1986) (failure to seasonably assert a compulsory counterclaim in opposition cannot be avoided by filing a petition to cancel).

6. *See Libertyville Saddle Shop Inc. v. E. Jeffries & Sons Ltd*, 22 USPQ2d 1594 (TTAB 1992) *summ. judgment granted*, 24 USPQ2d 1376 (TTAB 1992).

7. *See* 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i); *M. Aron Corp. v. Remington Products, Inc.*, 222 USPQ 93, 95-96 (TTAB 1984). *See also* Notice of Final Rulemaking, 46 Fed. Reg. 6940 (January 22, 1981).

8. *See* 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i).

313.05 Permissive Counterclaims

A party may counterclaim to cancel a registration that 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. [Note 1.] The filing date of the counterclaim is the date of electronic receipt in the Office of the counterclaim with the required fee. [Note 2.] A counterclaim must be filed through ESTTA. [Note 3.] In the rare instance that a paper filing is permitted by the Director, on petition, the filing date of a counterclaim will be determined in accordance with 37 CFR § 2.195 – 37 CFR § 2.198. [Note 4.] A counterclaimant must serve a copy of the counterclaim (with any exhibits thereto) on every other party to the proceeding, and must make proof of such service before the Board will consider the counterclaim. [Note 5.] TBMP § 313.03.

For information on fees for counterclaims, *see* TBMP § 308.02 and TBMP § 313.02.

NOTES:

1. *See* Fed. R. Civ. P. 13(b). *Cf.* 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i).

2. *See* 37 CFR § 2.111(e).

3. *See* 37 CFR § 2.111(c)(1) and 37 CFR § 2.114(b)(1).

4. *See* 37 CFR § 2.111(e).

5. *See* 37 CFR § 2.119(a).

313.06 Answer to Counterclaim

37 CFR § 2.106(b)(3)(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 by the Board within which an answer to the counterclaim must be filed.*

37 CFR § 2.106(b)(3)(iv) *The times for pleading, discovery, testimony, briefs or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

37 CFR § 2.106(a) *If no answer is filed within the time initially set, or as may later be reset by the Board, the opposition may be decided as in case of default.*

37 CFR § 2.114(b)(3)(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 by the Board within which an answer to the counterclaim must be filed. Such response period may be reset as necessary by the Board, for a time period to be determined by the Board.*

37 CFR § 2.114(b)(3)(iv) *The times for pleading, discovery, testimony, briefs, or oral argument may be reset or extended when necessary, upon motion by a party, or as the Board may deem necessary, to enable a party fully to present or meet a counterclaim or separate petition for cancellation of a registration.*

37 CFR § 2.114(a) *If no answer is filed within the time initially set, or as may later be reset by the Board, the petition may be decided as in case of default.*

When a counterclaim (together with proof of service and the required cancellation fee) is electronically filed, the Board prepares an order acknowledging its receipt and allowing the plaintiff (defendant in the counterclaim) a set time, not less than 30 days, within which to file an answer to the counterclaim. [Note 1.] In practice, the Board usually allows 30 days. A copy of the order setting the time to answer the counterclaim is sent to each party to the proceeding, or to each party's attorney or other authorized representative. The order will also include a trial schedule and briefing dates to accommodate the counterclaim, which will reset or extend, as appropriate, the times for discovery (including conferencing and initial and expert disclosure dates), pretrial disclosures, testimony, briefs and/or oral argument. [Note 2.]

If no answer to the counterclaim is filed during the time allowed, the counterclaim may be decided as in case of default. [Note 3.] For information concerning default for failure to answer , *see* TBMP § 312.

An answer to a counterclaim should be in the same form as an answer to a complaint. For information on the proper form for an answer to a complaint, *see* TBMP § 311.01.

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 by the counterclaimant is a compulsory counterclaim if grounds for such counterclaim exist at the time the plaintiff's answer to the defendant's counterclaim is filed. If the plaintiff knows of grounds for a counterclaim 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. [Note 4.] *Cf.* TBMP § 313.04.

A plaintiff's counterclaim to cancel a registration owned by the defendant, but not pleaded in the defendant's counterclaim, is a permissive counterclaim. [Note 5.] *Cf.* TBMP § 313.05.

For information on the fee for a counterclaim, *see* 37 CFR § 2.6(a)(16) and TBMP § 313.02. For information on the form for a counterclaim, *see* TBMP § 313.03.

NOTES:

1. *See* 37 CFR § 2.106(b)(3)(iii) and 37 CFR § 2.114(b)(3)(iii).

2. *See* 37 CFR § 2.106(b)(3)(iv) and 37 CFR § 2.114(b)(3)(iv). An example of a trial order for a proceeding with a counterclaim can be found in the Appendix of Forms.

3. *See* 37 CFR § 2.106(a)and 37 CFR § 2.114(a).

4. *Cf.* 37 CFR § 2.106(b)(3)(i) and 37 CFR § 2.114(b)(3)(i).

5. *Cf.* Fed. R. Civ. P. 13(b).

314 Unpleaded Matters

A plaintiff may not rely on an unpleaded claim. The plaintiff's pleading must be amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or (b), to assert the matter. [Note 1.]

In the case of an opposition against an application under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), however, the opposition cannot be amended (or deemed amended) to assert any new claim. [Note 2.] *See* TBMP§ 315 and TBMP § 507.

Except as provided in Fed. R. Civ. P. 12(b) and (h)(2) (which allow a defendant to raise certain specified defenses by motion), a defendant may not rely on an unpleaded defense unless the defendant's pleading is amended (or deemed amended), pursuant to Fed. R. Civ. P. 15(a) or 15(b), to assert the matter. [Note 3.]

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, to the extent such amendment would not be prohibited by 37 CFR § 2.107, which prohibits amendment of an opposition brought against applications filed under Trademark Act § 1 or Trademark Act § 44, 15 U.S.C. § 1051 or 15 U.S.C. § 1126, to add to the goods or services opposed or to add a joint opposer (*see* 37 CFR § 2.107(a)) and prohibits amendment of an opposition brought against applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a), to add to the grounds for opposition or to add to the goods or services subject to opposition or to add a joint opposer (*see* 37 CFR § 2.107(b)). [Note 4.] See TBMP § 315 andTBMP § 507.01 for further information about limitations on amending notices of oppositions brought against applications filed under Trademark Act § 66(a), 15 U.S.C. § 1141f(a).

A party may not obtain summary judgment on an unpleaded claim or defense, nor may a party defend against a motion for summary judgment by asserting the existence of genuine disputes of material fact as to an

unpleaded claim or defense. [Note 5.] However, a party that seeks to obtain, or to defend against, summary judgment on the basis of an unpleaded claim or defense may, unless prohibited by 37 CFR § 2.107, move to amend its pleading to assert the matter. [Note 6.] *See* TBMP § 315 and TBMP § 528.07.

A plaintiff which pleads ownership of an application in its complaint does not have to amend its pleading to assert the resultant registration, so long as it issues before the plaintiff's testimony period closes. [Note 7.] The pleading of an application is viewed as providing sufficient notice to the defendant of the plaintiff's intention to rely on any registration that issues from the pleaded application. [Note 8.]

NOTES:

1. *See UVeritech, Inc. v. Amax Lighting, Inc.*, 115 USPQ2d 1242, 1244 (TTAB 2015) (unpleaded allegations relating to fraud, acquiescence and laches will not be heard); *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, 804 (CCPA 1978) (registrant did not have fair notice that petitioner was attempting to establish a two-year period of nonuse extending beyond two-year period alleged in petition); *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1115 n.3 (TTAB 2009) (unpleaded claim of dilution not considered); *Hornby v. TJX Companies Inc.*, 87 USPQ2d 1411, 1415 (TTAB 2008) (unpleaded claims were not tried by express or implied consent of the parties such that pleadings could be treated as amended pursuant to Fed. R. Civ. P. 15(b)); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1103 n.3 (TTAB 2007) (raising claim for first time in plaintiff's brief is manifestly untimely; belated fraud claim given no further consideration); *Micro Motion, Inc. v. Danfoss A/S*, 49 USPQ2d 1628, 1629 (TTAB 1998) (motion to amend opposition filed with final brief denied where pleaded issue was genericness and applicant was not on notice of unpleaded issue of mere descriptiveness so that applicant could have put on defense of acquired distinctiveness); *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, 1471 n.11 (TTAB 1993) (only ground pleaded and tried was descriptiveness, not likelihood of confusion); *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1439-40 (TTAB 1993) (issue of abandonment argued in final brief was neither pleaded nor tried); *Riceland Foods Inc. v. Pacific Eastern Trading Corp.*, 26 USPQ2d 1883, 1884 (TTAB 1993) (only mark pleaded by opposer and tried was registered design mark and applicant had no notice that opposer intended to rely on use of unregistered word mark appearing on opposer's packaging); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1139 (TTAB 1992) (to have valid Trademark Act§ 2(d), 15 U.S.C. § 1052(d) claim in this case opposer was advised to amend pleading to state that its pleaded mark is merely descriptive and had acquired distinctiveness prior to any establishment by applicant of acquired distinctiveness of applicant's mark).

Cf. ChaCha Search Inc. v. Grape Technology Group Inc., 105 USPQ2d 1298, 1302 (TTAB 2012) (counterclaim plaintiff may not seek or obtain judgment on proposed new claims because motion to amend counterclaim denied).

2. *See* 37 CFR § 2.107(b); *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327 (TTAB 2010) (in opposition involving a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application, motion to amend notice of opposition to add an additional ground denied).

3. *See* Fed. R. Civ. P. 8(b), 8(c), and 12(b); *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1926 (TTAB 2011) (unpleaded affirmative defenses of prior registration defense and tacking not considered), *aff'd* __F. Supp. 3d __, 2016, No. 1:11-cv-01623-RC (D.D.C. May 27, 2016)); *Larami Corp. v. Talk To Me Programs Inc.*, 36 USPQ2d 1840, 1842 (TTAB 1995) (applicant allowed time to amend pleading to allege acquisition of secondary meaning as an affirmative defense in the answer); *Perma Ceram Enterprises Inc. v. Preco Industries Ltd.*, 23 USPQ2d 1134, 1139 (TTAB 1992) (in defending against Trademark Act § 2(d),15U.S.C. § 1052(d) claim where opposer's unregistered mark is

merely descriptive, applicant was advised to amend pleading to affirmatively assert priority of acquired distinctiveness); *Chicago Corp. v. North American Chicago Corp.*, 20 USPQ2d 1715, 1717 n.5 (TTAB 1991) (defense raised for first time in final brief that opposer lacks proprietary rights in its common law mark was neither pleaded nor tried); *United States Olympic Committee v. Bata Shoe Co.*, 225 USPQ 340, 341 (TTAB 1984) (respondent who failed to plead affirmative defense of laches in answer cannot be heard to argue the defense in response to motion for summary judgment).

4. *See* 37 CFR § 2.107(a) and 37 CFR § 2.107(b); Fed. R. Civ. P. 15(a); *Be Sport, Inc. v. Al-Jazeera Satellite Channel* , 115 USPQ2d 1765, 1769 (TTAB 2015) (motion to amend answer to include affirmative defense of claim preclusion denied as futile because the mark involved in the prior opposition creates a different commercial impression than the mark involved in the instant proceeding); *Sportswear Inc. v. Marmot Mountain Ltd.* , 77 USPQ2d 1152, 1155 (TTAB 2005) (motion to amend answer to assert counterclaim granted);*Hilson Research Inc.,* 27 USPQ2d 1423, 1440 (TTAB 1993) (noting that plaintiff failed to promptly move to amend petition to cancel to set forth abandonment claim); *Trans Union Corp. v. Trans Leasing International, Inc.* , 200 USPQ 748, 754 (TTAB 1978) (affirmative defense should be pleaded when answer filed, or when information is ascertained at a subsequent date through discovery or the like, so as to provide fair notice); *J.B. Williams Co. v. Pepsodent G.m.b.H.,* 188 USPQ 577, 579 (TTAB 1975) (if information is learned during discovery to support a counterclaim, then pleading should be amended to assert a counterclaim); *Johnson & Johnson v. Rexall Drug Co.* , 186 USPQ 167, 170-71 (TTAB 1975) (applicant would not be precluded by dismissal with prejudice of counterclaim in civil action from asserting a new counterclaim on the same ground in the Board proceeding); *Neville Chemical Co. v. Lubrizol Corp.* , 183 USPQ 184, 187 (TTAB 1974) (if applicant determines through discovery grounds exist for affirmative defense or counterclaim, it may move to amend its answer to assert the defense or counterclaim). *See also* 37 CFR § 2.106(b)(2)(i) and 37 CFR § 2.114(b)(2)(i).

5. *See, e.g., Omega SA (Omega AG) (Omega Ltd.) v. Alpha Phi Omega*, 118 USPQ2d 1289, 1291 n.2 (TTAB 2016) (no consideration given to applicant's unpleaded prior registration defense in connection with motion for summary judgment); *Be Sport, Inc. v. Al-Jazeera Satellite Channel*, 115 USPQ2d 1765, 1769 (TTAB 2015) (where motion to amend pleading to add defense of claim preclusion denied as futile, motion for summary judgment on such defense denied as moot); *American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1296 (TTAB 2010) ("defendant may not obtain summary judgment on an unasserted defense . . . summary judgment is not appropriate on an unpleaded issue."); *Consolidated Foods Corporation v. Berkshire Handkerchief Co.*, 229 USPQ 619, 621 (TTAB 1986) ("Generally only pleaded issues may be the basis for grant of summary judgment").

6. *See, e.g., American Express Marketing & Development Corp. v. Gilad Development Corp.*, 94 USPQ2d 1294, 1297 (TTAB 2010) ("the Board will not hesitate to deny any motion for summary judgment on an unpleaded claim or defense unless the motion for summary judgment is accompanied by an appropriate motion to amend or is withdrawn and refiled with such a motion to amend"); *Karsten Manufacturing Corp. v. Editoy AG*, 79 USPQ2d 1783, 1785-86 (TTAB 2006) (Board entertained a renewed motion for summary judgment where opposer corrected the problem of seeking summary judgment on an unpleaded ground by withdrawing the motion for summary judgment, moving to amend its pleading and then refiling the motion for summary judgment); *Societe des Produits Marnier Lapostolle v. Distillerie Moccia S.R.L.*, 10 USPQ2d 1241, 1242 n.4 (TTAB 1989) (motion to amend to add new ground, filed simultaneously with motion for summary judgment, granted and allegations in new ground deemed denied); *Paramount Pictures Corp. v. White*, 31 USPQ2d 1768, 1772 (TTAB 1994) (opposer's pleading deemed amended where nonmoving party did not object to summary judgment motion as seeking judgment on unpleaded claim), *aff'd*, 108 F.3d 1392 (Fed. Cir. 1997) (non-precedential).

Cf. Asian and Western Classics B.V. v. Selkow, 92 USPQ2d 1478, 1480 (TTAB 2009) (summary judgment deemed moot due to improperly pleaded claim which was the basis for the motion, leave to amend granted); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1528 n.3 (TTAB 2008) (opposer's attempt in reply brief to informally amend notice of opposition to add a claim not allowed; unpleaded claim on summary judgment not considered); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1437 (TTAB 2007)(unpleaded registrations asserted for first time in opposer's cross-motion for summary judgment and objected to by applicant not considered; cross-motion denied and opposer granted leave to include them in notice of opposition); *Wet Seal Inc. v. FD Management Inc.*, 82 USPQ2d 1629, 1634 (TTAB 2007) (where applicant not given fair notice of opposer's reliance on registration that issued after filing of complaint, and applicant objected to opposer's reliance on such registration in its brief, unpleaded registration given no consideration). *But see Fishking Processors Inc. v. Fisher King Seafoods Ltd.*, 83 USPQ2d 1762, 1764 n.3 (TTAB 2007) (after filing of a motion for summary judgment on unpleaded claim of prior trade name use, Board *sua sponte* granted petitioner time to amend petition to cancel to add the claim so that it could be considered on summary judgment).

7. *See Edom Laboratories Inc. v. Lichter*, 102 USPQ2d 1546, 1547 (TTAB 2012) (pleaded application matured into registration prior to close of opposer's testimony period); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 (TTAB 2009).

8. *See United Global Media Group., Inc. v. Tseng*, 112 USPQ2d 1039, 1040 n.3 (TTAB 2014) (opposer that pleads ownership of the underlying applications in the notice of opposition may make the registrations which issue during the opposition of record without having to amend the notice of opposition to assert reliance on the registrations); *UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1045 n.12 (TTAB 2009) (opposer that pleads ownership of application would have to make any subsequently issued registration of record but would not have to amend notice of opposition prior to doing so); *Standard Knitting Ltd. v. Toyota Jidosha Kabushiki Kaisha*, 77 USPQ2d 1917, 1920 (TTAB 2006) (opposer filed notice of reliance of status and title copy of registration issuing from pleaded application); *DC Comics v. Pan American Grain Manufacturing Co.*, 77 USPQ2d 1220, 1223 n. 6 (TTAB 2005) (to the extent necessary, holding opposer's pleading amended to include an allegation of ownership of a registration which was pleaded as an application in the notice of opposition); *M & T Chemicals Inc. v. Stepan Chemical Co.*, 150 USPQ 570, 571 (TTAB 1966) (during trial period opposer noticed under the applicable rule that its pleaded application matured into a registration).

315 Amendment of Pleadings

37 CFR § 2.107 ***Amendment of pleadings in an opposition proceeding.***

(a) *Pleadings in an opposition proceeding against an application filed under section 1 or 44 of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, after the close of the time period for filing an opposition including any extension of time for filing an opposition, an opposition may not be amended to add to the goods or services opposed, or to add a joint opposer.*

(b) *Pleadings in an opposition proceeding against an application filed under section 66(a) of the Act may be amended in the same manner and to the same extent as in a civil action in a United States district court, except that, once filed, the opposition may not be amended to add grounds for opposition or goods or services beyond those identified in the notice of opposition, or to add a joint opposer. The grounds for opposition, the goods or services opposed, and the named opposers are limited to those identified in the ESTTA cover sheet regardless of what is contained in any attached statement.*

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.*

As a general rule, 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. [Note 1.]There is an exception to this rule, however. An opposition against a Trademark Act § 66(a), 15 U.S.C. § 1141f(a) application may not be amended to add to the stated grounds for opposition. Thus, an opposition may not be amended to add an entirely new claim or to add an additional claimed registration to a previously stated Trademark Act § 2(d), 15 U.S.C. § 1052(d) ground. [Note 2.] Also, an opposition against an application filed under Trademark Act § 1, Trademark Act § 44 or Trademark Act § 66(a), 15 U.S.C. § 1051, 15 U.S.C. § 1126 or 15 U.S.C. § 1141f(a) may not be amended to add to the goods or services subject to opposition or to add a joint opposer. [Note 3.] Further, with respect to an opposition against a Trademark Act § 66(a) application, the scope of the goods and/or services opposed is limited to those identified in the ESTTA-generated opposition cover sheet, [Note 4], the scope of the grounds for opposition is limited to those identified in the ESTTA-generated opposition cover sheet, [Note 5] and the named opposers are limited to those identified in the ESTTA-generated opposition cover sheet. [Note 6.] Other amendments, such as those that would amplify or clarify the grounds for opposition, are not prohibited by this rule. [Note 7.]

For further information concerning the amendment of pleadings, *see* Fed. R. Civ. P. 15 and TBMP § 507.

NOTES:

1. *See* Fed. R. Civ. P. 15(a); 37 CFR § 2.107 and 37 CFR § 2.115 .

2. *See* Trademark Act § 68(c)(3), 15 U.S.C. § 1141h; 37 CFR § 2.107(b); Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act; 68 Fed. Reg. 55748, specifically, summary of amendments at 55757 (September 26, 2003); *O.C. Seacrets, Inc. v. Hotelplan Italia S.p.A.*, 95 USPQ2d 1327, 1329 (TTAB 2010) (in opposition involving a Trademark Act § 66(a), 15 U.S.C. § 1141f(a)application,motion to amend notice of opposition to add an additional ground denied); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016).

3. *See* 37 CFR § 2.107(a) and 37 CFR § 2.107(b); *Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 (TTAB 2007) (after close of opposition period, amendment of opposition to add to goods or services originally opposed is barred by 37 CFR. §2.107); *Syngenta Crop Protection Inc. v. Bio-Check LLC*, 90 USPQ2d 1112, 1115 n.2 (TTAB 2009) (second opposer named in the notice of opposition but not on the ESTTA cover sheet, for whom no fee was paid, not party to the proceeding); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952, 69957 (October 7, 2016).

4. *See* 37 CFR § 2.107(b); *Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1151 (TTAB 2014) (for § 66(a) application, scope of goods and services subject to opposition controlled by ESTTA-generated electronic opposition form); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1561-62 (TTAB 2011) (same); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952, 69957 (October 7, 2016).

5. *See* 37 CFR § 2.107(b); *Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1151 (TTAB 2014) (for § 66(a) application, scope of grounds of opposition controlled

by contents of ESTTA-generated electronic opposition form); *CSC Holdings LLC v. SAS Optimhome*, 99 USPQ2d 1959, 1962-63 (TTAB 2011) (same); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69952, 69957 (October 7, 2016).

6. *See* 37 CFR § 2.107(b); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69957 (October 7, 2016).

7. *See, e.g., Prosper Business Development Corp. v. International Business Machines Corp.*, 113 USPQ2d 1148, 1152 (TTAB 2014) (corrective amendment to notice of opposition against § 66(a) application allowed because it was a "minor change"); Rules of Practice for Trademark-Related Filings Under the Madrid Protocol Implementation Act, 68 Fed. Reg. 55748, specifically, summary of amendments at 55757 (September 26, 2003).

316 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.

Please Note: The filing of various pleading motions under Fed. R. Civ. P. 12 will effectively act to stay the parties' obligations to conference and, subsequently, make initial disclosures. [Note 1.] In any case in which a defendant files a potentially dispositive motion under Fed. R. Civ. P. 12 directed to plaintiff's pleading, the case is suspended for decision on the motion and the Board will reset the deadline for the discovery conference as well as all subsequent dates, as appropriate, when the motion is decided. [Note 2.]

For more information regarding the parties' obligations with respect to initial disclosures and the discovery conference, *see* TBMP § 401.01, TBMP § 401.02, TBMP § 408.01(a), and TBMP § 408.01(b).

NOTES:

1. MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 72 Fed. Reg. 42242, 42245 (August 1, 2007).

2. *See* 37 CFR § 2.127(d); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69951 (October 7, 2016) ("To clarify the obligations of the parties and render the status and timeline for a case more predictable, this final rule provides that a trial proceeding is suspended upon filing of a timely, potentially dispositive motion.").

317 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, and must be 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 an original or photocopy of the registration prepared and issued by the Office showing both the current status of and current title to the registration, or by a current copy of information from the electronic database records*

of the Office showing the current status and title of the registration. For the cost of a copy of a registration showing status and title, see § 2.6(b)(4).

* * * *

A plaintiff or defendant may attach exhibits to its pleading. However, with two exceptions, 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. [Note 1.]

The first exception to the foregoing rule is a current status and title copy, or photocopy thereof, prepared by the USPTO, of a plaintiff's pleaded registration. [Note 2.] When a plaintiff submits an original or photocopy of a status and title copy of its pleaded registration, prepared and issued by the Office, 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. [Note 3.] *See* TBMP § 704.03(b)(1)(A) and TBMP § 704.05(a).

The second exception is a current copy of information from the electronic database records of the USPTO showing the current status and title of the registration. When a plaintiff submits a copy of such information 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. [Note 4.] *See* TBMP § 704.03(b)(1)(A). The copy may be taken from (a) the TSDR (Trademark Status and Document Retrieval) electronic database of the Office by selecting the "Status" tab and opening all the relevant fields to show current status and title (owner) of the registration or, if the TSDR copy does not reflect the current owner of the registration, a copy from the Office's Assignment database demonstrating an assignment to the current owner of the registration should be included with the TSDR copy; or (b) the TESS (Trademark Electronic Search System) electronic database of the Office along with a copy of records from the Assignment database showing an assignment to the current owner of the registration. The Board does not take judicial notice of a party's registrations. [Note 5.]

The appropriate documentation, as described above, must accompany the pleading as an exhibit. When using ESTTA to file a complaint, a pleaded registration will not be made of record with the complaint simply by inputting the registration number when prompted by the ESTTA protocol. [Note 6.]

For more information regarding the introduction of applications and registrations into evidence *see* TBMP § 704.03(b)(1)(A) TBMP § 704.03(b)(1)(B), andTBMP § 704.12.

For information regarding the automatic updating of the ownership of trademark applications and registrations in the Trademark Database, *see generally* TMEP § 504.

Exhibits submitted with a pleading must conform to the requirements of 37 CFR § 2.126. *See, generally,* TBMP § 106.03.

NOTES:

1. 37 CFR § 2.122(c). *See Republic Steel Co. v. M.P.H. Manufacturing Corp.*, 312 F.2d 940, 136 USPQ 447, 448 (CCPA 1963) (as Board had invoked Trademark Rule 2.126, appellate court did not consider exhibits attached to pleading in reviewing Board decision); *Baseball America Inc. v. Powerplay Sports Ltd.*, 71 USPQ2d 1844, 1846 n.6 (TTAB 2004) (exhibits to pleading not evidence of record); *Hard Rock Café Intl (USA) Inc. v. Elsea*, 56 USPQ2d 1504, 1511 (TTAB 2000) (brief may not be used as a vehicle for introduction of evidence); *Home Juice Co. v. Runglin Cos.*, 231 USPQ 897, 898 (TTAB 1986) (exhibits attached to the parties' pleadings are not in evidence and given no consideration); *Intersat Corp. v. International Telecommunications Satellite Organization*, 226 USPQ 154, 155 n.3 (TTAB 1985) (exhibit

attached to pleading not evidence on behalf of party to whose pleading exhibit is attached unless identified and introduced in evidence as exhibit during period for taking testimony); *Syosset Laboratories, Inc. v. TI Pharmaceuticals*, 216 USPQ 330, 332 (TTAB 1982) (unauthenticated exhibits attached to complaint are not evidence of allegations in that complaint and inadmissible in the form presented); *Cities Service Co. v. WMF of America, Inc.*, 199 USPQ 493, 495 n.5 (TTAB 1978) (exhibits attached to pleading are not evidence unless introduced in the same manner as other exhibits during that party's testimony period); *A-1-A Corp. v. The Gillette Co.*, 199 USPQ 118, 119 n.2 (TTAB 1978) (reference in pleadings to attached exhibits does not make them of record in the case and such exhibits are not evidence on party's behalf unless offered as evidence during party's trial period); *Permatex Co. v. California Tube Products, Inc.*, 175 USPQ 764, 765 n.2 (TTAB 1972) (reference in brief to labels and brochures attached to notice of opposition not considered evidence on behalf of opposer since they were not identified and made of record during opposer's trial period in accordance with applicable rules). *Cf. Research in Motion Limited v. NBOR Corp.*, 92 USPQ2d 1926, 1928(TTAB 2009) (TARR printouts showing status and title of pleaded registrations may be introduced at trial under notice of reliance).

2. *See Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943, 1945 (TTAB 2009) ("[W]ith the exception of a plaintiff's pleaded registrations, which may be filed along with the petition to cancel or notice of opposition, documents and other exhibits may be made of record only during the testimony period of the offering party in the following two ways: (1) they may be introduced by a witness during the course of a deposition, and (2) they may be submitted pursuant to a notice of reliance filed with the Board if they meet the requirements of Trademark Rule 2.120 or 2.122."); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008) (registrations may be made of record by attaching to notice of opposition printouts from the Office's electronic database records showing the current status and title of its registrations under current version of 37 CFR § 2.122(d)(1)).

3. *See* 37 CFR § 2.122(e) and 37 CFR § 2.122(d)(1) . *See Sterling Jewelers Inc. v. Romance & Co.*, 110 USPQ2d 1598, 1601 n.2 (TTAB 2014) ("Documents submitted as evidence of a registration under Trademark Rule 2.122(d) must show *current* title and *current* status of registration . . . . and must have been created reasonably contemporaneous with their filing.").

4. *Vital Pharmaceuticals Inc. v. Kronholm*, 99 USPQ2d 1708, 1709 (TTAB 2011) (pleaded registrations of record because copies from USPTO databases were submitted with notice of opposition); *Bausch & Lomb Inc. v. Karl Storz GmbH & Co. KG*, 87 USPQ2d 1526, 1530 n.4 (TTAB 2008) (printouts from USPTO's database showing current status and title of registration sufficient under current version of Trademark Rule 2.122(d)(1)).

5. *See UMG Recordings Inc. v. O'Rourke*, 92 USPQ2d 1042, 1046 (TTAB 2009), citing Corporate Fitness Programs Inc. v. Weider Health and Fitness Inc., 2 USPQ2d 1682, 1683-84, n.3 (TTAB 1987) ("The Board does not take judicial notice of registrations that reside in the Patent and Trademark Office."); *Black & Decker Corp. v. Emerson Electric Co.*, 84 USPQ2d 1482, 1485 n.4 (TTAB 2007) (same).

6. *See United Global Media Group., Inc. v. Tseng*, 112 USPQ2d 1039, 1042 n.11 (TTAB 2014) (mere inputting of a registration number when prompted by ESTTA, to list any registration upon which the plaintiff relies, insufficient to make the registration(s) of record); *Melwani v. Allegience Corp.*, 97 USPQ2d 1537, 1540 (TTAB 2010) ("The fact that completion of the ESTTA filing form results in the creation of electronic records … is for administrative ease and is insufficient to make the pleaded registrations of record."). *See also Chutter, Inc. v. Great Concepts, LLC*, 119 USPQ2d 1865, 1867 n. 3 (TTAB 2016) (in finding a sufficient pleading of standing, the Board noted that the mere listing of the application number in electronic record does not make that application of record for purposes of proving standing at trial).

318 Fed. R. Civ. P. 11 Applicable

Fed. R. Civ. P. 11 provides, in part, as follows:

(b) ***Representations to the Court.*** *By presenting to the court a pleading, written motion, or other paper --whether by signing, filing, submitting, or later advocating it -- an attorney or unrepresented party certifies 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, 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 extending, modifying, or reversing existing law or for establishing new law;*

(3) *the factual contentions have evidentiary support or, if specifically so identified, will likely 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 belief or a lack of information.*

(c) ***Sanctions.***

(1) ***In General.*** *If, after notice and a reasonable opportunity to respond, the court determines that Rule 11(b) has been violated, the court may impose an appropriate sanction on any attorney, law firm, or party that violated the rule or is responsible for the violation. Absent exceptional circumstances, a law firm must be held jointly responsible for a violation committed by its partner, associate, or employee.*

The quoted provisions are applicable to pleadings, motions, and other papers filed in inter partes proceedings before the Board. [Note 1.] *See* TBMP § 527.02.

NOTES:

1. *See* 37 CFR § 2.116(a); *Emilio Pucci International BV v. Sachdev*, 118 USPQ2d 1383, 1387 n.8 (TTAB 2016) (standards prescribed in Fed. R. Civ. P. 11 apply to all filings in Board inter partes proceedings); *NSM Resources Corp. v. Microsoft Corp.*, 113 USPQ2d 1029, 1037-38 (TTAB 2014) (applying Rule 11 sanctions to dismiss a Board proceeding "initiated in bad faith" finding petitioner's pleading "frivolous," and its conduct "vexatious"). *See also Central Manufacturing, Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (the Board will also consider the conduct of a party relating to requests to extend time to oppose).

319 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 that is the subject of an opposition, *see* TBMP § 219.