

# Chapter 800 BRIEFS ON CASE, ORAL HEARING, FINAL DECISION

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<b>801</b>	<b>Briefs on the Case</b>
<b>801.01</b>	In General
<b>801.02</b>	Time for Filing
<b>801.02(a)</b>	Plaintiff's Main Brief
<b>801.02(b)</b>	Defendant's Main Brief
<b>801.02(c)</b>	Plaintiff's Reply Brief
<b>801.02(d)</b>	Reply Brief for Defendant Not Permitted
<b>801.02(e)</b>	Special Situations
<b>801.03</b>	Form and Contents of Brief
<b>801.04</b>	Amicus Briefs
<b>801.05</b>	Motion to Strike Brief on Case
<b>802</b>	<b>Oral Hearing</b>
<b>802.01</b>	In General
<b>802.02</b>	Request for Oral Hearing
<b>802.03</b>	Time and Place of Hearing
<b>802.03(a)</b>	Rescheduling a Hearing
<b>802.03(b)</b>	Attendance by Video Connection
<b>802.04</b>	Before Whom Held
<b>802.05</b>	Length of Oral Argument
<b>802.06</b>	Audio Recording and Video Recording
<b>802.07</b>	Visual Aids, etc.
<b>802.08</b>	Nature of Hearing
<b>803</b>	<b>Final Decision</b>
<b>804</b>	<b>Request for Rehearing, Reconsideration, or Modification of Final Decision</b>
<b>805</b>	<b>Final Decision Remand to Examining Attorney</b>
<b>806</b>	<b>Termination of Proceeding</b>
<b>807</b>	<b>Status of Application after Proceeding</b>
<b>807.01</b>	Abandoned Applications and Registrations Entirely Cancelled
<b>807.02</b>	Applications Not Abandoned and Registrations Not Cancelled

## **801 Briefs on the Case**

### **801.01 In General**

After the close of all testimony periods in an inter partes proceeding before the Board, the parties are allowed time in which to file briefs on the case. The brief is a party's opportunity to present, in a systematic and coherent manner, and in a form which is permanent and can be referred to, a discussion of the facts in light of the law, its strongest affirmative arguments, and a rebuttal of its adversary's arguments. Parties must file their briefs via ESTTA except under certain limited circumstances. [Note 1.] See [TBMP § 801.03](#).

Subject to Fed. R. Civ. P. 11, a party is entitled to offer in its brief on the case any argument it feels will be to its advantage. However, the facts and arguments presented in the brief must be based on the evidence offered at trial. A brief may not be used as a vehicle for the introduction of evidence. See [TBMP § 704.05\(b\)](#) and [TBMP § 704.06\(b\)](#). Exhibits to briefs are generally unnecessary and are discouraged. [Note 2.] To allow readers to easily locate materials in the record, the parties should cite to the evidence in the trial record by referencing the TTABVUE entry and page number, and not attach previously-filed evidence to their briefs. [Note 3.] For material or testimony that has been designated confidential, and which cannot be viewed on TTABVUE, the parties should include the TTABVUE docket entry and page numbers for both the redacted

version and the TTAB docket entry number for the confidential versions. [Note 4.] Evidence attached to the briefs will not be considered.

If a party fails to reference a pleaded claim or affirmative defense in its brief, the Board will deem the claim or affirmative defense to have been waived. [Note 5.] Furthermore, a mere statement in a party's brief that it has not waived an affirmative defense, without evidence of proof, may effectively result in waiver of such defenses. [Note 6.] A party may also expressly waive in its brief a pleaded claim or affirmative defense. [Note 7.]

For information concerning briefs and oral hearings in ex parte appeals, see [TBMP § 1203.01](#) and [TBMP § 1216](#), respectively.

For information concerning briefs and ACR proceedings, see [TBMP § 528.05\(a\)\(2\)](#) and [TBMP § 702.04](#). For information concerning citation to evidence in TTABVUE in ex parte appeals, see [TBMP § 1203.01](#) and [37 C.F.R. § 2.142\(b\)\(3\)](#).

#### NOTES:

1. [37 C.F.R. § 2.126\(a\)](#), [37 C.F.R. § 2.126\(b\)](#), [37 C.F.R. § 2.128\(a\)](#).
2. *Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at \*2 (TTAB 2020) (exhibits attached to brief not considered); *Life Zone Inc. v. Middleman Group Inc.*, 87 USPQ2d 1953, 1955 (TTAB 2008) (“while exhibits to briefs are not explicitly prohibited by the Trademark Rules, the Board will usually ignore them, because they comprise either untimely evidence or unnecessary copies of timely evidence”); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2022-23 (TTAB 1998) (filing duplicative submissions is a waste of time and resources, and is a burden on the Board).
3. Cf. [37 C.F.R. § 2.142\(b\)\(3\)](#); *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) (Board prefers citation to the TTABVUE record); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (citation to the Board's TTABVUE docket electronic database by the entry and page number (e.g., 1 TTABVUE 2) recommended).
4. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1468 n.6 (TTAB 2016).
5. *Alcatraz Media, Inc. v. Chesapeake Marine Tours, Inc.*, 107 USPQ2d 1750, 1753 (TTAB 2013) (petitioner's pleaded descriptiveness and geographical descriptiveness claims not argued in brief deemed waived; respondent's affirmative defense of failure to state a claim not argued in brief deemed waived), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1426 n.3 (TTAB 2013) (opposer's pleaded descriptiveness claim not argued in brief deemed waived); *Swatch AG (Swatch SA) (Swatch Ltd.) v. M.Z. Berger & Co.*, 108 USPQ2d 1463, 1465 n.3 (TTAB 2013) (pleaded claims not argued in its brief deemed waived), *aff'd*, 787 F.3d 1368, 114 USPQ2d 1892 (Fed. Cir. 2015); *Central Garden and Pet Co. v. Doskocil Manufacturing Co.*, 108 USPQ2d 1134, 1136 (TTAB 2013) (same); *Syndicat Des Proprietaires Viticulteurs De Chateaufeuf v. Pasquier DesVignes*, 107 USPQ2d 1930, 1931 n.6 (TTAB 2013) (affirmative defenses neither pursued at trial nor argued in brief deemed waived); *Research in Motion Ltd. v. Defining Presence Marketing Group Inc.*, 102 USPQ2d 1187, 1189-90 (TTAB 2012) (affirmative defenses not pursued at trial deemed waived); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1734 n.4 (TTAB 2012) (affirmative defenses deemed waived where no mention of them in trial brief); *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1588 n.1 (TTAB 2011) (“Due to the absence of evidence submitted during trial with regard

to applicant's goods in International Class 30, and the absence of argument in opposers' brief as to anything other than yogurt, to the extent opposers' pleading alleged a claim against the goods in Class 30, we deem that opposers have waived their likelihood of confusion and dilution claims as to the goods in this class. . . .”), *judgment set aside on other grounds*, 110 USPQ2d 1679 (TTAB 2014); *Barbara's Bakery Inc. v. Landesman*, 82 USPQ2d 1283, 1292 (TTAB 2007) (where applicant did not argue the affirmative defense of equitable estoppel in her brief, the affirmative defense was given no consideration); *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ2d 1313, 1314 n.4 (TTAB 2005) (where opposer presented no arguments in its brief regarding the claim of dilution, opposer is deemed to have waived the claim). *Cf. Rolex Watch U.S.A. Inc. v. AFP Imaging Corp.*, 101 USPQ2d 1188, 1189 (TTAB 2011) (where opposer did not argue its likelihood of confusion and dilution by tarnishment claims in its brief, applicant's uncontested request that judgment be found in its favor on the claims was granted), *judgment vacated based on action of defendant on appeal*, 107 USPQ2d 1626 (TTAB 2013) *Cf. Converse, Inc. v. International Trade Commission*, 907 F.3d 1361, 128 USPQ2d 1538, 1544 (Fed. Cir. 2018) (case remanded to ITC to permit plaintiff to raise argument about acquired distinctiveness that it had not raised below: “We do not think a finding of waiver is appropriate here, given that our opinion is clarifying and in some ways changing the legal landscape with respect to proving secondary meaning.”).

6. *Nahshin v. Product Source International LLC*, 107 USPQ2d 1257, 1264 n.13 (TTAB 2013) (“We note that respondent, in stating that it has asserted its various affirmative defenses, made the statement in its brief, ‘Respondent pursues these defenses and does not waive these defenses.’ It is not sufficient to simply make this statement. Respondent was under a burden to take some affirmative action if it actually wished to pursue them. To the extent that they have not been waived, we find that respondent has failed to prove them.”), *aff'd*, 112 F. Supp. 2d 383 (E.D. Va. 2015).

7. *Ayoub, Inc. v. ACS Ayoub Carpet Service*, 118 USPQ2d 1392, 1394 n.3 (TTAB 2016) (opposers expressly waived certain pleaded claims in reply brief).

## 801.02 Time for Filing

### 37 C.F.R. § 2.128 *Briefs at final hearing.*

(a)(1) *The brief of the party in the position of plaintiff shall be due not later than sixty days after the date set for the close of rebuttal testimony. The brief of the party in the position of defendant, if filed, shall be due not later than thirty days after the due date of the first brief. A reply brief by the party in the position of plaintiff, if filed, shall be due not later than fifteen days after the due date of the defendant's brief.*

(a)(2) *When there is a counterclaim, or when proceedings have been consolidated and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another of the involved proceedings, or when there is an interference or a concurrent use registration proceeding involving more than two parties, the Trademark Trial and Appeal Board will set the due dates for the filing of the main brief, and the answering brief, and the rebuttal brief by the parties.*

(a)(3) *When a party in the position of plaintiff fails to file a main brief, an order may be issued allowing plaintiff until a set time, not less than fifteen days, in which to show cause why the Board should not treat such failure as a concession of the case. If plaintiff fails to file a response to the order, or files a response indicating that plaintiff has lost interest in the case, judgment may be entered against plaintiff. If a plaintiff files a response to the order showing good cause, but does not have any evidence of record and does not move to reopen its testimony period and make a showing of excusable neglect sufficient to support such reopening, judgment may be entered against plaintiff for failure to take testimony or submit any other evidence.*

### 801.02(a) Plaintiff's Main Brief

The main brief of the party in the position of plaintiff is due not later than 60 days after the date set for the close of the rebuttal testimony period. [Note 1.]

If a party in the position of plaintiff fails to file a main brief, the Board may issue an order allowing plaintiff until a set time, not less than 15 days, in which to show cause why its failure to file a main brief should not be treated as a concession of the case. If the plaintiff fails to file a response to the order, or files a response indicating that it has lost interest in the case, judgment may be entered against the plaintiff. [Note 2.] The purpose of this order to show cause procedure is to save the Board the burden of determining a case on the merits where the parties have settled, but have neglected to notify the Board, or where the plaintiff has lost interest in the case. It is the policy of the Board not to enter judgment against a plaintiff, for failure to file a main brief on the case, where the plaintiff, in its response to the show cause order, indicates that it has not lost interest in the case. However, even if the Board discharges the show cause order because the plaintiff files a response indicating that it has not lost interest in the case, if the plaintiff does not have any evidence of record, and does not file a motion to reopen its testimony period and make a sufficient showing of excusable neglect to support such reopening, the Board still may enter judgment against plaintiff for failure to take testimony or submit any other evidence. [Note 3.]

For further information concerning the [37 C.F.R. § 2.128\(a\)\(3\)](#) order to show cause procedure, see [TBMP § 536](#). For information on reopening time, see [TBMP § 509](#).

#### NOTES:

1. [37 C.F.R. § 2.128\(a\)\(1\)](#).
2. [37 C.F.R. § 2.128\(a\)\(3\)](#). See *CTRL Systems Inc. v. Ultraphonics of North America Inc.*, 52 USPQ2d 1300, 1302 (TTAB 1999) (opposer's failure to respond to order to show cause under 37 C.F.R. § 2.128 resulted in entry of judgment).
3. [37 C.F.R. § 2.128\(a\)\(3\)](#). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69952 (October 7, 2016) ("This final rule codifies case law and Board practice under which the Board may sua sponte grant judgment for the defendant when the plaintiff has not submitted evidence, even where the plaintiff has responded to the Board's show cause order for failure to file a brief but has either not moved to reopen its trial period or has not been successful in any such motion.") (citing *Gaylord Entertainment Co. v. Calvin Gilmore Productions, Inc.*, 59 USPQ2d 1369, 1372 (TTAB 2000)).

### 801.02(b) Defendant's Main Brief

The filing of a brief on the case is optional, not mandatory, for a party in the position of defendant. [Note 1.]

However, if a party in the position of defendant wishes to file a brief on the case, the brief is due not later than 30 days after the due date of the plaintiff's main brief. [Note 2.] For information on extensions of time, see [TBMP § 509](#).

**NOTES:**

1. [37 C.F.R. § 2.128\(a\)\(1\)](#). See also *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1531 n.13 (TTAB 2018) (as defendant in cancellation, respondent not required to submit evidence or a brief, so failure to do so not treated as concession of case).

2. [37 C.F.R. § 2.128\(a\)\(1\)](#). See also *Ariola-Eurodisc Gesellschaft v. Eurotone International Ltd.*, 175 USPQ 250, 250 (TTAB 1972) (uncontested motion to strike brief filed three weeks after due date granted).

**801.02(c) Plaintiff's Reply Brief**

The filing of a reply brief is optional for a party in the position of plaintiff. [Note 1.]

If a party in the position of plaintiff wishes to file a reply brief, the brief is due not later than 15 days after the due date of the defendant's main brief. [Note 2.] However, if the defendant has not filed a main brief, any reply brief filed by the plaintiff may not be considered because there is nothing to which it could reply.

Objections raised for the first time in a reply brief are untimely because they effectively foreclose the adverse party from responding to the objections. [Note 3.] See [TBMP § 707.01](#).

**NOTES:**

1. [37 C.F.R. § 2.128\(a\)\(1\)](#).

2. [37 C.F.R. § 2.128\(a\)\(1\)](#).

3. *Grote Industries, Inc. v. Truck-Lite Co., LLC*, 126 USPQ2d 1197, 1199 (TTAB 2018) (evidentiary objections raised for first time in reply brief are untimely). Cf. *Productos Lacteos Tocumbo S.A. de C.V. v. Paleteria La Michoacana Inc.*, 98 USPQ2d 1921, 1928 (TTAB 2011) (objection not maintained in opening brief but renewed in reply brief is untimely), *aff'd*, 188 F. Supp. 3d 222 (D.D.C. 2016), *aff'd*, 743 F. App'x 457, 128 USPQ2d 1172 (D.C. Cir. 2018); *Kohler Co. v. Baldwin Hardware Corp.*, 82 USPQ2d 1100, 1104 (TTAB 2007) (same).

**801.02(d) Reply Brief for Defendant Not Permitted**

There is no provision for filing a reply brief, rebuttal brief, rejoinder brief, etc. by a party in the position of defendant. [Note 1.] If a party in the position of defendant files such a brief, it may be stricken, or given no consideration, by the Board. [Note 2.] The party in the position of defendant may counter any arguments raised in plaintiff's reply brief during oral argument. [Note 3.]

However, if a defendant has counterclaimed to cancel a registration owned by the plaintiff, the defendant, as plaintiff in the counterclaim, may file a reply brief directed to the counterclaim. [TBMP § 801.02\(e\)](#).

**NOTES:**

1. *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (“the plain language of the TBMP states that the TTAB is not required to permit ‘a party in the position of defendant’ to file a reply brief.”).

2. *Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Federal Circuit found that the Board did not abuse its discretion in applying the plain language of the TBMP and excluding defendant's reply brief).

3. *United Foods Inc. v. United Airlines Inc.*, 33 USPQ2d 1542, 1542 (TTAB 1994) (respondent may counter any arguments raised in petitioner's reply brief during oral argument).

### **801.02(e) Special Situations**

Since January 2017, the Board usually sets, by written action in all cases in which a scheduling order is issued, the due dates for the filing of briefs on the case. Enhancements to electronic systems permits this to be done easily.

There are specific circumstances in which the Board has traditionally set the briefing dates. These are when (1) there is a counterclaim, (2) proceedings have been consolidated, and one party is in the position of plaintiff in one of the involved proceedings and in the position of defendant in another, or (3) there is an interference or a concurrent use registration proceeding involving more than two parties. [Note 1.]

For example, if there is a counterclaim, the Board will issue an order setting the due dates for plaintiff's main brief in the original proceeding (due the 60th day after the date set for the close of rebuttal testimony); defendant's combined brief as defendant in the original proceeding and as plaintiff in the counterclaim (due the 30th day after the due date of the plaintiff's main brief); plaintiff's combined reply brief in the original proceeding and its brief as defendant in the counterclaim (due the 30th day after the due date of defendant's combined brief as defendant in the original proceeding and as plaintiff in the counterclaim); and defendant's reply brief as plaintiff in the counterclaim (due the 15th day after the due date of plaintiff's combined reply brief in the original proceeding and brief as defendant in the counterclaim). Combined briefs may not exceed the page limit for a brief. [Note 2.] See the TBMP Appendix of Forms for a sample briefing trial order with a counterclaim.

In an interference or concurrent use registration proceeding, the Board will schedule briefing periods so that each party in the position of plaintiff will have a period for filing a main brief on the case, each party in the position of defendant will have a period for filing a main brief in which it may respond to the brief of each plaintiff, and each party in the position of plaintiff will have a period for filing a reply brief. [Note 3.] [See TBMP § 1007](#) and [TBMP § 1109](#).

If a reviewing court vacates and/or remands a final decision for further proceedings, the Board has the discretion to order rebriefing of the case. [Note 4.]

#### **NOTES:**

1. [37 C.F.R. § 2.128\(a\)\(2\)](#).

2. *Cf. Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478, 1479 (TTAB 2008) (one cannot exceed the page limitation for a brief by combining an opposition brief and a cross-motion addressing the same issue).

3. [37 C.F.R. § 2.121\(b\)\(2\)](#).

4. *See, e.g., Frito-Lay North America, Inc. v. Princeton Vanguard, LLC*, 124 USPQ2d 1184, 1186 (TTAB 2017) (on remand from the Federal Circuit for further proceedings, Board ordered the parties to rebrief the case on the original record), *on appeal sub nom Snyder's Lance, Inc. v. Frito-Lay North America, Inc.*, No 3:17-CV-00652 (W.D.N.C. November 6, 2017).

### 801.03 Form and Contents of Brief

#### 37 C.F.R. § 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.*

37 C.F.R. § 2.128(b) **Briefs at final Hearing.** *Briefs must be submitted in written form and must meet the requirements prescribed in § 2.126. Each brief shall contain an alphabetical index of cases cited. Without prior leave of the Trademark Trial and Appeal Board, a main brief on the case shall not exceed fifty-five pages in length in its entirety, including the table of contents, index of cases, description of the record, statement of the issues, recitation of the facts, argument, and summary; and a reply brief shall not exceed twenty-five pages in its entirety. Evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit. Any brief beyond the page limits and any brief with attachments outside the stated requirements may not be considered by the Board.*

A brief on the case must be submitted in written form and must meet the general requirements for submissions to the Board specified in [37 C.F.R. § 2.126](#). A party must file a brief on the case electronically through ESTTA. See [TBMP § 110](#) for further information regarding ESTTA. The requirements for electronic filing are set out in [37 C.F.R. § 2.126\(a\)](#). [Note 1.] See [TBMP § 106.03](#) for further information regarding the form of submissions.

If ESTTA is unavailable due to technical problems, or if extraordinary circumstances exist, a party may file a brief on the case in paper form. The requirements for paper filing are set forth in [37 C.F.R. § 2.126\(b\)](#). A brief filed in paper form must include a written explanation of such technical problems or extraordinary circumstances, or it will not be considered. [Note 2.]

In addition to the general requirements for submissions to the Board, briefs at final hearing are also subject to the page limitations specified in [37 C.F.R. § 2.128\(b\)](#). The Board may not consider briefs exceeding the page limit. [Note 3.]

As provided in [37 C.F.R. § 2.128\(b\)](#), without prior leave of the Board, a main brief on the case may not exceed 55 pages in length in its entirety, and a reply brief may not exceed 25 pages in its entirety. The parts of the brief that fall within the length limit include the table of contents, index of cases, description of the record, statement of the issues, recitation of facts, argument, and summary. Extensive single-spaced footnotes may not be used as a subterfuge to avoid the page limit. [Note 4.] Exhibits or appendices to a brief, not being part of the brief itself, are not included within the page limit. [Note 5.] In addition, evidentiary objections that may properly be raised in a party's brief on the case may instead be raised in an appendix or by way of a separate statement of objections. The appendix or separate statement is not included within the page limit. [Note 6.] Nevertheless, appendices to a brief may not be used to avoid the page limitation. [Note 7.]

For information concerning motions for leave to file a brief exceeding the page limit, see [37 C.F.R. § 2.128\(b\)](#) and [TBMP § 537](#).

The brief must contain an alphabetic index of all cited cases. When cases are cited in a brief, the case citation should include a citation to The United States Patents Quarterly (USPQ), if the case has appeared in that publication. [Note 8.] See [TBMP § 101.03](#) for further information on decisional law. The Board permits, but does not encourage, the citation of non-precedential final decisions. A decision that is not designated as precedential is not binding on the Board, but may be cited for whatever persuasive value it might have. Citation to a non-precedential decision may be to TTABVUE. If a non-precedential decision does not appear in the USPQ or TTABVUE, the citing party should append a copy of the decision to the motion or brief in which the decision is cited. [Note 9.] See [TBMP § 101.03](#).

While parties may cite relevant cases from any jurisdiction, the Board relies primarily on precedent from the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"), not only because the Federal Circuit is the Board's primary reviewing court, but also because its cases address registration issues more specifically. [Note 10.] See [TBMP § 101.03](#).

The description of the record should comprise a list of the evidence properly introduced by the parties, such as, "The evidence of record consists of Opposer's Registration No. 1,234,567; Applicant's answers to opposer's interrogatories; the discovery deposition of Mr. X; and the testimony depositions of opposer's witnesses, Mr. Y and Ms. Z." For each significant fact recited, the recitation of facts should include a citation to the portion of the evidentiary record where supporting evidence may be found. When referring to the record in an inter partes proceeding before the Board, parties should include a citation to the TTABVUE entry and page number (*e.g.*, 1 TTABVUE 2) to allow the reader to easily locate the cited materials. [Note 11.] For information regarding citation in ex parte appeals, see [TBMP § 1203.01](#).

If a mark that is the subject of, or is pleaded in, a proceeding includes stylization or a design feature, a reproduction of the mark should be included in the brief on the case.

If a plaintiff files a reply brief, the brief must be confined to rebutting the defendant's main brief. In other words, the reply brief shall be limited to the key points in defendant's brief which plaintiff believes require clarification or response.

**Confidential information.** Except for materials filed under seal pursuant to a protective order, the files of applications and registrations which are the subject matter of pending proceedings before the Board and all pending proceeding files and exhibits thereto are available for public viewing on the USPTO web site via TTABVUE at <http://ttabvue.uspto.gov/>. [Note 12.] See [TBMP § 412.05](#) for further information on handling of confidential materials by the Board. In accordance with [37 C.F.R. § 2.126\(c\)](#), a party who submits a brief containing confidential information under seal or designated as confidential in ESTTA must submit the brief using the "Confidential" selection in ESTTA or, where appropriate, under a separate paper cover. The party must mark both the submission and its cover "confidential," and must identify the case number and parties. The party must also concurrently submit for the public record a redacted version of the brief. [Note 13.] For material or testimony that has been designated confidential and which cannot be viewed on TTABVUE, the parties should include the TTABVUE docket entry and page numbers for the redacted version and the TTABVUE docket entry number for the confidential version of the brief. [Note 14.]

In addition, in the confidential brief, parties are strongly encouraged to enclose confidential information in brackets to better mark the specific information to be kept confidential. This facilitates a better comparison between the public and confidential versions of the briefs when the Board is preparing a final decision, and will reduce the possibility of the Board inadvertently including confidential information in a final decision. See [TBMP § 110](#) and [TBMP § 412.04](#) for further information on filing confidential material using ESTTA, and [TBMP § 120.02](#) for further information on confidential materials in general.

The Board's standard protective order is automatically applicable throughout all inter partes proceedings, subject to specified exceptions, unless modified by the parties and approved by the Board. [Note 15.] For further information on protective orders, see [TBMP § 412](#).

When necessary to articulate the reasoning of the Board decision, the Board may treat as not confidential material which cannot reasonably be considered confidential, notwithstanding a party's designation. [Note 16.] For further information regarding confidential materials see [TBMP § 120.02](#) and [TBMP § 412](#).

#### NOTES:

1. [37 C.F.R. § 2.126\(a\)](#) codifies the use of electronic filing. The Board does not accept briefs filed on CD or DVD, but continues its current practice of accepting a CD or DVD as an exhibit to a deposition where the proffering party authenticates and introduces audio and/or video evidence, such as commercials. See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

2. See [37 C.F.R. § 2.126\(b\)](#); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69966 (October 7, 2016).

3. [37 C.F.R. § 2.128\(b\)](#). Cf. *Hole In 1 Drinks, Inc. v. Michael Lajtay*, 2020 USPQ2d 10020, at \*2 (TTAB 2020) (single spaced, seven-page brief considered because it was not an attempt to circumvent the page limits).

4. *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992) (warned that single-spaced footnotes containing substantial discussion may be viewed as a subterfuge to avoid page limit).
5. See [37 C.F.R. § 2.128\(b\)](#); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753-54 (TTAB 2013) (raising evidentiary objections in appendices was not viewed as subterfuge to avoid page limit), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (same); *United Foods Inc. v. United Air Lines Inc.*, 33 USPQ2d 1542, 1543 (TTAB 1994) (motion to file 30-page reply brief denied as unnecessary where main brief was 18 pages and responsive brief was 37 pages); and *Consorzio del Prosciutto di Parma v. Parma Sausage Products Inc.*, 23 USPQ2d 1894, 1896 n.3 (TTAB 1992).
6. See [37 C.F.R. § 2.128\(b\)](#); *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753-54 (TTAB 2013) (appropriate evidentiary objections may be raised in appendix or separate submission rather than in text of brief), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (same); *Marshall Field & Co. v. Mrs. Fields Cookies*, 25 USPQ2d 1321, 1326 (TTAB 1992).
7. *Alcatraz Media, Inc. v. Chesapeake Marine Tours Inc. dba Watermark Cruises*, 107 USPQ2d 1750, 1753-54 (TTAB 2013) (appendices may not be used as a subterfuge to avoid the page limitation), *aff'd*, 565 F. App'x 900 (Fed. Cir. 2014) (mem.); *Harjo v. Pro-Football Inc.*, 45 USPQ2d 1789, 1792 (TTAB 1998) (same).
8. See *Lebanon Seaboard Corp. v. R&R Turf Supply Inc.*, 101 USPQ2d 1826, 1830 (TTAB 2012) (include citation to the USPQ if the case appeared in that reporter); *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1736 n.11 (TTAB 2012) (same); *In re Carlson*, 91 USPQ2d 1198, 1199 n.2 (TTAB 2009).
9. *Corporacion Habanos SA v. Rodriquez*, 99 USPQ2d 1873, 1875 n.5 (TTAB 2011) (although parties may cite to non-precedential cases, the Board does not encourage the practice); *Citation of Opinions to the Trademark Trial and Appeal Board*, O.G. Notice (January 23, 2007).
10. *Grand Canyon West Ranch LLC v. Hualapai Tribe*, 88 USPQ2d 1501, 1506 n.2 (TTAB 2008).
11. Cf. [37 C.F.R. § 2.142\(b\)\(3\)](#). *RxD Media, LLC v. IP Application Development LLC*, 125 USPQ2d 1801, 1804 (TTAB 2018) (Board prefers citation to the TTABVUE record); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014) (same).
12. [37 C.F.R. § 2.27\(d\)](#) (“The official records of applications and all proceedings relating thereto are available for public inspection”. . . .) and [37 C.F.R. § 2.27\(e\)](#) (filing and handling of confidential matter). See, e.g., *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (Board agreed to hold exhibits marked confidential for thirty days pending receipt of a motion for a protective order but cautioned that in the absence of such motion, the exhibits would be placed in the proceeding file), *rev'd on other grounds*, 284 F. Supp. 2d 96, 68 USPQ2d 1225 (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).
13. [37 C.F.R. § 2.126\(c\)](#); *Turdin v. Trilobite, Ltd.*, 109 USPQ2d 1473, 1476 n.6 (TTAB 2014); *Duke University v. Hagggar Clothing Inc.*, 54 USPQ2d 1443, 1445 (TTAB 2000) (redacted copy deleting confidential

matters must be filed). *See also Fiserv, Inc. v. Electronic Transaction Systems Corp.*, 113 USPQ2d 1913 (TTAB 2015) (entry of confidential exhibits and briefs in ACR case).

14. *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1468 n.6 (TTAB 2016).

15. [37 C.F.R. § 2.116\(g\)](#).

16. [37 C.F.R. § 2.116\(g\)](#). *See* MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69959 (October 7, 2016) (“The purpose of the rule is to codify existing practice to treat improperly designated material that is public information as public. This is narrowly applied and only done when necessary to articulate the Board decision. *See, e.g., Couch/Braunsdorf Affinity, Inc. v. 12 Interactive, LLC*, 110 USPQ2d 1458, 1461 (TTAB 2014).”).

#### 801.04 Amicus Briefs

The Board may, in its discretion, entertain an amicus brief. An entity that wishes to file an amicus brief should file a motion with the Board for leave to do so. For information concerning motions for leave to file an amicus brief, see [TBMP § 538](#).

#### 801.05 Motion to Strike Brief on Case

A party may move to strike a brief on the case on a variety of grounds, including that the brief was untimely filed, exceeds the page limit for a brief on the case, violates the format requirements for such a brief, or is a brief not provided for by the applicable rules (e.g., is a reply brief filed by the defendant). [Note 1.] In addition, a party may move to strike evidentiary matter attached to a brief where the evidentiary matter was not properly made of record during the time for taking testimony. For information concerning motions to strike a brief on the case, or matter attached to such a brief, see [TBMP § 539](#).

1. *Cf. Zheng Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 127 USPQ2d 1797, 1799 (Fed. Cir. 2018) (Federal Circuit found that the Board did not abuse its discretion in applying the plain language of the TBMP and excluding defendant’s reply brief).

### 802 Oral Hearing

#### [37 C.F.R. § 2.129](#) *Oral argument; reconsideration.*

(a) *If a party desires to have an oral argument at final hearing, the party shall request such argument by a separate notice filed not later than ten days after the due date for the filing of the last reply brief in the proceeding. Oral arguments will be heard by at least three Administrative Trademark Judges or other statutory members of the Trademark Trial and Appeal Board at the time specified in the notice of hearing. If any party appears at the specified time, that party will be heard. Parties and members of the Board may attend in person or, at the discretion of the Board, remotely. If the Board is prevented from hearing the case at the specified time, a new hearing date will be set. Unless otherwise permitted, oral arguments in an inter partes case will be limited to thirty minutes for each party. A party in the position of plaintiff may reserve part of the time allowed for oral argument to present a rebuttal argument.*

(b) *The date or time of a hearing may be reset, so far as is convenient and proper, to meet the wishes of the parties and their attorneys or other authorized representatives. The Board may, however, deny a request to reset a hearing date for lack of good cause or if multiple requests for rescheduling have been filed.*

For general information concerning oral hearings in ex parte appeals to the Board, see [TBMP § 1216](#)

**Please Note:** Administrative Trademark Judges and other statutory members of the Board collectively are referred to as “judges.”

## 802.01 In General

The oral hearing on the case in an inter partes proceeding before the Board corresponds to the oral summation in court proceedings after all the evidence is in. [Note 1.] For information on oral hearings in ex parte cases, see [TBMP § 1216](#).

An oral hearing is optional and is scheduled only if a timely request therefor is filed by a party to the proceeding. In the vast majority of cases, an oral hearing is not requested. The oral hearing provides a party with one last opportunity to emphasize its strongest arguments, and to refute its adversary’s arguments. It is particularly useful in cases with complex issues or a complex record, or where the defendant needs to respond to arguments in the plaintiff’s reply brief. If neither party requests an oral hearing, the case will be decided on the evidence made of record during the testimony periods.

Subject to Fed. R. Civ. P. 11, a party is entitled to offer at oral hearing any argument it feels will be to its advantage. However, the facts recited and arguments made at oral hearing must be based on the evidence offered at trial. An oral hearing may not be used as a vehicle for the introduction of evidence. [Note 2.] [TBMP § 704.06](#) and [TBMP § 801.01](#) .

Board practice does not allow parties to submit additional comments or clarify their positions after oral hearing unless specifically requested to do so by the Board. [Note 3.]

Following an oral hearing, the Board will add as an entry in TTABVUE an “Appearance Record” identifying the presiding judges and the individuals who appeared on behalf of each party.

Questions or inquiries regarding an oral hearing can be directed to [TTABHearings@uspto.gov](mailto:TTABHearings@uspto.gov)

Parties and judges may attend oral hearings in person or, at the discretion of the Board, remotely through video conference. [Note 4.]

### NOTES:

1. [37 C.F.R. § 2.116\(f\)](#).
2. See [37 C.F.R. § 2.123\(k\)](#).
3. *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1739 n.19 (TTAB 2012) (“Motion to Request Clarification After Oral Argument” denied; “[i]f petitioner had some question about how to comply with the Board’s request, perhaps in view of the confidentiality agreements the parties had signed, a motion for clarification might have been warranted on this subject.”).
4. [37 C.F.R. § 2.129\(a\)](#).

## 802.02 Request for Oral Hearing

A party that wishes to have an oral hearing on the case must file a request, by separate submission via ESTTA – not as part of its brief on the case – not later than 10 days after the due date for filing the last reply brief in the proceeding. [Note 1.] Under certain limited circumstances, a party may file a request for oral hearing via paper submission. [Note 2.] Any party to the proceeding may request a hearing.

The Board will issue an order acknowledging receipt of the request and allowing time for submission of several potential dates for the hearing, agreed upon by both parties, if the information was not provided in the request. The response also should indicate whether either party will attend the oral hearing by video conference. Such information is intended to assist the Board in scheduling the oral hearing. Ordinarily, hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time). The Board will notify the parties by written order the date and time of the scheduled hearing.

If an oral hearing is not requested, the case will be decided in due course after the due date for filing the last reply brief on the case.

### NOTES:

1. [37 C.F.R. § 2.126\(a\)](#); [37 C.F.R. § 2.129\(a\)](#).
2. [37 C.F.R. § 2.126\(b\)](#).

## 802.03 Time and Place of Hearing

When a timely request for an oral hearing on the case has been filed by a party to an inter partes proceeding before the Board, the Board sets the date and time for the hearing with input from the parties, and sends each party written notice of the hearing specifying the date, time, and location of the hearing. [Note 1.] Oral hearings are scheduled on Tuesdays, Wednesdays and Thursdays between 10:00 a.m. and 3:00 p.m. (Eastern Time). In setting an oral hearing, the Board normally expects the parties, or their attorneys or other authorized representatives, to confer with each other to determine at least three convenient dates (suggested to be within the next four to eight weeks) and times for the hearing within the foregoing parameters. It is recommend that the requesting party provide that information to the Board with the request for oral hearing. If the parties do not provide potential dates with the request for oral hearing, the Board will issue an order asking the parties to provide three possible dates. If the Board issues such an order and the parties do not respond, or the response does not include agreed upon dates or a reason why the parties could not reach consensus on the dates, the Board will consider the request for oral hearing to be waived.

Oral hearings typically are held at the offices of the Board but may be held elsewhere in conjunction with conferences or continuing legal education programs.

Attendance at a scheduled oral hearing is voluntary, not mandatory. If any party appears at the specified time, the party will be heard, whether or not the party that appears is the one that requested the hearing. [Note 2.]

Any party who does not intend to be present for the oral hearing should notify the Board at least two (2) weeks in advance of the scheduled hearing date. If a party, or its attorney, that requested an oral hearing fails to appear at the appointed time, without giving prior notice to the Board of its nonappearance, that party's right to an oral hearing will be deemed waved, and the hearing will not be rescheduled.

**NOTES:**

1. [37 C.F.R. § 2.129\(a\)](#).
2. [37 C.F.R. § 2.129\(a\)](#).

**802.03(a) Rescheduling a Hearing**

If the Board is prevented from hearing the case at the time specified in the notice of hearing, a new hearing date will be set. [Note 1.] The Board will reschedule an oral hearing, at the request of the parties, if there is a reasonable basis for the request; but, absent compelling circumstances or the consent of all other parties, a hearing date will not be changed if the request for rescheduling is made within two weeks of the scheduled hearing date. A party who wishes to reschedule an oral hearing with the consent of all parties must first determine at least three agreed-upon, non-consecutive dates and times, and file through ESTTA a written stipulation or consented motion confirming the parties' agreement to reschedule, and the proposed three new dates and times. The agreed-upon dates must be between four and eight weeks from the mailing date of the Board scheduling order setting the original hearing date. The parties should also contact the Board's Hearing and Decision Specialist by telephone to provide notification of the filed stipulation or consented motion to reschedule. If the parties agree to reschedule an oral hearing due to settlement negotiations, they should request that proceedings, including the time for oral hearing, be suspended pending completion of the negotiations. If agreement cannot be reached, the party that wishes to have the hearing reset must file through ESTTA a motion therefor showing good cause. [Note 2.] Parties should not file repeated requests to reschedule an oral hearing. The Board may deny a request to reschedule a hearing date for lack of good cause or if multiple requests for rescheduling have been filed. [Note 3.]

**NOTES:**

1. [37 C.F.R. § 2.129\(a\)](#).
- 2, *See* [37 C.F.R. § 2.129\(b\)](#).
3. [37 C.F.R. § 2.129\(b\)](#). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69968 (October 7, 2016).

**802.03(b) Attendance by Video Connection**

For hearings held at the offices of the Board, a party may request attendance via video connection from another location. A video conference will be conducted in the same manner as if conducted entirely in the hearing room.

When a party submits its written request for an oral hearing, it should indicate if it is also requesting to attend by video conference. A request to attend a hearing by video conference may also be made in response to the Board order which issues after a party submits a request for oral hearing. Otherwise, a party is expected to appear in person unless it has clearly stated, in its initial request for oral hearing or in its response to the Board's order, its intent to participate by video conference. A party that has not timely and clearly stated its intent to participate by video conference may not be able to switch to video participation without also rescheduling any already scheduled date for the hearing.

The USPTO does not provide the parties with the means to participate by video conference. The party requesting attendance at the oral hearing through a video conference is responsible for arranging and paying for its video connection. The Board cannot assist the party in this endeavor. The requesting party also is responsible for contacting a USPTO video conference technician by email at [VTCOPS@USPTO.gov](mailto:VTCOPS@USPTO.gov) no fewer than three business days before the confirmed hearing date to provide the proceeding number(s), the date/time of the hearing, and the type of equipment that the party plans to use. A USPTO video conference technician will schedule a test of the equipment the party plans to use. The Board will liberally grant remote attendance, but retains discretion to account for any technological limitations. [Note 1.]

For information concerning requests to reset an oral hearing, see [TBMP § 541.01](#).

#### NOTES:

1. [37 C.F.R. § 2.129\(a\)](#). MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES OF PRACTICE, 81 Fed. Reg. 69950, 69968 (October 7, 2016).

### 802.04 Before Whom Held

An oral hearing is held before a panel of at least three members of the Board (i.e., its statutory members, generally administrative trademark judges), who may attend oral argument in person or remotely. [Note 1.] Normally, an oral hearing panel consists of only three judges. If for some reason a judge on a panel of three that heard the oral argument is unable to participate in the final decision, another judge may be substituted at final decision for the unavailable judge, even though the substituted judge was not present at the oral hearing; no new oral hearing is necessary. [Note 2.]

The Director of the USPTO or the Board may, in its discretion, use an augmented panel to hear a case. A decision to use an augmented panel may be made either upon the Director's or the Board's own initiative, or upon motion filed by a party to the proceeding. [Note 3.]

For information concerning motions for an augmented panel hearing, see [TBMP § 540](#). For further information concerning the constitution of Board panels, see *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547-51 (Fed. Cir. 1994) (en banc).

#### NOTES:

1. See Trademark Act § 17, [15 U.S.C. § 1067\(b\)](#); [37 C.F.R. § 2.129\(a\)](#); MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69967 (Oct. 7, 2016) (codifying current practice that all statutory members of the Board may hear oral argument and parties and members of the Board may attend oral argument in person or, at the discretion of the Board, remotely). See also *Knickerbocker Toy Co. v. Faultless Starch Co.*, 467 F.2d 501, 175 USPQ 417, 420 n.8 (CCPA 1972) (where only one Board member's name appeared on decision, court presumed the proper number participated in decision).

2. See *Swiss Watch International Inc. v. Federation of the Swiss Watch Industry*, 101 USPQ2d 1731, 1732 n.1 (TTAB 2012) (change in composition of panel does not necessitate a rehearing of oral argument); *Hunt Control Systems Inc. v. Koninklijke Philips Electronics N.V.*, 98 USPQ2d 1558, 1560 n.1 (TTAB 2011) (same); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066, 1068 n.1 (TTAB 2011) (same). See also *In re Bose Corp.*, 772 F.2d 866, 869, 227 USPQ 1, 3-4 (Fed. Cir. 1985) (statutory requirement that a case be heard "means judicially heard not physically heard"); *Jockey International, Inc. v. Bette Appel*

*Unltd.*, 216 USPQ 359, 360 (TTAB 1982). *Cf. Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199 (TTAB 1981), *set aside on other grounds and new decision entered*, 217 USPQ 464, 464 (TTAB 1983) (final decision rendered by only two Board members vacated); *Ronson Corp. v. Ronco Teleproducts, Inc.*, 197 USPQ 492, 494 (Comm'r 1978) (final decision heard by three Board members but rendered by only two, vacated and oral hearing rescheduled); and *Ethicon, Inc. v. American Cyanamid Co.*, 193 USPQ 374, 377 (Comm'r 1977) (petition to vacate decision denied).

3. *See In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547-51 (Fed. Cir. 1994) (en banc) (Director has the authority under § 7 of the Patent Act (now § 6 of the Leahy-Smith America Invents Act) to convene an expanded panel which includes not only administrative patent judges, but also one or more of the senior executive officers of the USPTO identified in that section, including himself or herself). *Cf.* 15 U.S.C. § 1067 (containing similar provisions for the TTAB).

*See also N.Y. Yankees Partnership v. IET Products & Services, Inc.*, 114 USPQ2d 1497 (TTAB 2015) (augmented seven-member panel used to sustain opposition regarding dilution by blurring claim); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (augmented panel used to affirm examining attorney's refusal to register the mark KHORAN as disparaging under Trademark Act § 2(a)); *In re Ferrero S.p.A.*, 22 USPQ2d 1800 (TTAB 1992) (augmented panel used to overrule previous decision barring examining attorneys from requesting reconsideration), *recon. denied*, 24 USPQ2d 1061 (TTAB 1992); *In re Johanna Farms Inc.*, 8 USPQ2d 1408, 1409 (TTAB 1988) (in view of issues presented, oral hearing held before augmented panel of eight Board members); *In re McDonald's Corp.*, 230 USPQ 210 (TTAB 1986) (augmented five-member panel); and *In re WSM, Inc.*, 225 USPQ 883 (TTAB 1985) (augmented panel used to delineate rights in FCC "assigned" call letters for radio broadcasting services). *See also In re Active Ankle Systems Inc.*, 83 USPQ2d 1532, 1534 (TTAB 2007) (an augmented panel is not necessary to reach the proper decision where the examining attorney relied on cases that are no longer good law); *Crocker National Bank v. Canadian Imperial Bank of Commerce*, 223 USPQ 909, 909 n.1 (TTAB 1984) (augmented panel of eight members because of the importance of the issues). *Cf.* Federal Circuit Rule 35. *Cf. also Fioravanti v. Fioravanti Corrado S.R.L.*, 1 USPQ2d 1304, 1305 (TTAB 1986) (case not appropriate for designation of augmented panel on request for en banc consideration).

## 802.05 Length of Oral Argument

Ordinarily, each party in a Board inter partes proceeding is allowed 30 minutes for its oral argument. If it so desires, the plaintiff may reserve part of its 30 minutes for rebuttal. [Note 1.] No additional time for oral argument is allotted for counterclaims or consolidated proceedings. Accordingly, if there is a counterclaim, the defendant, as the plaintiff in the counterclaim, may also reserve part of its 30 minutes for rebuttal on the counterclaim.

There is no requirement that a party use all of its allotted 30 minutes for oral argument. Often a case may be presented in considerably less than 30 minutes.

On the other hand, if a party feels that it needs more than 30 minutes for oral argument, it may file a request with the Board for additional time. [Note 2.] If the request is granted, each party will be allowed the same amount of time for oral argument. For information concerning requests or motions for additional time for oral argument, see [TBMP § 541.02](#).

### NOTES:

1. [37 C.F.R. § 2.129\(a\)](#).

2. See [37 C.F.R. § 2.129\(a\)](#); *U.S. Navy v. United States Manufacturing Co.*, 2 USPQ2d 1254, 1255 (TTAB 1987) (additional time for arguments allowed in view of voluminous record).

## 802.06 Audio Recording and Video Recording

Upon motion showing good cause and with prior arrangement, the Board will usually permit a party to make an audio recording of an oral hearing. [Note 1.] The recording, when permitted by the Board, is strictly for the party's private use, and is not to be used for purposes of publicity, or as "evidence" in any proceeding (the oral hearing is not part of the evidentiary record in a proceeding before the Board). The motion should be filed well in advance of the date set for the oral hearing, so if an objection is raised, the Board will have time to rule on the matter. For information concerning motions for leave to audio record an oral hearing see [TBMP § 542](#).

If permission to record an oral hearing is granted, the moving party is responsible for furnishing, operating, and removing its own audio recording equipment in an unobtrusive manner.

A court reporter is distracting and disruptive in the context of an oral hearing before the Board, and therefore may not be used. For the same reason, an oral hearing before the Board may not be video recorded. [TBMP § 542](#).

### NOTES:

1. *But cf.* [37 C.F.R. § 2.120\(j\)\(3\)](#) (Parties prohibited from recording conferences held to determine stipulations, motions, and other interlocutory issues.).

## 802.07 Visual Aids, etc.

The Board will generally allow certain types of materials, such as graphs, large depictions of marks, schedules, charts, etc., to be used at oral hearing, either for clarification or to eliminate the need for extended description, when such materials are based on evidence properly of record. [Note 1.]

A party may also bring to the oral hearing any materials introduced as exhibits at trial, including audio or video recordings of commercials or demonstrations. A party that introduced an audio or video recording as an exhibit at trial which wishes to play the recording at the oral hearing should notify the Board in advance. In addition, a party that wishes to play such a recording at oral hearing is responsible for furnishing, operating, and removing the necessary equipment in an unobtrusive manner.

A party may not, however, use an oral hearing for the purpose of offering new evidence, whether in the form of charts, graphs, exhibits, or other such materials. [TBMP § 802.01](#). Nor may a party submit in writing the text of its oral argument; to allow such a practice would be to permit a party, in effect, to file an additional brief on the case. [Note 2.]

### NOTES:

1. See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.5 (TTAB 1990).

2. See *Reflange Inc. v. R-Con International*, 17 USPQ2d 1125, 1126 n.5 (TTAB 1990).

## 802.08 Nature of Hearing

Prior to an oral hearing, the judges read the briefs on the case and, if necessary, examine the case files. Thus, persons presenting oral arguments should not read from the briefs on the case, except to emphasize an admission contained in an adversary's brief.

Normally, an oral hearing case is not assigned to a particular judge to draft a final decision until after the oral hearing. Thus, the judge who sits in the middle of the panel of three is not necessarily the person to whom the case will be assigned for decision; rather, the middle panel member is usually (but not always) the senior judge.

A person presenting oral arguments should be prepared to answer questions from the judges at any point in the arguments. If exhibits or visual aids have been brought to the oral hearing, they should be shown to the adversary before they are shown to the judges. When a hearing is in session, no one should be heard except for counsel making an argument or a judge. Further, a person presenting oral arguments should never interrupt the oral arguments of the adversary.

## 803 Final Decision

After an oral hearing has been held in a Board inter partes proceeding, the case is set down for final decision. If no oral hearing is requested, the case is set down for final decision after the due date for filing the last reply brief.

A panel of at least three Administrative Trademark Judges or other statutory members of the Board (collectively "judges") renders the final decision. [Note 1.] See [TBMP § 802.04](#). When there has been an oral hearing in a case, the final decision normally is rendered by the panel before whom the oral hearing was held. If one of the three judges before whom an oral hearing was held is unable to participate in the final decision, another judge may be substituted at final decision for the missing judge. [TBMP § 802.04](#).

The Board may use an augmented panel at final decision. For information concerning the use of an augmented panel, see [TBMP § 540](#). For further information concerning the constitution of Board panels, see Trademark Act § 17, [15 U.S.C. § 1067](#); and *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545, 1547-51 (Fed. Cir. 1994) (en banc).

Every judge assigned to decide the case does not read the full evidentiary record in a case. Rather, one judge is assigned to read the testimony and examine the other evidence of record, discuss the case with the other judges, and then draft a decision and supporting opinion. The draft is circulated to the other judges for their approval. A judge who does not agree with the decision may write a dissent. [Note 2.] A judge who agrees with the decision, but disagrees with the reasoning expressed in the opinion supporting the decision, or wishes to express additional reasons, may write a concurring opinion.

When the judges rendering the decision have completed a final decision, a copy is sent to every party to the proceeding. All final decisions are posted on the USPTO website and available for public viewing via TTABVUE and the USPTO e-FOIA database. Both databases may be accessed by proceeding number or other criteria. A link to the USPTO e-FOIA database is available on the Board's webpage under "Board receipts & issued decisions" or may be accessed directly at <https://e-foia.uspto.gov/Foia/TTABReadingRoom.jsp>. For more information regarding access to files, see [TBMP § 120](#).

Trademark Act § 21, [15 U.S.C. § 1071](#), and [37 C.F.R. § 2.145](#) govern any appeal from a final decision of the Board. For more information regarding appeals, see [TBMP Chapter 900](#).

In some instances, the Board in its decision may not decide all of the tried claims. [Note 3.]

The Board in its discretion may issue a bifurcated decision on a matter raised in the parties' briefing prior to rendering a final decision on the merits. [Note 4.]

#### NOTES:

1. See Trademark Act § 17, [15 U.S.C. § 1067](#).
2. See, e.g., *Edwards Lifesciences Corp. v. VigiLanz Corp.*, 94 USPQ2d 1399 (TTAB 2010) (one judge dissenting). See also *In re Adlon Brand GmbH & Co. KG*, 120 USPQ2d 1717 (TTAB 2016) (same); *In re Lebanese Arak Corp.*, 94 USPQ2d 1215 (TTAB 2010) (two judges in augmented panel wrote dissent).
3. *Yazhong Investing Ltd. v. Multi-Media Tech. Ventures, Ltd.*, 126 USPQ2d 1526, 1540 n.52 (TTAB 2018) (Board has “discretion to decide only those claims necessary to enter judgment and dispose of the case,” as our “determination of registrability does not require, in every instance, decision on every pleaded claim.”) (quoting *Multisorb Tech., Inc. v. Pactive Corp.*, 109 USPQ2d 1170, 1171-72 (TTAB 2013)); *Azeka Bldg. Corp. v. Azeka*, 122 USPQ2d 1477, 1478 (TTAB 2017) (same). See also *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036, 2039-40 (TTAB 1989), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990) (non-precedential).
4. See, e.g., *Destileria Serralles, Inc. v. Kabushiki Kaisha Donq*, 125 USPQ2d 1463 (TTAB 2017) (Board addressed a pleading issue in a separate opinion).

### 804 Request for Rehearing, Reconsideration, or Modification of Final Decision

[37 C.F.R. § 2.129\(c\)](#) [*Oral argument; reconsideration.*] Any request for rehearing or reconsideration or modification of a decision issued after final hearing must be filed within one month from the date of the decision. A brief in response must be filed within twenty days from the date of service of the request. The times specified may be extended by order of the Trademark Trial and Appeal Board on motion for good cause.

A party may file a request for rehearing, reconsideration, or modification of a final decision. [Note 1.] The request must be filed within one month from the date of decision, and a responsive brief, if any, is due within 20 days of the date of service of the request. [Note 2] For information concerning requests for rehearing, reconsideration, or modification of a final decision see [TBMP § 543](#).

A party need not request reconsideration before it appeals a Board decision to the Federal Circuit or district court as provided in Trademark Act § 21, [15 U.S.C. § 1071](#); but, if a party wishes to request reconsideration, it must do so before seeking judicial review of the Board's decision. [Note 3.] For information about seeking judicial review of a Board decision see [TBMP Chapter 900](#).

#### NOTES:

1. [37 C.F.R. § 2.129\(c\)](#).

2. [37 C.F.R. § 2.129\(c\)](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (October 7, 2016) (“The Office is amending § 2.129(c) to reflect that all response dates initiated by a service date are twenty days.”).

3. [37 C.F.R. § 2.145\(a\)\(1\)](#) and [37 C.F.R. § 2.145\(c\)\(1\)](#).

## 805 Final Decision Remand to Examining Attorney

**[37 C.F.R. § 2.131](#) *Remand after decision in inter partes proceeding.*** *If, during an inter partes proceeding involving an application under Section 1 or 44 of the Act, facts are disclosed which appear to render the mark unregistrable, but such matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended under Rule 15(b) of the Federal Rules of Civil Procedure to conform to the evidence, the Trademark Trial and Appeal Board, in lieu of determining the matter in the decision on the proceeding, may remand the application to the trademark examining attorney for reexamination in the event the applicant ultimately prevails in the inter partes proceeding. Upon remand, the trademark examining attorney shall reexamine the application in the light of the matter referenced by the Board. If, upon reexamination, the trademark examining attorney finally refuses registration to the applicant, an appeal may be taken as provided by §§ 2.141 and 2.142.*

If, during the course of an opposition, concurrent use, or interference proceeding involving an application under Trademark Act § 1, [15 U.S.C. § 1051](#), or Trademark Act § 44, [15 U.S.C. § 1126](#), facts are disclosed which appear to render the mark of the involved application unregistrable, and the matter has not been tried under the pleadings as filed by the parties or as they might be deemed to be amended pursuant to Fed. R. Civ. P. 15(b), the Board, in its decision on the proceeding, may, in addition to determining the pleaded matters, remand the application to the examining attorney for further examination in light of the disclosed facts. That is, the Board may include in its decision a recommendation that in the event the applicant ultimately prevails in the inter partes proceeding, the examining attorney reexamine the application in light of the disclosed facts. [Note 1.] See also [TBMP § 515](#). Cf. [TBMP § 1217](#).

If a party to an opposition, concurrent use, or interference proceeding involving an application under Trademark Act § 1, [15 U.S.C. § 1051](#), or Trademark Act § 44, [15 U.S.C. § 1126](#), believes that the facts disclosed therein appear to render the mark of the involved application unregistrable, but the matter was not pleaded or tried by the express or implied consent of the parties pursuant to Fed. R. Civ. P. 15(b), the party may request that the Board include, in its decision in the proceeding, a [37 C.F.R. § 2.131](#) remand to the examining attorney. The request may be made in the party’s brief on the case, or by separate motion.

An application under Trademark Act § 66(a), [15 U.S.C. § 1141f\(a\)](#), may not be remanded under [37 C.F.R. § 2.131](#).

### NOTES:

1. [37 C.F.R. § 2.131](#). See, e.g., *First International Services Corp. v. Chuckles Inc.*, 5 USPQ 1628, 1636 n. 6 (TTAB 1988) (in the event applicants ultimately prevail, the involved application will be remanded to the examining attorney for reexamination).

## 806 Termination of Proceeding

When an inter partes proceeding before the Board has been finally determined (that is, when the time for filing an appeal from a decision of the Board determining the case has expired, and no appeal has been filed,

or when any appeals filed have been determined), the Board takes certain further steps, based on the judgment entered, to close out the proceeding file and give effect to the judgment. [Note 1.] The same is true when a proceeding ends by stipulation of the parties, voluntary withdrawal, or consent to judgment by one party.

For example, when a decision of the Board dismissing an opposition becomes final (that is, the time for filing an appeal has expired, and no appeal has been filed, or when any appeals filed have been finally determined), or the opposition is dismissed pursuant to a stipulation of the parties or as the result of a withdrawal by opposer, among other things, the Board normally takes the following steps:

- (1) The proceeding file, containing all the submissions filed therein, including filings marked as Confidential pursuant to a protective order, is updated to “Terminated” in TTABVUE.
- (2) After termination, exhibits which were filed in the case and which were not able to be scanned are disposed of by the Board in an appropriate manner unless the party who filed them makes prior arrangements to pick them up.
- (3) The opposition proceeding is updated by selecting an option to send the subject application for issuance of a notice of allowance under [37 C.F.R. § 2.81\(b\)](#) if the application is an intent-to-use application for which no amendment to allege use under [37 C.F.R. § 2.76](#) has been submitted and accepted; or for issuance of a registration pursuant to [37 C.F.R. § 2.81\(a\)](#).
- (4) The termination of the opposition proceeding will cause an update to the status of the subject application which is being allowed for issuance, which releases it back to the Trademark Operation for the issuance of a notice of allowance or registration.
- (5) When republication of the subject application is necessary, the status of the application is updated accordingly. This status update automatically queues the application for republication.
- (6) When reexamination of the subject application by the examining attorney is ordered pursuant to [37 C.F.R. § 2.131](#), the status of the application is updated accordingly and jurisdiction is restored to the examining attorney for further examination. See [TBMP § 805](#) for further information on final decision remands.
- (7) If the applicant has abandoned the subject application or if the Board orders the application to be abandoned, the status of the application is updated to “Abandoned” in TTABVUE.

The Board normally follows steps one and two set out above when a decision of the Board on a cancellation becomes final. In addition:

- (9) When a decision of the Board granting a petition for cancellation becomes final, the subject registration is cancelled, in whole or in part, by separate order of the Director with no further action by the parties. Upon the cancellation order by the Director, the cancellation proceeding is terminated in TTABVUE.
- (10) When a decision of the Board dismissing the petition for cancellation becomes final, the cancellation proceeding is terminated in TTABVUE and the status reverts to the earlier and otherwise appropriate status of the subject registration.

For further information concerning the status of an application or registration after termination of an opposition, cancellation, or concurrent use proceeding see [TBMP § 807](#).

Because the Board will take the termination steps described above when a Board decision appears to be final, a party that commences a civil action seeking review of the Board’s decision pursuant to Trademark Act § 21(b), [15 U.S.C. § 1071\(b\)](#), must file written notice thereof with the Board via ESTTA no later than five business days after the party files the complaint in the district court. The notice must include the case name, case number, and court in which the civil action was filed. The party also may file a copy of the complaint with the notice. [Note 2.] If a party files a civil action, but fails to notify the Board, the Board,

believing that its decision has become final, will terminate the proceeding. As a result, a registration may be issued or cancelled prematurely while the civil action seeking review of the Board's decision is still pending. For further information concerning appeal of a Board decision, see [TBMP Chapter 900](#).

For further information regarding access to files see [TBMP § 120](#).

#### NOTES:

1. [37 C.F.R. § 2.136](#).
2. [37 C.F.R. § 2.145\(c\)\(3\)](#).

### 807 Status of Application after Proceeding

[37 C.F.R. § 2.136](#) *Status of application or registration on termination of proceeding.* After the Board has issued its decision in an opposition, cancellation or concurrent use proceeding, and after the time for filing any appeal of the decision has expired, or any appeal that was filed has been decided and the Board's decision affirmed, the proceeding will be terminated by the Board. On termination of an opposition, cancellation or concurrent use proceeding, if the judgment is not adverse to the applicant or registrant, the subject application returns to the status it had before the institution of the proceeding and the otherwise appropriate status of the subject registration is unaffected by the proceeding. If the judgment is adverse to the applicant or registrant, the application stands refused or the registration will be cancelled in whole or in part without further action and all proceedings thereon are considered terminated.

Once the Board has issued its decision in an opposition, cancellation, or concurrent use proceeding, the Board will terminate the proceeding after the time for filing any appeal of the decision has expired, or any appeal that was filed has been decided and the decision has been affirmed. [Note 1.] When the proceeding is terminated, the TTABVUE proceeding record will include a prosecution history entry, a "Status" indicator, and a field for "Application Status" that each say "TERMINATED."

#### NOTES:

1. [37 C.F.R. § 2.136](#). See MISCELLANEOUS CHANGES TO TRADEMARK TRIAL AND APPEAL BOARD RULES, 81 Fed. Reg. 69950, 69968 (October 7, 2016) ("The Office is amending § 2.136 to specify when a proceeding will be terminated by the Board and the status of an application or registration on termination of an opposition, cancellation, or concurrent use proceeding.").

#### 807.01 Abandoned Applications and Registrations Entirely Cancelled

The Board handles all status updates to applications that are abandoned and registrations that are cancelled in their entireties upon termination of inter partes proceedings. [Note 1.] **Please Note:** The status update process may take up to one week. If the status of such an application or registration is incorrect after one week, the interested party should contact the Board for assistance.

#### NOTES:

1. [37 C.F.R. § 2.136](#). See *Forest Laboratories Inc. v. G.D. Searle & Co.*, 52 USPQ2d 1058, 1060 n.3 (TTAB 1999) (if opposition is sustained, application is deemed abandoned); *In re Vesper Corp.*, 8 USPQ2d 1788, 1789 (Comm'r 1988) (there is no authority for the Commissioner to reopen an application for entry of an

amendment after a successful opposition). *See also National Patent Development Corp. v. Hercules Inc.*, 192 USPQ 491, 492 (Comm'r 1976) (Commissioner refused to reopen application for motion to amend after adverse final judgment in opposition).

## 807.02 Applications Not Abandoned and Registrations Not Cancelled

When an opposition or concurrent use proceeding ends with a judgment which is not adverse to an involved applicant and the Board terminates the proceeding, the application returns to the status it had before the proceeding commenced, unless the Board indicates in its decision that the application must be republished for some reason or includes in its decision a [37 C.F.R. § 2.131](#) remand to the examining attorney. [Note 1.] *See* [TBMP § 805](#).

When a cancellation or concurrent use proceeding ends with a judgment which is not adverse to an involved registration and the Board terminates the proceeding, the otherwise appropriate status of the subject registration is unaffected by the proceeding. [Note 2.]

Upon termination of an inter partes proceeding in which the application was not abandoned or the registration was not cancelled in its entirety, the Board updates the “Application Status” field in TTABVue to reflect “Terminated.” However, it is the Trademark Examining Operation that undertakes the electronic transactions necessary to return the application to the status it had before the proceeding was instituted, and to ensure that the otherwise appropriate status of the registration is unaffected by the proceeding. The Board is unable to change the status of the application or registration at this point unless: (1) the placement of the application or registration into “Terminated” status was premature or otherwise inappropriate, or (2) the application or registration should be abandoned or cancelled in its entirety.

**Please Note:** This status update process can take up to several weeks. If, after a reasonable time, the application or registration has not been electronically transitioned in status from that which the Board enters upon termination of its proceeding to that which the Trademark Examining Operation subsequently enters, the interested party should contact the Trademark Assistance Center for assistance.

If the application or registration was the subject of multiple proceedings brought by unrelated plaintiffs, and the Board finds in favor of one of the plaintiffs, either on summary judgment or at final hearing, the Board usually issues an order to the remaining plaintiffs allowing them time to inform the Board if they wish to go forward to obtain a judgment on the merits, failing which, the proceeding will be dismissed as moot. [Note 3.]

### NOTES:

1. *See* [37 C.F.R. § 2.136](#).
2. [37 C.F.R. § 2.136](#).
3. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 n.3 (TTAB 2011).